



INDEX.

Statement.	1
Nature and circumstances of the controversy.	5
Murray patent No. 854,959 of May 28, 1907.	24
Files of patent compel limitation of claims to constructive details neither patentable nor employed by defendant.	30
No infringement.	40
Petitioner's comments on Bowyer patent.	55
Other prior patents.	57
Both Whitney hoists essentially novel and exclusive of Henderson.	60
Henderson specifically anticipated under petitioner's present interpretation.	63
No conflict of decisions concerning "Little Wonder"...	68
Whitney's relation to the Liebel-Binney and Chain Belt cases.	70
Law of infringement.	72
The several decisions.	75
Eighth Circuit.	75
Third Circuit.	84
Seventh Circuit.	84
No patentable invention.	90
Summary.	96

CASES CITED.

Aron <i>v.</i> Manhattan Ry. Co., 132 U. S., 88.....	91, 94
Atlantic Wks. <i>v.</i> Brady, 107 U. S., 192.....	90, 92
Belding Mfg. Co. <i>v.</i> Corn Planter Co., 152 U. S., 100....	91
Brill <i>v.</i> Washington Ry. & El. Co., 215 U. S., 527.....	91
Burt <i>v.</i> Ivory, 133 U. S., 349 (359).....	91
Busell Trimming Co. <i>v.</i> Stevens, 137 U. S., 423 (435)....	91, 94
Bussey <i>v.</i> Excelsior Mfg. Co., 110 U. S., 131.....	93
Cimiotti Unhairing Co. <i>v.</i> Am. Fur Ref. Co., 198 U. S., 399, 416.	91
Comp. Scale Co. <i>v.</i> Automatic Scale Co., 204 U. S., 609.75, 91	
Consolidated Roller Mill Co. <i>v.</i> Walker, 138 U. S., 124..	91
Corbin Cabinet Co. <i>v.</i> Eagle Lock Co., 150 U. S., 38-40..	75
Crescent Brewing Co. <i>v.</i> Gottfried, 128 U. S., 158.....	91
Duer <i>v.</i> Corbin Lock Co., 149 U. S., 216.....	78, 91, 96
Fay <i>v.</i> Cordesman, 109 U. S., 408.....	75
Florscheim <i>v.</i> Schilling, 137 U. S., 64.....	91, 93
Grant <i>v.</i> Walter, 148 U. S., 547.....	91
Grinnell W. Ma. Co. <i>v.</i> Johnson Co., 247 U. S., 426..75, 79, 91	
Hailes <i>v.</i> Van Wormer, 20 Wall., 353.....	90
Hall <i>v.</i> Macneale, 107 U. S., 90.....	90
Heald <i>v.</i> Rice, 104 U. S., 737.....	90
Hubbell <i>v.</i> U. S., 179 U. S., 77.....	75
Keystone Bridge Co. <i>v.</i> Phoenix Iron Co., 95 U. S., 274.	73
Knapp <i>v.</i> Morss, 150 U. S., 221.....	91
Mahn <i>v.</i> Harwood, 112 U. S., 354, 359.....	75
Market St. Ry. Co. <i>v.</i> Rowley, 155 U. S., 621.....	91
Mast, Foos & Co. <i>v.</i> Stover Mfg. Co., 177 U. S., 485....	91, 96
McCarthy <i>v.</i> Lehigh Valley R. R. Co., 160 U. S., 110....	72
McClain <i>v.</i> Ortmyer, 141 U. S., 419, 429.....	96
Morris <i>v.</i> McMillan, 112 U. S., 244.....	91
N. Y. Belting & Packing Co. <i>v.</i> Sierer, 158 Fed., 819.....	91
Olin <i>v.</i> Timken, 155 U. S., 141.....	95

Penn. Ry. Co. <i>v.</i> Locomotive Truck Co., 110 U. S., 490..	90
Pickering <i>v.</i> McCullough, 104 U. S., 310.....	94
Planing Machine Company <i>v.</i> Keith, 101 U. S., 479, 490, 491.	56
Pope Mfg. Co. <i>v.</i> Gormully Mfg. Co., 144 U. S., 254 (259- 260).	91
Railway Sup. Co. <i>v.</i> Elyria Iron Wks., 244 U. S., 285.75, 79, 91	
Richards <i>v.</i> Chase Elevator Co., 158 U. S., 299; 159 U. S., 477.	90
R. R. Co. <i>v.</i> Mellon, 104 U. S., 112.....	75
Ryan <i>v.</i> Hard, 145 U. S., 241.....	91
Shepard <i>v.</i> Carrigan, 116 U. S., 593, 597-8.....	75
Slawson <i>v.</i> Grand St. Rd. Co., 107 U. S., 649.....	90
Thatcher Heating Co. <i>v.</i> Burtis, 121 U. S., 286.....	91, 93
Thompson <i>v.</i> Boisselier, 114 U. S., 1 (11).....	91
White <i>v.</i> Dunbar, 119 U. S., 47.....	74
Wright <i>v.</i> Yuengling, 155 U. S., 47 (53-4).....	91

IN THE
SUPREME COURT OF THE UNITED STATES.

NEW YORK SCAFFOLDING COMPANY	}	
Petitioner,		
vs.		
LIEBEL-BINNEY CONSTRUCTION COM-	}	No. 712.
PANY,		
Respondent.		

NEW YORK SCAFFOLDING COMPANY,	}	
Petitioner,		
vs.		
CHAIN BELT COMPANY et al.,	}	No. 713.
Respondents.		

(Nos. 284 and 285 of October Term, 1918.)

Statement.

These are suits for infringement of United States patent No. 959,008, granted to Elias H. Henderson, May 24, 1910 (application filed June 19, 1909), for "*Improved Scaffold Supporting Means*" (L. B. Rec., p. 169; C. B. Rec., p. 329, following p. 258). The charge of infringement is confined to the first and third claims.

The record in the first-entitled case will be referred to as "L. B. Rec." and in the second as "C. B. Rec."

These cases are brought here in response to a petition for writ of certiorari predicated upon alleged conflict between the Courts of Appeal in the respective circuits; but all the judges of all the Circuit Courts of Appeal who have passed upon this



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patent have been unanimous in holding that the patent could not be sustained as covering what petitioner now asserts to be the invention of the patent, viz., a "loose jointed connection between the put log and the supporting frames" of the hoist. (Petitioner's Brief, Liebel-Binney case, p. 7). Petitioner is compelled to abandon the fallacy by which the Court of Appeals of the Eighth Circuit (after finding, as the trial court had done, that there was no patentable novelty in the construction of the hoists, or in hanging them in the same relative position on the outriggers as in the prior Murray patent, and supporting a similar platform on them, raising and lowering them in a similar way) was misled into supposing there was an advantage in setting hoist frames parallel to the wall instead of edgewise, and laying the timbers loosely in them instead of having them so attached to the frames that they could not be lifted out without unfastening them. It has also to abandon the pretense by which that court was led to assume that plaintiff's extensive business in the manufacture and use of these hoists was due to the presence of this feature and, disregarding the constructive features to which the claims had been explicitly limited after rejection (which were not in defendant's hoists), enjoined the use of the first Whitney hoists *when used parallel to the wall*, though expressly authorizing their use when the planks were laid on the lower bars of the hoist frame and these frames were placed *with their edges to the wall*. (L. B. Rec. 6 to 16.)

There is entire unanimity in all the circuits in holding the patent cannot be sustained as covering what plaintiff now asserts as the patented invention. Its present argument is, in effect, that plaintiff's use of the Murray hoist and platform positioned and operating as in the prior Murray patent of May 28, 1907, is the invention of these claims.

Defendants believe for reasons more particularly stated hereafter, that what two of the judges of the Eighth Circuit

held to be invention was neither novel nor patentable; that it was neither claimed, nor recognized in the Patent Office, as the invention of Henderson; that the allowance of the patent was procured solely on the theory that the invention resided in the modification in the construction of the frame consisting in forming it of a single bar bent in U-shape, carrying the bearings of the hoisting drum directly in the upright arms of this bar (instead of upon an attached bracket or other construction that involved a larger number of parts), and upon the exclusion of attaching devices at any point between the bearings of the hoist and cross-bar constituting the bottom of the frame thus formed, (not present in either of the Whitney hoists); that the fact that this was held by the court not to be patentable invention should have resulted in finding the claims invalid, instead of treating it as a reason why they should not be limited to what was thus claimed after rejection of broader claims, and as covering what was nowhere represented, either in the specification or claims, to be the invention upon which the patent rested.

The Liebel-Binney case was tried in open court, where a cross-examination of plaintiff's witnesses exhibited to the Court that plaintiff, claiming to be the largest manufacturer and user of such hoists in the country and to have long controlled this business, had since over a year before Henderson's alleged invention, down to the present date, manufactured under and in accordance with the prior Murray patent of May 28, 1907, setting the hoists edgewise to the wall, positively attaching the put-logs or cross timbers to the frames by bolts or rivets so that they could not be applied or removed without fastening or unfastening, retaining every feature that the former court had presumed to be fatal to the Murray, and excluding every feature that the two judges of the Eighth Circuit, who overruled the trial court and other circuit judge, had been induced to assume were

essential to success. It was shown in the Liebel-Binney case that plaintiff down to the present date made and used its hoists under and in accordance with the prior Murray patent, retaining its relative arrangement as well since it acquired the Henderson patent in 1911, as during the years preceding Henderson's alleged invention, uniformly adhering to the feature that these judges supposed to have been fatal to the Murray and excluding the feature which it conceived to have been the key to its success and erroneously credited to Henderson.

With this unrebutting evidence confronting it, the District Court in the Third Circuit was convinced it could not follow the first opinion of the Court of Appeals for the Eighth Circuit in holding the patent valid under any possible interpretation, even if it had been proved that the Liebel-Binney Company had used the hoist in the manner necessary to bring it within the supposed invention (which was not proved) and decreed accordingly, holding the Henderson patent invalid. See opinion, L. B. Rec., p. 80; decree, p. 89. The Court of Appeals for the Third Circuit, after full hearing and consideration, unanimously affirmed its decree. See p. 150. Presumably the Court of Appeals of the Eighth Circuit would have reached the same conclusion on the same record, or if it had not been misled into supposing that the placement of the hoist parallel to the wall instead of edgewise was the key to plaintiff's success, and adopted its definition of the Henderson invention from plaintiff's argument, instead of from the claims in suit and the proceedings in the Patent Office. This appears from its second opinion after its attention had been directed to the significance of the files, 243 Fed., 180.

Plaintiff-petitioner no longer argues that the patent covers the supposed invention upon which alone it has ever been sustained by any court (realizing that their argument would be fatal in the Liebel-Binney case), but having got here on the assertion of conflict of decisions, asks this court to substitute

for the claims of the patent a definition of the invention entirely inconsistent with them, which has been rejected by every one of the twelve judges who have passed upon this patent, which is absolutely destitute of novelty and equally destitute of patentability.

It is insisted that the four judges sitting in the Liebel-Binney case were right in holding the patent invalid; that they would have been compelled to hold it not infringed if they had sustained it as covering the edgewise placement of the hoist (the only interpretation upon which any judge has found invention in it); and that the patent and the files showing the significance of the limitations by which its allowance was procured excluded the acceptance of the illusion which was temporarily effective in the Eighth Circuit.

The evidence supporting what has thus far been stated will be more particularly referred to under subsequent headings.

Nature and Circumstances of the Controversy.

The Henderson patent recognizes scaffold supporting means, of the same general character, as already old, and, by the terms of the specification and claims, emphasized by the proceedings in the Patent Office, confines the invention asserted to whatever economy and security was contributed to the hoist by making its frame of a single bar bent into U-shape at the bottom, having the bearings of the drum on which the cable is wound mounted directly in the upright arms of this U-shaped bar, on the bottom of which the timbers supporting the platform rested. It claims to thus dispense with the bolts and rivets that had before been employed in connecting the parts of the frame receiving the bearings of the hoisting drum with the support of the timbers. This was represented to reduce the number of parts, effecting economy and security.

Scaffold supporting hoists had commonly been used and exhibited in patents, having frames of the same general

shape, with the hoisting drum mounted and operated in such frames, the bearings being carried by the side bars of the frame and the drums similarly rotated by crank shafts, the cross timbers which carried the platform being supported on the bottom of the frame. Such hoists were used in pairs when only narrow platforms were required and in sets of four or more when broader platforms were used.

With the increasing demand for the rapid construction of lofty buildings, the broader platforms have come more into use, and it was a common practice since before the Henderson patent was applied for (a practice largely followed by plaintiff under its Murray patent of May 28, 1907, long preceding the application for the Henderson patent, and ever since continued by it to the exclusion of everything that distinguishes the Henderson from the Murray), to support pairs of these hoists on successive outriggers in the same position as illustrated in Fig. 1 of the Henderson patent and Fig. 2 of the Murray patent of May 28, 1907, with cross timbers (either of metal or of wood) supported on the lower end of these hoist frames, and longitudinal timbers resting on these cross timbers in the same relative position and for the same purpose. Sometimes these cross timbers had rested directly upon the bottom of the U-frame, sometimes they were shown as attached to the bottom by bolts, and sometimes as resting on the bottom without such attachment, sometimes as resting on an attached cross-bar at the bottom of the frame.

So far as the prior art was illustrated by patents, when the platform timber rested directly on the U-shaped bottom of the frame (as in the Bowyer *et al.* patent of May 1, 1888, L. B., p. 185; C. B., p. 332), the bearings for the hoisting drum were carried by a bracket attached to the uprights of the frame, instead of directly in the uprights. This involved using a separate piece of metal for the bracket and attaching it by some means to the uprights, which Henderson avoided by omitting the bracket and setting the bearings directly in

the upright arms of the single bent bar, which had been done in prior hoists other than the Bowyer. In other cases illustrated in prior patents, the bottom of the hoist had been formed by bolting or riveting the cross-bar forming the bottom of the frame to the uprights, instead of bending the single bar to form at once the bottom support and the uprights, as in the Sladek patent of June 19, 1898 (C. B., p. 336), Foster of 1904 (C. B., p. 350), Harpin of June 28, 1904 (C. B., p. 356), and the Crandall of Aug. 22, 1905 (C. B., p. 380).

Plaintiff had also, for some time before the application for the Henderson patent, manufactured, advertised and put into use, under its Murray patent of May 29, 1907, the hoist there shown, in successive pairs, having the frame formed by the single U-shaped bar supporting the cross timbers of the platform, as illustrated in plaintiff's advertisements following p. 181 of the L. B. Record, particularly pp. 10 and 25 of such advertising catalogue, and more clearly shown opposite p. 236, C. B. Rec.

Henderson, before he applied for patent or made his preliminary sketch, had seen plaintiff's hoists, as shown in these cuts, used in the construction of the Blackstone Hotel in Chicago, and had designed his "improvement" so as to avoid the claims of the Murray patent (which, by reason of the art preceding Murray were very limited), while retaining substantially the features of that and prior hoist patents. He made such changes in the means of rotating the drum as were the subject of claims in his application as filed, but these were rejected and abandoned. After all his claims had been rejected upon the Murray, Bowyer and Casperson and other prior patents, his solicitors struck out his original claims, and limited the specification and claims to such invention as resided in forming the U-frame of a single bent bar and mounting the bearing of the drum "*directly*" in the upright arms of that bent bar, insisting that the economy and security thus

afforded, dispensing with any connections or fastenings intermediate of these bearings and the timber support, constituted the invention to which the claims were confined. After repeated rejections, the Examiner yielded to this reiterated argument and the claims were allowed. These files are specifically referred to under a subsequent title.

The specification admitted that it was not novel "*to use such hoisting means in connection with the cables on the scaffold to adjust the height as required in connection with the work,*" and stated that the invention "*relates to an improved form of hoisting mechanism carried by the scaffold for securing the same to the cables, the upper ends of which are connected to outriggers, generally temporary in character, secured to the upper portion of the building.*" It throughout represented the invention to consist in the economy and security to be obtained in the manner above described, thus reducing the number of parts, dispensing with auxiliary means "to secure the hoisting mechanism to the scaffold" and making the construction simple and cheap "on account of the small number of parts, and further on account of the single bar constituting the framework of the machine serving also as the bearings and bearing supports for the hoisting mechanism."

All three of the Courts of Appeal which have passed upon this patent have been unanimous in holding that these improvements, which were the sole pretext for allowing the patent (as abundantly shown by specification, claims, and the proceedings in the Patent Office), did not constitute patentable invention in view of the prior art. The Court of Appeals of the Third Circuit, in the *Liebel-Binney* case, following the court below which had the witnesses before it, unanimously reached the apparently unavoidable conclusion that the claims were, therefore, invalid, and the bill must be dismissed. The reasons for doing so were fully stated in their opinions (opinion below, L. B. Rec., p. 80, opinion of Court of Appeals, p. 115).

The district judge in the case in the Eighth Circuit, before whom this patent first came, and who heard the evidence, also held that the claims were invalid and, if sustained at all, would not cover the defendant's machine. On appeal, one of the circuit judges agreed with him, the other circuit judge and the district judge sitting with him, while distinctly holding that the features upon which the claims were allowed, and to which they were in terms restricted, did not constitute patentable invention, instead of holding the patent invalid on this ground, treated it as a reason why the claims should not be limited to the elements so defined; that is, finding that the distinctions emphasized by specification and claims and reiterated in argument before the Patent Office as defining the departure which the patentee had made from the prior art, could not sustain a patent, they held that the limitations so imposed upon the claims as a means of coaxing the Examiner into their allowance could—because representing no patentable distinction—be disregarded for the purpose of finding infringement, and that the patent could be sustained for a feature not mentioned in specification or claim as constituting any part of the invention asserted, and which there was no reason to infer was novel with the patentee or involved any invention—viz: hanging the hoists parallel to the wall of the building instead of edgewise.

The patent had, as before stated, described the invention as consisting in the economy and security afforded by forming the frame of the hoist out of a single bar of metal bent into a U-frame at the bottom and carrying the bearings of the drum directly in the upright arms. It had illustrated in successive figures, as alternative methods of using this hoist, hanging it with the frame parallel to the wall and with the frame at right angles to the wall, not intimating that either placement was original with the patentee, or that the invention was in any way concerned with which way it was used. It was obviously a mere matter of convenience, depending upon the relative

space available for the platform or the size of the platform required, the length of the timber available, or whether, for any reason, it was preferred to have the hoists occupy one or the other position.

The defendant's hoists, like those that preceded them, were equally adapted to be used with their frames parallel to the wall or edgewise to the wall. The evidence in the Eighth Circuit case happened to show them placed parallel to the wall. Plaintiff, having carried the case to the Circuit Court of Appeals of the Eighth Circuit, seized upon that fact in its argument there to urge that this parallel placement was revolutionary in its effect (though there was not a particle of evidence to support this theory and plaintiff has adhered to the edgewise placement) and persuaded two of the judges that it was the real invention which had brought these hoists into very extensive use. As the plaintiff was shown to have introduced its hoists very extensively during the few years preceding the suit, these two judges were induced to assume that they were hoists made in accordance with the Henderson patent (which was entirely untrue, plaintiff never having made any under and in accordance with this patent or designed to be used in any different placement than the old Murray); that their success had been due to this parallel placement (which was also entirely untrue, for they did not employ it); and that this placement possessed important advantages (which the present record shows to be entirely fictitious).

These two judges, basing their opinion on these assumptions (completely excluded by the present records) held that the invention consisted in and was limited to placing the hoist with the frame parallel to the wall and, on this ground, reversed the decision below (see opinion, 224 Fed., 452-463). A copy of this opinion (omitting mention of the dissent of one of the circuit judges) was attached to the bill in the Chain Belt case (p. 8). The dissenting opinion was afterwards introduced by defendant (p. 21).

Thus the district judge, both in the Eighth and the Third Circuits, before whom the witnesses had been produced and examined, held the patent altogether invalid. The three judges of the Court of Appeals in the Third Circuit concurred with the trial judge. One of the circuit judges in the Eighth concurred with the trial judge. The other circuit judge and one district judge—who had not heard the evidence—held that what the patent represented to be the invention of the patent was not patentable, but, misled by an argument based on assumptions that were untrue in fact, sustained the patent as covering the first Whitney hoist when used with the frame parallel to the wall, but excluding it when the hoists were hung edgewise to the wall; they did so on the assumption that this parallel placement was essential to success and that plaintiff's extensive business was due to such placement, when, as matter of fact, as conclusively shown in the present records, it had been, both for years preceding the acquisition of the Henderson patent and continuously since, conducted under and in accordance with the Murray patent of May 28, 1907, with the hoist placed at right angles to the wall. The advantages ascribed to the parallel placement and to absence of attachments between hoist frames and cross-timbers were entirely imaginary, and contrary to fact with Henderson hoists.

The hoists used by the Liebel-Binney Co. and those manufactured by the Chain Belt Co. (who have only made the ironwork of hoists, under contract, and have never been engaged in their sale or use) are, like all the hoists of the prior art, equally adapted to be used edgewise to the wall or parallel to the wall or in any other position that the purchaser may have occasion to use them. In this respect they are not distinguished from the platform hoists of the same general character shown in patents and in extensive use many years before Henderson's application.

Since the evidence has exposed the fiction by which the first

decision of the Court of Appeals of the Eighth Circuit was procured, plaintiff has repudiated the interpretation of the patent upon which that decision rested and has sought to assert the patent as covering a "loose-jointed connection."

The hoist involved in the above-mentioned decision of the Eighth Circuit (which the defendant there had then ceased to manufacture) was what was termed the "Whitney hoist" (shown in Whitney patent of January 28, 1911; C. B. Rec., p. 396). It had the drum mounted on a bracket attached to and projecting forward from the frame as in the Bowyer and Casperson patent of May 1, 1888, differing from the hoist of the Henderson patent in this and other respects in which the specification, claims and argument in the Patent Office distinguished the Henderson from the prior patents upon which the broader claims had been rejected. Because of this fact and because a lever pivoted and projecting on the same side of the frame was used in connection with a peculiar clutch arrangement to operate the mechanism (instead of the rotating crank by which the Henderson and Murray were operated), there was some advantage in setting the pairs of hoists with the side carrying the drum facing each other and the companion hoists in reverse position, so that the lever on each would extend inward towards each other and enable both to be operated simultaneously by one man, and this arrangement had, for that reason, been illustrated and described in the first Whitney patent, the specification stating (p. 3, ls. 20-24) that the frames were "arranged in pairs, the frames facing one another so as to dispose the hand levers 52 convenient to the hand of the operators, as shown in Fig. 1." This construction of the hoist enabled the frame to be set *edgewise* or *flatwise* to the wall.

Both these advantages were excluded by the Henderson construction, where the drum was operated by a crank pivoted in the frame through a reducing gear so extended and so projecting that the frame could not be set as near the wall

of the building if parallel to it as if edgewise to it, and where, if set parallel to the building, it would be impossible for the same operator to contemporaneously turn the two cranks.

The construction of the Whitney hoist was distinguished from that of the Henderson in that the Whitney hoist frame could be set close to the wall, whether edgewise or parallel, and could be operated as conveniently as the Henderson when set edgewise, and more conveniently when set so that the two levers projected inwardly. Its frame was not made of a single bent bar carrying the timbers on the bent portion of the frame so as to dispense with rivets, bolts or other auxiliary fastenings; but was composed of many pieces bolted or riveted together and had an attached bar at the lower end to carry the timbers as in the Sladek and Harpin hoists of the prior art on which the Henderson had been rejected and from which the amendments and argument in the Patent Office distinguished the construction of the Henderson frame. Instead of having the bearings of the drum mounted in the single bent bar, it had them on an attached bracket projecting out of the plane of the frame as in the Bowyer & Casperson of 1888, from which again the claims and argument had, in this respect, differentiated the Henderson. It was only by ignoring the express terms of the claims, emphasized by their having been introduced to avoid these prior patents and by the argument which induced their allowance that such a hoist could be held an infringement even if the claims had been for patentable subject matter.

Before the first Whitney case was heard in the District Court Whitney had invented and applied for a patent upon the hoist commonly known as the "Little Wonder" (see Whitney patent of October 27, 1914, applied for November 22, 1913; C. B. Rec., p. 402), and began manufacturing this and putting it into use in the spring of 1914, discontinuing from about that time the manufacture of the hoist involved

in the first decision of the Court of Appeals of the Eighth Circuit. It was an ingenious and entirely new construction of hoist, dispensing altogether with the drum and the space-consuming mechanism incident to the use of the drum, so constructed that the hoist crawled up the cable, and dispensing with any winding of the cable (a feature also present in the first Whitney hoist, and distinguishing it from the Henderson). It, like the former Whitney, was adapted to be used either edgewise to the wall or parallel to the wall, and in either position could work much closer to the wall than the Henderson in either position. It had been used both parallel and edgewise to the wall.

Plaintiff asked to have this hoist included in the accounting after the case came back from the Court of Appeals. The district judge regarded the first decision of the Court of Appeals as covering such a construction when used parallel to the wall, and entered a supplemental decree enjoining such use and ordering that it be included in the accounting. From this supplemental decree the same case went, by defendant's appeal, a second time to the Court of Appeals of the Eighth Circuit. At that hearing the court's attention was definitely directed to the Patent Office files as interpreting the claims, and to the essential differences between the Henderson and Whitney hoists. The judge who had delivered the opinion of that court at the former hearing presided and wrote the opinion at the second hearing. The judge who had dissented in the former decision was not on the bench, and two judges who had not participated at the former hearing sat with the presiding judge. By a unanimous opinion the court held that this "Little Wonder" machine did not infringe, whether the hoists were placed parallel or edgewise to the wall, interpreting and restricting its former decision. The reasons given for its conclusion all apply to the first Whitney as well, when properly understood. This "Little Wonder" was

asserted to have the same loose joint and rocking movement between the put log and hoist that plaintiff now relies on to sustain its charge of infringement against each of the defendants here. It may fairly be inferred from this decision (reported 243 Fed., 180) that if the court had not been under a misapprehension concerning the facts at the former hearing it must have found the Henderson claims invalid, or so restricted as not to cover the first Whitney hoist. All the five judges that sat in the Court of Appeals of the Eighth Circuit at the two hearings were, therefore, of the opinion that the Henderson patent could not be sustained as covering anything except the parallel placement of the original Whitney hoist, and the three that sat at the second hearing—including the one who had delivered the opinion at the first—were unanimous in holding that it could not cover the second Whitney or "Little Wonder" machine whether placed parallel or edgewise to the wall.

In August, 1915, plaintiff filed its bill in Milwaukee against the Chain Belt Co., which, as an employe of Whitney, had made the metal work of his hoists for him, but had nothing to do with supplying the platforms or directing how the hoists should be hung, charging it with infringement of the same patent, and attaching the majority opinion of the Court of Appeals of the Eighth Circuit as an exhibit to the bill. Whitney asked to intervene for the purpose of obtaining an injunction against plaintiff's pressing this and other suits against his vendees pending the accounting, showing that eleven suits in various districts for infringement of this patent had been filed by the plaintiff against him and his vendees, seeking to enjoin the hoist involved in the Eighth Circuit, for which an accounting was proceeding against him, and to recover damages and profits by reason thereof; that the plaintiff was threatening to bring other suits against vendees, and threatening them by misleading advertisements; that he was financially responsible for all damages

or profits arising by reason of the sale or use of such hoists; that the purpose and effect of this multiplicity of suits against his vendees, and the advertisements thereof, was to destroy his business and involve him and them in needless expense; that the manufacture and sale of the hoists involved in the Eighth Circuit suit had been discontinued before the suit was commenced (C. B. Rec., p. 28 *et seq.*).

The only hoist that the Chain Belt Company was manufacturing for Whitney at the time the suit was commenced was what was known as the "Little Wonder." There was no evidence that the Chain Belt Company had manufactured any of the first Whitney hoists for more than two years before the suit was commenced, or had ever had anything to do with setting them up or had ever seen them set up parallel to the wall. The bill and supplemental bill had shown that an accounting was then pending against Whitney for all the hoists made by him or in his behalf. The district judge, apparently regarding the validity of the patent as determined by the first opinion of the Court of Appeals of the Eighth Circuit, and, like it, treating the pretended invention upon which the claims were allowed as so obviously not patentable that its *omission* was a mere "*evasion*" of the patent, ordered an injunction and accounting, apparently including in this Whitney, who was already, by the plaintiff's showing, under an injunction and accounting for the same alleged infringement in the prior suit. Stress was laid on the presumption attaching to the grant of the patent as evidence of patentability, while the limitations which were treated in the Patent Office as the only invention to sustain the patent were held to be immaterial.

The District Court was impressed with the extent of plaintiff's business as evidence of the value of the invention, but disregarded the fact that the business was conducted under and in accordance with the prior Mur-

ray patent, and that plaintiff's hoists had not been modified either in construction or placement since Henderson saw them before the earliest date claimed for the conception of his invention. It overlooked the fact that Henderson hoists had no adaptation to use parallel to the wall not equally possessed by those of prior patents, and that the Chain Belt Co. was not shown to have used any, or to have known of their being used, in any different position from those of the prior patents (opinion, C. B. Rec., pp. 247-8). It confined the relief granted to the hoists placed parallel to the wall, but included the "Little Wonder" when so placed, assuming that it was following the Court of Appeals of the Eighth Circuit in so doing. This was before the second decision of that court.

The decision of this case in the Court of Appeals was after the Court of Appeals of the Eighth Circuit had rendered its second decision. It unanimously concurred with the Court of Appeals of the Eighth Circuit that the patent could not be sustained as covering the "Little Wonder" machine in any position; adopted the theory of that court's first opinion that the invention consisted in and was limited to placing the frames parallel with the wall instead of edgewise, and thereby effecting "saving of room on the platform" though conceding that "*neither in the specification nor claims is mention made of the position of the drums with reference to the building wall.*" It plainly disregarded the fact that in the Henderson machine there would be no such saving of space, but the reverse, and that plaintiff's machines were uniformly set edgewise to the wall. It said that Henderson's advance, "however slight, is not so wholly wanting in invention or novelty; as to justify a finding contrary to the presumptive validity of the grant to him, and we therefore conclude that his claims in issue here are valid," but held that they could only cover the first Whitney hoist when set parallel to the wall, and decreed accordingly (opinion, C. B. Rec., p. 265).

It seemed to entirely overlook the fact that the "*presumptive validity of the grant*" could only attach to the invention *claimed*, and defined as indicated by the files; that both the files and the claims predicated this solely on features that were absent from all defendant's hoists, however placed; and that the effect of the "presumption" attaching to the grant could only be to exclude infringement, not to create a presumption that the patentee had invented what the Patent Office did not recognize, or the patentee assert, as his invention, or to relieve the patent from the limitations expressly and persistently asserted to constitute the invention, and for which alone the patent was allowed. If the "saving space" had been secured by Henderson (as it was not, but by changes made by Whitney), this was not patentable invention within any of the decisions of this court.

It seemed, also, to overlook the fact that, in the absence of proof that the Chain Belt Company had used hoists parallel to the wall, or induced such use, or had knowledge of such use, plaintiff was not entitled to a decree against it for either an injunction or accounting, and that Whitney, who had employed the Chain Belt Company to make these hoists for him, being already under a decree in the Eighth Circuit for an injunction and accounting for these identical hoists, plaintiff had exhausted its remedy against him and could not have a second decree against him in another district based on identically the same subject-matter.

If, as repeatedly held by the Supreme Court and generally held by other courts, the invention is to be defined by the specification and claims of the patent, either alone or read in connection with the amendments and arguments in the Patent Office, there is no escape from the conclusion that the district judge who heard the Liebel-Binney case, and the Court of Appeals of the Third Circuit, which affirmed his decision, were right in holding that the patent was invalid, and that, even if sustained, the Whitney hoist did not in-

fringe it—a conclusion reached after giving full consideration to the opinion of the Court of Appeals of the Eighth Circuit. If, on the other hand, the claims of the patent drawn by the inventor or his solicitor, and made by statute the definition of his invention, are to be entirely disregarded; if the nature of the invention asserted is to be a matter of conjecture by the court, or governed by the argument of counsel, rather than by the terms of the claims; if, when the court finds that the defendant has not used what was plainly defined as the invention, and that the invention as defined would not be patentable, it is to conjecture what, if any, other pretext can be found for awarding a monopoly to the plaintiff, it follows that patents can only serve to mislead the public concerning the nature of the invention. The defendant, having abstained from using the invention as defined by the patent, whether read by itself or in the light of the proceedings in the Patent Office, or having proved that there was no patentable novelty in the invention so asserted, has no security against such an attack as has been made upon these defendants.

The object of the statute in requiring specifications and claims, and in providing for the investigation made in the Patent Office preliminary to the grant of the patent, is more than nullified; the claims granted, or record of the Office leading up to their grant, serve only as a blind to those who seek to ascertain what the patents are intended to cover.

The invention which the court conjectures was made by the patentee may be one that the patentee knew did not originate with him and never intended to assert, or one for which the Patent Office would have immediately refused to allow a patent if it had been asserted.

This is recognized in the second opinion of the Court of Appeals of the Eighth Circuit, though it seems in its first opinion to have unconsciously taken its definition of the invention from the argument of plaintiff's counsel, as well as

its assumption that the success of plaintiff's hoists was due to a feature which plaintiff never adopted.

If a defendant in such a suit is required to anticipate and meet by evidence every conceivable theory of what the invention may be alleged to consist in by plaintiff's closing argument, and every other misrepresentation of fact which that argument may suggest, the records and briefs in these cases, voluminous as they now are, would have to be multiplied many fold.

Respondent submits:

First. That the decision of the Court of Appeals of the Third Circuit holding the claims invalid, and of the judge of the Eighth Circuit who reached the same conclusion, were plainly right; that all the judges who have passed on this question have concurred in finding that the invention recited in the claims in suit was not patentable, the only conflict being due to the judges of the Third Circuit having held that this rendered the claims invalid, while the judges of the Seventh Circuit and two of those of the Eighth Circuit (when the case was first heard there) treated this want of patentability as reason for conjecturing that the invention consisted in something which the patentee never claimed to invent, and held the patent was infringed by a construction which the language of specification and claims, the amendments, the arguments leading up to allowance and the action of the Patent Office, excluded from the invention asserted.

Second. That if the placement of the frames parallel with the wall had been claimed, it must have been rejected for want of patentability, and that, if it had been included in either claim, it would not have relieved the claims from the other limitations expressed therein and emphasized in the amendments and arguments leading to allowance, in the absence of which there can be no infringement; that when claims are plainly limited to distinguish a device claimed from prior devices upon which it is rejected, the effect of

such limitation cannot be nullified by arguing that the limitations so expressed do not represent patentable invention, or that the device made as shown in the prior art, from which the limitation was intended to distinguish the device claimed, is the equivalent of that claimed.

Third. That from the time these hoists came into use many years before the application for the Henderson patent the support of the timbers carrying the platform, either directly upon the cross-bar at the bottom of the frame or by other means of attachment to the bottom of the frame, have been, as shown in patents and testimony, the common method of using them, the loose support of the timbers directly upon the cross-bar at the bottom of the frame having been the earliest and most usual practice; that whether they should be set parallel to the wall or edgewise to the wall has depended upon the fancy or convenience of the user, the advantage or disadvantage of carrying the timber directly on the cross-bar or attaching it to the bottom of the frame by bolts or rivets being precisely the same whether placed in one position or the other. If a platform broader than the width of the hoist is required and the timbers are to rest directly upon the bottom of the cross-bar, the cross-timbers or put logs can be carried on the bottom bar equally well whether set edgewise or parallel to the wall, and the question which position should be used may be determined by whether the major part of the planking at hand is of one length or another. Any ordinary user of such hoists, irrespective of whether he is a carpenter, mechanic, a farmer, or a common workman, would know that the hoists of the prior art could be used in either position, and would place them as was most convenient for the work he had in hand. The office of the hoists when hung parallel to the wall, in the exact position illustrated in the Henderson patent, is to support the timber which rests in the two opposite hoists—that is, identically the office performed by the hoists of the Bowyer &

Casperson patent of May 1, 1888, and of other prior patents before mentioned. The placement of the planks longitudinally upon the cross-timber supported on the bottom of two hoists hung from the same outriggers was a common practice where a broad platform was required, as illustrated in plaintiff's Murray patent of May 28, 1907. There was no novelty in supporting the platform timber on the bottom bar of two oppositely placed hoists or in laying the longitudinal timbers on cross-timbers resting on the bottom of successive pairs of hoists, supported, raised and lowered identically as in the Henderson patent. If it was desired to have a platform of any width supported on cross-timbers carried by successive pairs of hoists, and there were at hand two timbers long enough to extend the length of the platform, or from one outrigger to the next, and enough short timbers to be laid crosswise of these timbers, it might be more convenient to hang the hoists edgewise to the wall, supporting one long timber in the series of hoists next to the wall, and the other long timber in the other series of hoists at the outer end of the outriggers, laying the short timbers crosswise. If the proportions of the platform to be constructed were such that, with the timbers at hand, it was more convenient to have the timbers resting in the frame run in the same direction as the outriggers, any workman of ordinary intelligence would understand that, for this purpose, the frame should be hung parallel to the wall. The fact that plaintiff (claiming to be the largest user of such hoists in the world), owning this Henderson patent, uniformly sets its hoists with the frame at right angles to the wall, excludes the supposition that there is any substantial advantage in setting the crank-driven hoists, such as those of the Henderson patent, parallel to the wall. That there is no economy of space in so setting it (such as imagined by the Courts of Appeal of the Eighth and Seventh Circuits) is amply shown by looking at Fig. 6

of the Henderson patent, which shows that the frame can be set rather nearer to the wall when edgewise than when parallel to it, and that it occupies quite as much space over the platform when set parallel as when set at right angles. The courts which held otherwise have overlooked the space required for turning the crank and for the projection of the gear, and for cross-timbers projecting sufficiently to have any chance of not slipping out when the platform is tilted in raising it.

The fact that in all the desperate struggle to persuade the Patent Office to allow the patent and to distinguish from the prior patents that had been cited, it was never suggested that the invention was concerned with this parallel placement; that it was not made an element in either of the claims but was, by the illustrations, description and argument, treated as residing in the construction of the frame however positioned, should conclude plaintiff from asserting this placement as any part of the invention.

Fourth. If the elements recited in the claims and emphasized by the amendments and argument in the Patent Office are to be treated as nonessential for the purpose of infringement, and this parallel placement, which the patentee never claimed as his invention, is to be taken as the sole definition of the patented invention, the judgment in the Liebel-Binney case must still be affirmed, and that in the Chain Belt case, so far as in conflict with it, held to be erroneous, since, as against either of these defendants, there is no proof to sustain the charge of infringement.

Murray Patent No. 854,959 of May 28, 1907.

(L. B. Rec., pp. 230-233; C. B. Rec., pp. 284-8.)

This patent, entitled for "Improvement in Adjustable Scaffolds," is that under and in accordance with which plaintiff has made all its hoists since the date of that patent and had put many thousand into use prior to Henderson's alleged invention, never modifying them to adopt any feature of Henderson after obtaining his patent in 1911. It shows and describes substantially the same hoists as those of the Henderson patent, carrying a platform of substantially the same character. It has the same outriggers projecting from the building in the same way as illustrated in the Henderson, one hoist hung near the building and the other near the outer end of the outrigger, the cross-timbers carried by these hoists extending at right angles to the building, successive pairs of hoists being hung on parallel outriggers, and the platform completed by laying boards from the cross-timber carried by one pair of hoists to that carried by a companion pair, corresponding to the arrangement shown in Figs. 1 and 2 of the Henderson patent, except that the Murray U-frames are inverted, and the cross-timbers are made of angle iron and pivotally attached to the lower end of the frames by bolts or rivets, the frames being set edgewise to the wall instead of parallel with it, which edgewise arrangement is still that generally used with hoists of this character—practically exclusively used by plaintiff and its licensees as well since it bought the Henderson patent as before the Henderson "invention." It has the advantage (where a drum or windlass hoist operated by a crank is used) of so placing the hoist as to occupy less space on the wall than it would if set parallel to the wall, and also of enabling the scaffold to be brought closer to the wall. This construction and attachment of the cross-timbers also in-

sures their being so bolted or otherwise positively attached to the frame that they cannot be separated by accident, and *it enables the manufacturer to supply for rent the entire outfit, including these angle-iron cross-timbers or "put-logs" as a complete structure*; whereas with the U-frames illustrated in the earlier Bowyer & Casperson patent, and with the Henderson, the purchaser of the hoists could supply his own cross-timbers.

The evidence shows that plaintiff and its licensees have been manufacturing platform hoists under and in accordance with this Murray patent from May, 1908, down to the present time, this being, so far as appears, the only style of platform scaffold hoist that either plaintiff or its licensees have made. They have been extensively advertised by plaintiff and its licensees, are the only form of hoists shown in their elaborately illustrated catalogues in evidence (L. B. Rec., p. 182; also C. B. Rec., Ex. C, Exs. 13 and 14, after p. 236; depts. La Belle, p. 165, As. 1-50; Henderson, p. 125, As. 1-347), and plaintiff's witness Cavanagh testified that 70 per cent. of the trade were using these Murray machines (L. B. Rec., pp. 63-5) edgewise to the wall and with the cross-timbers or "put-logs" extending edgewise of the hoist frames, and secured to them by bolts. The only other form of scaffolding hoists plaintiff or its licensees are shown to have manufactured during the last nine years is what was termed overhead or Cavanagh hoists, which apparently represents the other 30 per cent.

Plaintiff's witness Davidson testified (L. B. Rec., pp. 41-54) that he helped to form the plaintiff company in May, 1908; that this Murray type of scaffolding was on the market in 1908 at the time they formed the company; that they started the company to make it with the U-shaped frame and the put-logs at the lower end and the hoisting device by which it was lowered and raised, and have been putting it out ever since, and are still doing so, designating and marking them under

the Murray patent (L. B. R., pp. 49-50); that he is the president of the "Patent Scaffolding Company," which, as licensee of plaintiff, manufactures and operates its scaffolding machines (p. 50); that the scaffolding machines are not sold outright, only leased, and they were leasing them in 1908, and have done so right along (p. 51); that this Murray device has given good satisfaction ever since they started and has "revolutionized the business" (p. 52). In his direct testimony, he described the Murray platform machine as having been upon the market prior to the Henderson as well as since (pp. 42-3), and nowhere asserts the Henderson to have been ever manufactured by plaintiff or any of its licensees, or manufactured by anybody, since plaintiff bought the Henderson patent (May 12, 1911).

Plaintiff made no change in its construction of hoists after acquiring the Henderson patent, and apparently had no reason for acquiring it except to obtain an estoppel upon Henderson and his associates against competition in the market. It has adhered strictly to the Murray machine as made and extensively used by it before Henderson claims to have conceived of his, marking it only under the Murray patent, conforming it in every material respect to that patent, as well since as before it acquired the Henderson. Its own conduct is the most conclusive evidence that there was no practical advantage in anything contributed by Henderson.

It would seem to be obvious to the simplest mechanic or carpenter, or farmer, that the Bowyer & Casperson hoist frame could be used to support the cross-timbers of the Murray scaffolds with whatever advantage there was in laying the timbers on the bottom of the U, if it were not considered more desirable to set the frame edgewise to the wall and thus avoid obstructing as much of the wall as would be incident to setting it "broadside" to the wall. The advantage of the continuity of support between the hoist frame and the timber was exactly the same as in the Bowyer & Casperson, whether the hoists

were used in sets of two or sets of four, or whether they were placed edgewise or broadside to the wall.

The catalogue under and in accordance with which plaintiff's scaffolds are built and marketed (Defendant's Exhibit C, L. B. R., p. 182), published Aug. 12, 1912 (p. 7 of catalogue), describing plaintiff's Murray hoists as used years before Henderson's application for patent, shows that this Murray machine had, on Nov. 21, 1910, received a medal for its life-saving record (p. 4 of catalogue) and has undergone no material change since first put on the market. This medal was awarded long before plaintiff acquired any right under the Henderson patent, and would indicate that it was based upon a record of at least several years prior to this award. The same catalogue states (p. 9), referring to the machine thus advertised:

"We have no statistics to show the number of lives, which the ever-increasing use of our scaffolding has saved, during the period of more than five years since its introduction."

Five years prior to August, 1912, is August, 1907. The Murray patent was applied for in November, 1906.

This catalogue also reprints, on page 15, the "History and Description" of this so-called "safety device" published at the date of award of this medal (November, 1910), continuing the following statement:

"Since the introduction of the new form of scaffolds, there have been no fatal accidents where it has been used, although in the last two years 319 buildings were erected with its aid, where 8,265 machines were employed and not one man was injured."

Two years prior to this publication would be in 1908—long prior to the alleged Henderson invention.

Apparently plaintiff has always used, in the manufacture of this Murray machine, the frame having the U at the bottom instead of at the top, as illustrated in the Murray patent, with the bolts or rivets which connect the "put-logs" with the frame resting on the U. The Murray machines put in evi-

dence by plaintiff so show it, the catalogues representing the machines as in use for years before the Henderson application so show it, including that to which plaintiff's witness Davidson referred as showing this machine as built from the outset. Referring to pages 10 and 11 of this catalogue, it will be seen that the bolts or rivets are not in line with the uprights of the frame, but rest upon the bottom of the U, just as shown in the exhibits in evidence representing the Murray machine as manufactured by plaintiff.

After Davidson had testified to the Murray machines having been made by plaintiff since May, 1908, he was asked (p. 48, L. B. Rec.):

"The Murray type to which you have referred is correctly shown in Defendant's Exhibit 'C' on pages 10, 11 and 13, is it not?"

And answered:

"Yes, I would think it looks like the Murray type. I think it is."

See, also, illustration of this Murray machine, opposite p. 98, Plaintiff's Exhibit 6.

The Murray patent expressed preference for making the hoist frame of "angle iron" (first page of specification, line 58). When angle iron was used, it was equally convenient to put the bolt through the web of the angle iron of the frame. The convenience of having the U at the bottom, as already used in the prior Bowyer & Casperson patent, was evidently recognized by the constructive mechanic when they began to manufacture on a commercial scale. It introduced no change in function or mode of operation, and had no advantages in the Murray that it did not possess in the Bowyer & Casperson. In either case the cross-timber or put-log was positively attached to the hoist frame, so as to prevent their slipping apart; in each case a limited pivotal movement of the cross-log relative to the frame was permitted, though, in each case, when the timber was placed on the put-log, as illus-

trated both in the Murray patent and in the catalogue, excessive tipping was prevented. Any appreciable tipping of the platform involves danger, even when the put-logs are positively attached. These platforms are used at great elevations and carry articles which a slight tipping might cause to fall off with peril to those below; much tipping is perilous to those on the platform. Murray's object in connecting the "put-logs" or cross-timbers to the hoist frame by bolts or rivets was to exclude the danger of accident incident to allowing them to rest unattached on the bottom of the frames as in earlier hoists. The peril of having a cross-timber slip out when a platform was swayed by wind or tilted in hoisting was far more important than any convenience in using the cross-timbers unattached (which so impressed the majority of the Court of Appeals of the Eighth Circuit when the case was first heard there) and it is not probable the use without attachment would be permitted on modern tall buildings. If some patents fail to show means of attachment, it is because the particular means used was not any part of the invention, but left to the option of the user—not because it was intended to dispense with attachment. Henderson and Whitney used attachments when making their hoists for use (dep. Henderson, C. B., p. 155, A. 326-334; cut and description Whitney "Little Wonder," p. 269).

Pitou, plaintiff's witness, secretary of the Patent Scaffolding Company, testified that the scaffolding machines put into use under the license of plaintiff were marked as "rented, not sold"; also marked "Patent No. 854,959, May 28, 1907" (L. B. R., pp. 26-29); that the catalogue in evidence (Defendant's Exhibit C, L. B. R., p. 182) was put out by the Patent Scaffolding Company, of which he is secretary (licensee of plaintiff), in August, 1912, and a second edition in December, 1913; that this Murray machine shown in the pamphlet (corresponding to the Murray machine in evidence) was the one on which the award was made on November 21, 1910; that these ma-

chines, "as shown in these cuts," had been made and leased by his company two years or so prior to this award; that some of the earlier machines had used rivets instead of bolts, bolts being substituted sometime before the award was made (L. B. R., pp. 34-36).

Cavanagh, another employee of plaintiff, testified that the machine shown on pages 10, 11 and 13 (Defendant's Exhibit C, pp. 182 *et seq.*) is a machine which they have been installing since he has been with the plaintiff, that is, since August, 1910; that it is what they called the Murray platform machine, and they are set up as shown in the cut, the put-logs in line with the axis of the drum. This has been the custom all the time he has been with them (L. B. R., pp. 63-65).

Files of Patent Compel Limitation of Claims to Constructive Details Neither Patentable Nor Employed by Defendant.

Since the Court of Appeals of the Seventh Circuit in the Chain Belt case, while confessing that it could discover no substantial invention in the claims in suit, even when limited to the edgewise position of the hoist frame, and that it found nothing in the specification or claims referring to such edgewise positioning, and conceding that there was no invention in the claims unless so limited, justified its sustaining the claims limited to covering the first Whitney machine when placed edgewise to the wall (but excluding the "Little Wonder") upon the "*presumptive validity of the grant*" (see Rec., p. 267), it is pertinent before referring more specifically to the question of validity and infringement to inquire *on what this "grant" was based*. Certainly it could confer no presumption of validity in respect to a feature not asserted as the invention in the specification or claims, and excluded from any consideration as even an element in the invention by the amendments and arguments in the Patent Office, by which the Ex-

aminer was finally coaxed into allowing claims limited expressly to features which the defendants have not used, and so limited to distinguish from the prior patents upon which the claims had been rejected. If the distinctions expressed by amendments to the claims, and emphasized by the arguments, excluded the defendant's hoists in every respect that these limitations of the claims distinguish them from the prior art, there is more than a "presumption" against plaintiff. The grant of the patent certainly carries no presumption of patentability concerning features that the claims and the arguments exclude from consideration as any part of the invention.

This Court of Appeals of the Seventh Circuit was at the same time holding that there was nothing patentable in any of the distinctions between the Henderson hoist and the prior hoists defined by the claims as amended after rejection, and relied upon in the Patent Office as the pretext for granting the patent. It treated this, not as a reason for holding the patent invalid, but as a reason for holding that these limitations could be disregarded for the purpose of finding infringement, and then placed upon the Patent Office the responsibility for holding patentable what that Office "did not consider as representing plaintiff's invention, and what neither plaintiff nor its solicitors through whom the patent was obtained, ever suggested to be either original with Henderson or an element in the claims they were asking the Patent Office to allow. How radically the patent had to be reissued by the court to escape being held invalid, and how strangely it erred in supposing that, with the Henderson hoist, any "*saving of space*" (the one advantage which it thought might be obtained) was effected when set flatwise, is evident from a careful reading of the specification and claims and examination of the drawings, and still more so when these are read in connection with the files.

It will then be evident that just what all the judges who

have passed on this question have held *not patentable*, was all that was relied upon in the Patent Office to distinguish the claims from the prior art. An examination of both the Whitney hoists will then show that the claims could not have been drawn more explicitly to distinguish between them and what was asserted as the Henderson invention, if the Whitney (in each form in which it has been made) had been in the prior art; that such advantages as the court supposed Whitney possessed in common with the Henderson were either absent from the Henderson, and due to what distinguish the Whitney from the Henderson, or were not present in the Whitney or ever used by plaintiff, and had no practical advantage.

Limited as was the invention asserted by Henderson when he filed his application for patent, the entire application was rejected for want of novelty until he had reduced his claim of invention to forming the connection between the rotary drum and the scaffold by a *single bent bar, in whose bend the timber was laid and in whose upright arms the bearings of the drum or windlass were directly mounted*, and the argument accompanying the amendments and to which the Patent Office finally yielded asserted the invention to reside *in the reduction of the number of parts and the exclusion of attachments between parts thus secured*. It was argued that this conduced to economy and safety.

The specification, admitting that it was old "to use such hoisting means in connection with the cables on a scaffold to adjust the height as required in connection with the work" stated, as an object of the invention "*to construct in such manner a hoist or mechanism that it results in a maximum degree of security and a minimum cost of production.*" It then describes this as accomplished by forming the frame of a single bar bent into U-shape "adapted to pass around and support one end of one of the cross pieces," and supporting the drum upon which the cable was wound in bearings in the upright arms of this U-shape bar. While this was referred

to in the original specification as the "preferred" construction, the claims in suit were, after rejection, expressly limited to what was so described. After such description the specification proceeds:

"The hoisting mechanism just described is also adapted for use in connection with comparatively small scaffolds which are much narrower than the style of scaffold shown in Fig. 1. In this connection, one hoisting mechanism may be used at each end of the scaffold 21, as shown in Figs. 3 and 4. In connection with scaffolds of this type, it is generally desirable to locate a supporting timber 22 longitudinally of the scaffold 21 on its under side and substantially under the middle of the scaffold. This timber has placed upon it cross-pieces 23, upon which the floor 24 of the scaffold is laid. The frames 6 of the hoisting mechanisms in this modification are built to pass around the ends of the timber 22 to support the scaffold.

"From the above it will be seen that my construction secures the greatest possible amount of security, since the frame 6 passes around the supporting beams of the scaffold in such a way that no auxiliary means are required to secure the hoisting mechanism to the scaffold. Furthermore, the construction is made very simple, and the machines can be cheaply made on account of the small number of parts, and further on account of the single bar constituting the framework of the machine serving also as the bearings and bearing support for the hoisting mechanism."

Amendments and arguments show that the only improvement ultimately depended on to secure the claims in suit consisted in making this frame in a single continuous bar, bent in a U at the bottom, passing around the cross-timbers, the "*single bar constituting the framework of the machine, serving also as the bearings and bearing supports for the hoisting mechanism,*" and thus dispensing with any "*auxiliary means, to secure the hoisting mechanism to the scaffold.*" Each of the claims in suit is expressly limited to this feature, laying stress upon the fact that the single bar which was bent under the timbers constituted the frame-

work and bearing for the windlass shaft and crank-shaft, respectively.

The Patent Office rejected all the original claims on the Murray, Bowyer *et al.*, Sladek, Harpin and Crandall patents and the Howe patent of November 22, 1904 (L. B. Rec., p. 106; C. B. Rec., p. 192)). Bowyer *et al.* had the U-frame of the hoist "*extending around the underside of and upward from the associated beam,*" but attached brackets on these uprights to carry the bearing of the windlass.

The Examiner added:

"None of the claims are seen to present invention over Murray. To arrange this U-shaped frame with the closed end down so as to extend around the cross bar, would be obvious if desired."

The applicant, in response, did not intimate that the Examiner had not correctly understood the features asserted to constitute the invention, but amended the claims and emphasized the limitation to having this *continuous bar bent under the timber* made in a *single piece* and extended upward on both sides of the timber to afford bearings for the windlass and crank-shaft. The first claim was further limited by inserting after the word "around" the words "*the under side of,*" and what were then the fourth, fifth, sixth, seventh and eighth claims, by inserting between the words "*a metal bar bent to*" and the words "*support a beam of the scaffold,*" the words "*directly carry and*"; so that it read "*a metal bar bent to directly carry and support a beam of the scaffold and its ends extending upwards,*" etc. An additional claim was then submitted, which, with a subsequent minor amendment, became the present third claim, laying special stress still upon the U-shaped bar having the beams laid in the U-shaped bend and rotatable drum supported *between* the upwardly extending members of this U-shaped bar (L. B. Rec., pp. 106-7; C. B. Rec., pp. 193-4).

The argument that followed showed that the language so

reiterated in the claims and emphasized by the amendments was understood both by the applicant and the Examiner to define whatever invention was asserted, and that it consisted primarily and solely (so far as either of the claims ultimately retained is concerned) in having this single metal bar bent to form the U on which the timber rested extended upward to afford in the *same* bar the bearings for the windlass and crank shaft, thus avoiding the objections to the number of parts and *saving any attachment or connections of parts* between the bearings of the drum and the support of the timber, such as the attachment of the bracket carrying the drum bearings in Bowyer *et al.*, or of the cross-bar at the bottom in the Sladek, the Harpin and the Crandall. There is never a hint that the looseness of the joints between the hoists and the timber carried by them, or the positioning of the frame relative to the wall, was an element in the invention, or in either of the claims; there could not be, in view of the specification and drawings and the terms of the claims, or in view of the prior patents. The third claim was plainly drawn to equally cover the use of such a hoisting frame whether set in the position shown in Figs. 1 and 2 or that shown in Figs. 3 and 4, or in any other position, provided the frame was constructed as described in that claim, in contradistinction to prior hoists. The other claims would be equally responded to with it set in either position. The argument following this first amendment read as follows (L. B. Rec., p. 107; C. B. Rec., pp. 193-4):

"It is considered that each of the claims presented are allowable over the patent to Murray 854,959, the Examiner's principal citation, and in fact, any of the other references to which he has incidentally referred.

"It is the primary requisite of a device of the class to which this invention relates that it be secure, and all efforts are directed in this behalf. In a chain of parts between a primary support and the scaffold upon which a workman stands a number of connections are necessarily employed, and it follows that the security

of the device will vary inversely as the number of members in such a chain. Each connection employed makes another danger point, if such it may be termed, and it is the object of applicant's invention to make a desirable construction, so far as hoisting mechanism is concerned, secure enough to be practical and worthy of confidence. Claim 1 specifies that the U-shaped metal bar extends around the under side of the beam, while the ends thereof extend upwardly. Thus the connection between the U-shaped bar and the cross beam is absolute and positive, and no connecting rivets, bolts or other auxiliary means are employed. Hoisting mechanism is mounted directly between the ends which thus extend from the beam, and the desirable security is thus effectively realized.

"Claims 2 and 3 specify that the metal bar is formed around the beam. This is, of course, different from the Murray structure and it is submitted that it merits patent protection. Although claims 4 and 8 as originally filed may be considered in the light of the above argument, it has been thought wise to further specify that the metal bar is bent to *directly* carry and support the beam.

"Favorable consideration is urged."

The Examiner, in reply to this, said:

"In response to amendments of Nov. 15, 1909:

"The claims are seen to present mere colorable and mechanical variations over Murray as previously applied. At best they present no invention over Murray in view of Bowyer *et al.*, showing a frame closed at the bottom." (L. B. Rec., p. 108; C. B. Rec., 194.)

Applicant still introduced no mention of the position of hoisting frames relative to the building, or of loose joints, but further urged that the language of the claims plainly distinguished the *continuous frame formed of a single bar in one piece, so bent at the bottom as to form a continuous support for the timber and windlass bearings*, from a frame connected by *attached parts* or requiring other means of securing the timber to the frame. Claim 1 was further amended to emphasize this limitation, by inserting before the words "*U-shaped*

metal bar" the word "*continuous*," making it read "*a continuous U-shaped metal bar extending around*," etc. Claims 3 to 8, inclusive, were stricken out and the remaining claim renumbered as claim 3, with a slight verbal correction. To this was appended an argument, which stated (L. B. Rec., p. 109; C. B. Rec., p. 195):

"Claim 1 has been revised to more clearly and pointedly bring out the essential feature of the invention consisting of the structure of the windlass frame by which it directly supports the scaffold members and this without resorting to a complicated frame of built up structure but by the use of a frame consisting of a single bar of metal bent so as to support one end of a scaffold member without the need of securing such member thereto." (Italics ours.)

The amendment referred to as having this effect was the insertion of the word "*continuous*" before "*U-shaped metal bar extending around*," etc. A reconsideration of claims 2 and 3 was asked (L. B. Rec., p. 109; C. B. Rec., pp. 195-6)—

"since in each is recited the combination of the scaffold, its supporting members and the frames of the windlass in such a manner that the frames comprising bent U-shaped bars serve to support the scaffold directly and without need of fastening the scaffold supporting members to the windlass."

It was urged that upon an interview with the Examiner it had been pointed out—

"that the applicant's structure is much simpler, cheaper to make and more effective than any of the structures shown in the references, and further that none of the structures of the prior art are adapted to support the scaffold without either positively securing the windlass frame to the scaffold or using a complicated structure for the windlass frame. It was pointed out that the windlass frame used by the applicant consists of a single bar of metal bent in the form of a U, the bent portion receiving directly and supporting, without the need for securing to it, the supporting members of the scaffold and that the upwardly extending ends of the

bent bar receive between them and constitute the bearings for the drum of the windlass. It is thought that the claims recite combinations which are in accord with the suggestions made by the Primary Examiner at the interview mentioned and favorable action is therefore requested." (Italics ours.)

It was upon this argument that the Examiner was persuaded to give the applicant the benefit of the doubt and allow the claims, *each of them explicitly limited to the features thus described*, neither of them including any other distinguishing element, and each of them, by the terms of the specification, made to equally include a hoist having such a frame extended around the timbers and carrying the bearings for windlass and gears, without reference to whether used in one position or the other. If the defendant had composed its frame of the *continuous bent bar* upon which the timber could be supported without extraneous fastening, carrying the windlass bearings in the arms of the U, and *used its hoists in just the positions illustrated in Figs. 3 and 4 of the patent*, it would have infringed quite as unmistakably as if it had used them in the positions shown in Figs. 1 and 2. The court would then have treated as frivolous the argument that infringement was avoided by using the frames in one, rather than the other, of the two positions in which the patent illustrates them as embodying the invention—especially so when *every purpose asserted in specification and argument was dependent on this formation of frame and independent of which of the two illustrated positions it was used in*. Yet if the invention consists in what the claims state, and includes the use of the hoist in the several positions illustrated, it cannot be sustained as consisting in anything else, or be infringed by hoists which do not contain the specified construction of frame for which the claims were granted.

Unless the object of a specification and claim is to *conceal* the invention which it purports to *describe and define*; unless

the statutory requirement of specifications and claims is to be nullified, and they are to be converted into a delusion and snare, a means of imposition, there can be no justification for treating the definition of the invention in these claims as meaning nothing, and a subsequent conjecture of an advocate or a court, as to what might have been substituted for the specification and claims, as superseding their definition of the invention, to be used in destroying industries which have been built up outside the invention asserted by the patent. No extravagance in the abuses of the reissue law in times past has approached the wrong which would be done by thus judicially reconstructing a patent and making that reconstruction retroactive.

By the statement of the invention, the claims and the argument, it is made as plain as language can make it that the invention asserted by the patent resides in substituting for the hoist frames of prior patents *this continuous bent bar frame, affording in the single bar of metal the bearings for the windlass and the support for the timber*, thus giving to the whole the "*small number of parts*" and the *economy* so secured, as distinguished from a frame made of separate pieces, or connected by attached cross-bars, bolts or other means. If the purpose of the statute in requiring the explicit definition of the invention in the claims, and the law concerning their effect so often laid down by the Supreme Court, is to be abrogated, if the patent is no longer to be a guide for those who are seeking to ascertain what it covers, if the fancy of advocates is to supersede its terms and effect; if it is no longer true that a patentee is *so bound by his claims* that he can neither omit an element specified nor inject an element not specified, for the purpose of giving patentability or scope; if limitations emphasized in the files, and plainly used to differentiate the invention claimed from the constructions of the prior art, are to be disregarded; then patents become instruments for de-

ception rather than a means of informing the public concerning the nature of the invention claimed, and the allowance of claims by the Patent Office is worse than superfluous, since it passes only on the claims as expressed, and not on the fanciful claims that may be substituted by arguments of experts or counsel.

If the Patent Office had been asked to allow a claim which would express what the majority of the Court of Appeals of the 8th Circuit, in its first decision (practically rejected by it on its second decision, after having its attention directed to the terms of the patent and files, and its errors of fact in its former decision) and the Court of Appeals of the 7th Circuit, have assumed to be the invention, or what petitioner now argues is the invention, it would have been immediately rejected because plainly excluded by the terms of the specification as sworn to, because there was no evidence that it was the invention of the patentee, and because the use of such a hoisting device in either position did not change its function or mode of operation and was so obviously a matter of mechanical skill or convenience that it involved no invention. In any event, the public would have had notice of the assertion of such a claim and could have governed itself accordingly, and the defendant in any suit would have been informed in advance what invention was asserted and have an opportunity to meet the issue.

No Infringement.

The charge of infringement in the Liebel-Binney case is based on the admission in the answer that on the 20th day of May, 1914, defendant ordered from the Eclipse Scaffolding Co., of Omaha, Neb., some Whitney scaffold hoist machines and cable; that these machines were shortly afterwards delivered to defendant, and that at the time of filing the answer defendant was using the machines so furnished.

Under the decisions of all the courts these hoists did not infringe if used edge-wise to the wall, and petitioner has now conceded that their placement parallel to the wall is not an element in either claim of the patent, by arguing that the Murray hoists placed edgewise to the wall embody the invention covered by the claims in suit.

The bill against the Liebel-Binney Co. was filed Sept. 16, 1914, and the answer Oct. 3, 1914. As these hoists are capable of use in exactly the manner illustrated in the prior patents, including the Bowyer & Casperson and the Murray, and differ from Henderson in every respect the Bowyer does, and in other respects, and as there is no proof that they were used in any way prior to the filing of the bill, and the answer makes no admission concerning the manner of their use, plaintiff's charge of infringement assumes that the claims cover the hoists thus purchased, irrespective of the manner of their use. It necessarily rejects the theory upon which alone any court has sustained the patent, and all the decisions become for the purposes of this case uniformly adverse to petitioner. They all concur in holding that just the distinctions between the hoist frames of the prior art and the Henderson hoist frame recited in the claims in suit did not constitute patentable invention. All have held that the patent could not be construed as covering the "loose jointed connection between the put-log and the supporting frame," in which petitioner now asserts the Henderson invention to consist. They could do no otherwise, since this "loose jointed connection" was present in all the prior hoists to at least as great an extent as in the Whitney, and had long been used in the Murray before Henderson made his first sketch, (as shown by evidence hereafter cited). It is evident that mere proof of the possession, or even the use, of these hoists (resembling the Henderson patent in no respect that prior hoists did not

more closely resemble it) could not sustain the charge of infringement against Liebel-Binney Co.

Plaintiff called Pitou, an officer of the Patent Scaffolding Company (L. B. R., pp. 18-19), plaintiff's licensee, through whom it puts its patent scaffoldings upon the market (pp. 26-29), who testified that during the late summer or early fall of 1914, he had seen such hoists used upon the Place Hardware Building, at Erie, Pa., by the Liebel-Binney Construction Co., and that they were used with the frames parallel to the wall. He admitted in cross-examination that he cannot tell whether he saw this before or after the 30th of September; that when he saw it he was standing on the ground, and that the scaffolding was at the third story. (R., pp. 30-32.) He introduced a model which he claimed to have made about six months after having seen it. He could not testify concerning the details of construction, and evidently had made his model more with reference to impressions of what the construction might have been, influenced by what served the plaintiff's purpose in the present case, than from any definite examination or recollection (R., pp. 32-34). He had no personal knowledge that the hoists which he then saw belonged to defendant, or that defendant had any connection with their use, and bases his assertion to this effect upon what he says he was told by a person whom he did not know, and whose name he does not remember (R., p. 32).

If the manner in which these hoists were used, whether edgewise or parallel to the building, or the manner of connecting them with the timbers, be treated as an element in the claims, it is plain this testimony would not be sufficient to sustain the charge of infringement, and as the witness admits that it may have been subsequent to the 30th of September, 1914, that he saw these hoists (the bill having been filed substantially prior thereto), such testimony would not serve as proof of infringement prior to the com-

mencement of the suit. The fact that the defendant ordered such hoists carries no presumption of intention to use them in any different way from the prior hoists, and plaintiff's proofs already referred to show that substantially all the scaffold hoists, either at the time this order was given or prior or subsequent thereto, were used with the frame set edgewise to the wall and not parallel to the wall. It must be remembered that when the answer was filed and the admission concerning the purchase of these hoists made, it had never been suggested, either in the Henderson patent or by any opinion of any court, that the patent was at all concerned with whether the hoists were set edgewise or parallel to the wall, or depended upon whether the timbers were snugly or loosely connected to the bottom of the hoist frames, so that the admission made in the answer concerning the purchase of these hoists carries no implication that there was then, or at any time, intention to use the hoists in any different manner from prior hoists, which the subsequent opinion of the Court of Appeals of the Eighth Circuit held to be essential to infringement. The only decision then made was that of Judge Morris, before whom the first Whitney case had been tried, in the District Court, finding

“that the same claims are void, and that, if they were not entirely void, there would, under the very limited interpretation that must be given to them, be no infringement by any scaffolding which might be constructed with the defendant's device”,

ordering the bill dismissed with costs (L. B. R., pp. 28-29).

The burden is upon plaintiff to clearly establish infringement by convincing proof, and the question of infringement here presented rests entirely upon the purchase of the Whitney hoists, and whether such purchase was in itself an infringement. It may be presumed that defendant intended to use or sell these hoists, but not that they were intended to be used differently from prior hoists.

If the purchase of such a hoist would be an infringement, the purchase of the hoist of the Bowyer & Casperson patent would be much more clearly an infringement, for that has the continuous bent U frame passing under the timber (as defendant's has not), and it carries the rotary drum and crank operated driving gear corresponding to that of the Henderson patent, which the defendant's does not. The bearings for the rotating drum and crank gear are in the Bowyer supported in brackets by the upright arms of the U frame, the only difference in that respect between it and the Henderson being that the bearings are not "*between*" the arms of the bent U, but in *brackets attached thereto which support the drum at the side of the frame*. Defendant's is distinguished from the Henderson in other respects common to the Henderson and Bowyer. *This identifies it with the Bowyer in every respect in which Henderson's claims distinguished his invention from Bowyer*. The Whitney is distinguished from the Henderson in other respects common to the Henderson and Bowyer. In defendant's there is no rotating crank and no rotating drum having its bearings in the upright arms or operating as the drum of the Henderson patent. The frame of the hoist is a "*built-up structure*," involving the fastening together of more parts, and the interposition of more fastening devices, than either of the prior structures from which the claims and the argument in the Patent Office sought to distinguish the Henderson.

The "Whitney hoist" does not depend upon a drum to take up the cable on the frame, but provides a sort of ratchet operating clamping mechanism through which the cable can be drawn, which is so constructed that it clamps the cable and sustains the frame on the cable whenever the drum ceases to operate. The cable, therefore, while passing around the drum is not attached to it, and the drum does not, as in the ordinary windlass hoists, have to carry upon it the amount of cable that is wound up as

the hoist ascends the cable. This relieves it from a limitation and quite serious objection incident to windlass hoists of the Henderson and Murray type, which, as wound up, accumulate cable on the drum, thus increasing the distance from the center of the drum at which the pull is received and rapidly increasing the difficulty of winding, because every increase in this diameter reduces the advantage in leverage provided by the winding gear. This difficulty makes it necessary (as recognized in the Murray patent, and equally incident to the Henderson) after the platform has been raised a few stories to interrupt the operation and hold the platform there by other means until the hoist can be unwound and reattached at a greater elevation. A provision for this resetting at intervals was the only novelty accorded to the Murray patent, which recognized the general platform hoist construction as old. Defendant's hoists embodies an invention which dispenses altogether with this resetting and enables the hoist to travel up the rope indefinitely, while the rope, instead of being carried on the windlass, passes downward and hangs freely.

The frame of defendant's hoist is constructed of a large number of separate pieces of metal bolted or riveted together, and the transmission of the strain from the cable to the timber by the hoist is through so many more "members" in the "chain of connections" than in the hoists from which the argument in the Patent Office distinguished this "improvement" that defendant's hoist, in every respect that it departs from the prior art, departs in the opposite direction from Henderson. As in the Bowyer *et al.*, the rotating drum is set in a bracket to one side of the frame, instead of mounted in bearings in the U-frame or "between" its upright arms. Between these bearings and the support of the timber are more than half a dozen attachments and connections. The frame is "composite," each side bar being composed of two separate bars of metal bolted together, and, in turn, bolted

to a third bar of metal which extends from the lower end of these first two bars to the lower end of the frame, where it is connected by a kind of rivet connection with an attached cross-bar. The connections between the clamping device, by which the weight is sustained on the cable, and the attached cross-piece at the bottom are still more numerous.

Defendant's hoist has *neither of the elements* relied upon alike in the claims in suit and the argument in the Patent Office to distinguish the Henderson from the prior patents cited. The first four lines of the first claim read literally on the Murray prior patent, and the remaining lines relied upon to distinguish the Henderson from the Murray will read upon the Murray with a less stretch of the doctrine of equivalents than would be required to read it on the defendant's. Defendant has neither the "continuous U-shaped metal bar extending around the under side of and upward from the associated beam" nor a "hoisting drum rotatably supported by the side members of such bar." The first of these quoted clauses was used, as the files already cited show, to distinguish "*a frame consisting of a single bar of metal bent so as to support one end of a scaffold member,*" from a "*frame of built-up structure*" (see last argument before Patent Office). The word *continuous* was inserted by amendment after the claim had been rejected, in order to distinguish this bent U-frame composed of a single bar from hoist frames in which the supporting bar was attached to the side bars by "rivets, bolts or other auxiliary means," and it was urged in argument that the claims "specify that the metal bar is formed around the beam," that the security was obtained by reducing the number in the "*chain of parts between the primary support and the scaffold*"; that "each connection employed makes another danger point," and that it had been "*thought wise to further specify that the metal bar is bent to directly carry and support the beam.*"

The Office insisted that the claims presented

"mere colorable and mechanical variations over Murray as previously applied. At best they present no invention over Murray in view of Bowyer *et al.* showing a frame closed at the bottom" (rejection preceding last amendment and argument).

It had been insisted in the last preceding argument that by placing the bearings of the hoisting mechanism "*directly between the ends which thus extend from the beam,*" the desirable security was obtained. In the last argument, after urging the advantage of making the frame simpler and cheaper by forming it of this single bent bar and mounting the bearings of the windlass in it, thus "*avoiding a complicated structure for the windlass frame,*" the distinction between having the bearings of the hoist directly in the upright arms and having them on a bracket, as shown in the Bowyer *et al.*, was further emphasized as follows:

"It was pointed out that the windlass frame used by the applicant consists of a single bar of metal bent in the form of a U, the bent portion receiving directly and supporting without the need of securing to it, the supporting member of the scaffold and that the upwardly extending ends of the bent bar receive between them and constitute the bearings for the drum of the windlass."

It was on such arguments as these, interpreting each expression in the last half of this claim, as well as each expression in the third claim, in its most literal and restrictive sense, so as to hold it down to the exact construction of frame illustrated and described, that the allowance of the claims in suit was procured.

The third claim, unless every limitation in it is taken in its most restrictive sense, reads literally on the Bowyer *et al.* patent, from which, as well as the Murray, the above cited argument sought to distinguish it. It is only differentiated when the limitation to "*a drum rotatably supported between the pair of side members of each of said U-shaped bars*" is taken (as the Patent Office arguments above quoted show that it was intended to be taken) as limiting the claim

to a frame in which the drum is rotatably supported *between the upwardly extending side members* of each of "*said U-shaped bars*," instead of having the rotatable drum supported upon *brackets attached to the side members*. Each of these limitations expressly excludes the defendant's hoist, where the frame is composed of a greater multiplicity of parts than either of those from which the distinction was made; where there are many more intervening attachments between the bearings of the drum and the support of the timber than in the prior hoists; where there is no continuous bar connecting the support of the hoist with the support of the timber; where the cross-bar at the bottom of the hoist is made of a separate "member" from the side bars and attached to them by "auxiliary attachments," and where neither the *simplicity* nor the *cheapness* nor the avoidance of attachments, or of a "*built-up structure*" or of "*connections*" (each of which is alleged in the argument to make "another danger point") is obtained, either by means exhibited and recited in the Henderson patent or by any analogous means.

Petitioner has argued that the frame, *omitting all the elements relied upon to secure allowance, so emphasized in the claims, specification and argument*, is the equivalent for that containing them. This disregards the necessary significance of "equivalent." If the structure, omitting each of the limitations on which the claims rest, is the equivalent of that containing those limitations, it would follow that the claims were invalid, because based on immaterial distinctions. It would require less stretch of the doctrine of equivalents to include the Murray structure under the first claim, and either that or the Bowyer *et al.* under the third claim, than to include defendant's structure, and if any doctrine of equivalents is to be allowed it must be as broad with reference to anticipation as with reference to infringement. The limitations expressed in these claims are not mere acci-

dental or non-essential designations of appurtenances or incidents of the main invention. They are used to *define* the precise modifications upon which the claim of invention rests, and to which the franchise granted is exactly confined. We are not concerned with the question of equivalents, for that from which the *terms of the claims* were used to *differentiate* the invention asserted cannot be treated as the equivalent *for the purpose of such claims*, however they might be in the *absence* of such limitations. The boundaries thus fixed for the patent cannot be obliterated by calling what lies outside of these boundaries the equivalent of what is circumscribed within them. Where descriptive terms are used in referring to some of the *appurtenances* of the invention *rather than to that which specifically constitutes the invention*, an element which performs the same office by virtue of the same properties may be treated as an equivalent, even though it does not conform literally to the terms of the description; but when the terms of the specification and claims, and the proceedings in the Patent Office, make it clear that the *designation of the form of the device*, or of *any other characteristic*, is used to *define the invention asserted*, nothing can be treated as an equivalent which does not possess such specific characteristic. This is especially true when the terms of the claims are used to distinguish from devices cited from the prior art and the allowance of the claims is plainly predicated on the difference so defined, as is conspicuously the case here. To exclude from a claim limitations expressed and emphasized as the limitations of the claims here in suit are, for the purpose of subordinating to the patent devices that have carefully avoided the features to which the claims are restricted, would destroy the safeguard of requiring the examination and opinion of the Examiner concerning the patentability of the invention asserted before the public is asked to respect it, and make the oath to the patent required by statute entirely inoperative, since the conjecture of plain-

tiff's advocate or of the court may single out as the imaginary invention just what the applicant knew did not originate with him and could not have been supported by his oath, or just what the Examiner would have found not to be patentable. Such juggling with claims, for the purpose of subjecting to liability those who had respected their plain import, would be far more mischievous than the most extravagant reissue ever resorted to, since it would create judicial *retroactive reissues* to broaden the patent or change its scope without the safeguard of requiring a *surrender of the past term* and an examination of the Patent Office with reference to the scope of the reconstructed franchise asserted, and there would not be, as by the statutory reissue, notice to the public before anybody was required to respect it.

The reason why plaintiff and its licensees have never manufactured a Henderson hoist, have confined their manufacture of scaffold hoists to the Murray, and persistently used them set edgewise to the wall, is that, with the construction of hoist shown in the Henderson patent, or that shown in the prior Murray patent, there is a distinct *disadvantage* in dispensing with positive fastenings between frame and timber, and in setting the frame parallel to the wall. There would be such peril in placing the timbers on the bottom of the frame without positive attachment that no prudent constructor would take the risk of using them in tall buildings; and the manufacturer would lose the profit of furnishing the cross-logs with the frames if ordinary timbers laid on the bottom of the U-frame were used instead of those shown in the Murray patent.

With both the Henderson and the Murray hoist, as illustrated in their respective patents, the gear and crank depended upon to rotate the drum would occupy more space upon the platform, and be more dangerous to those passing, if the frame were set parallel to the wall, so that they pro-

jected out into the platform, than if it were set edgewise to the wall; and when set edgewise to the wall they could support the platform in close proximity to the wall, while, when set parallel, with the timbers laid on as shown in the Henderson patent, the edge of the platform must be a long distance from the wall—the reverse of what was assumed by the judges supporting the patent. This is necessary both to give clearance to crank and gear and to permit the cross-timbers the needed projection. The construction of the Whitney hoist, on the other hand, is such that the large gear wheel and the crank is dispensed with, and it can be placed close against the wall whether set edgewise or parallel, occupying in either position much less space on the wall or on the platform than the Henderson construction would occupy whether set parallel or edgewise. It is what distinguishes this Whitney hoist from the Henderson that enables it to be set close to the wall in either position and occupy little space on the platform. The cross-timbers must, in either case, in order to secure safety, be attached in some way to the frame, but this is a matter so plainly within the intelligence of any constructive mechanic as to require no mention in a patent. In the Whitney, as used, the side rods pass through holes or notches in the cross-timbers, and the cable through a hole in the center and through the bottom of the frame, and tie them snugly in place so that they cannot be removed without lowering them to the ground. This is equally true in the first Whitney and in the "Little Wonder." All the discussion by which the "Little Wonder" was held, in the second opinion of the Court of Appeals of the Eighth Circuit, not to infringe in either position would apply equally to the first Whitney. Neither of them ever can be or ever are taken into the top story. The presence or absence of an ordinary means of attachment for a purpose for which any farmer, or carpenter, or common laborer would understand that a means of attachment was required

would not confer patentability upon either hoist. It is enough that either defendants are not shown to have ever used any hoist in which the timbers were not positively attached to the hoist frame by some means.

The catalogues under which plaintiff's hoists are sold, referring as well to hoists as placed upon the market for years prior to Henderson's application as to those being placed upon the market since, adheres to the same attachment and the same arrangement of hoists that had been shown in the Murray patent, and had gone into use long before plaintiff acquired any interest under the Henderson patent, and before Henderson applied for his patent. There is no proof in the Liebel-Binney case that Henderson's invention was made prior to the date of his application (July 19, 1909), while the proof in the Chain-Belt case, elsewhere cited, shows affirmatively that it was not made until after Henderson had seen the Murray in the exact form which petitioner now alleges to embody the Henderson invention. Plaintiff's evidence shows the Murray to have been extensively on the market long before that, and to have retained control of the market since, with no change of any kind since plaintiff acquired the Henderson patent, and no material change since the Murray patent issued.

Petitioner argues that no force is to be given "consisting of a continuous U-shaped metal bar extending around the under side of and upward from the associated beam, and a hoisting drum rotatable supported by the side members of such bar"; that *continuous* has no significance; that the bar when not made continuous is an equivalent for a bar made continuous, and that it makes no difference whether the hoisting device consists of a *continuous U-shaped metal bar extending around*, etc., or a built-up frame made in many parts connected together by bolts and rivets and having the bearings of the drum elsewhere than specified; or whether it is set edgewise or otherwise, or connected with or without bolts or rivets.

The last paragraph but one of the specification makes it plain that the very essence of the invention asserted is in the "*small number of parts and further on account of the single bar constituting the framework of the machine, serving also as the bearings and bearing supports for the hoisting mechanism.*" The argument before the Patent Office, more particularly referred to elsewhere, shows that the changes were rung on this "*single bent bar*" affording all the points of support in itself and dispensing with all attachments; that the word "*continuous*" was inserted after rejection, in connection with an argument to the effect that this made clearer what was before sufficiently clear—namely, that by thus forming the bar and placing these several supports in the single bar, the cost of the frame was reduced, and the weakness in the chain of parts, due to having the several parts attached together, was avoided. This makes it as plain as any language can that this single continuous U-shaped bar bent in this form, constituting the entire connection between the hoisting mechanism (the drum and gear) and the timber, without any interposed attachment, was the very essence of each of these claims; that the language was used in antithesis to a "*built-up structure,*" such as the Whitney, and that plaintiff is concluded against the very specious argument by which it now seeks to escape these limitations.

Petitioner has argued that defendant's disputing the validity of the patent is an admission of infringement. It could as well argue that defendant's denying infringement is an admission of the validity of the patent. Hence, where a bill charges that a patent that is plainly invalid is infringed by a device that is entirely foreign to it, and the defendant denies both validity and infringement, plaintiff becomes entitled to an immediate judgment on the record. The advantage to a plaintiff in having a conspicuously invalid patent would be that it could obtain a judgment for infringement

against any device, no matter how remote, because defendant's denying both validity and infringement would entitle it to immediate judgment. The defenses of invalidity and non-infringement are not even inconsistent or conflicting, and here they are plainly both well taken. Rule 30 of the new rules in equity expressly authorizes the defendant to plead different defenses "regardless of consistency." Does this mean that each defense pleaded admits the invalidity of every other defense? In all the years that the Supreme Court has heard patent cases it was never discovered that a defendant admitted infringement by denying validity, or admitted validity by denying infringement. More than 95 per cent. of the cases it has heard have contained both these defenses.

Petitioner has argued that what is described in the patent and recited in the claims as constituting the Henderson invention is only the "preferred embodiment." If it were true (as it is not) that the specification had described the continuous bent U-frame as merely a preferred embodiment of the invention, and had described some other invention that was independent of this as the essential invention of the patent, it would still not justify disregarding either of the elements specified in the *claims* (which are often finally limited to what has been described as the preferred form), especially so when the argument before the Patent Office shows that they were intended to be taken in their most restrictive sense. Here the invention is alleged to consist in "*an improved form of hoisting mechanism.*" The improvement in *form*, reduction in number of parts, and exclusion of attachments, is all that is described, and the claims are in terms restricted to this. The specification *does not* represent this to be the preferred form of embodiment, but uses the term "preferable" *only with reference to whether the frame should be composed of "bar iron,"* the prior Murray patent having stated that its frame was "*composed pref-*

erably of angle iron." Henderson's patent was evidently drawn with the Murray patent and hoist before the draftsman, seeking every formal distinction, and, therefore, gave the preference to "*bar iron*." The context shows that the Henderson patent treated the use of the bent U made out of a single piece of metal passing around the timber and containing the bearings of the drum and gear mounted directly in its upright arms, so that no attachment occurred between these several points of support and so that the number of parts in the frame was correspondingly reduced, as the very essence of the invention asserted. This is only emphasized by the fact that the word "*preferable*" is applied solely to the use of "*bar iron*" in antithesis to the "*angle iron*" referred to in the Murray patent.

The stock phrase used by many solicitors immediately before the claims, to the effect that the patentee does not limit himself to the construction shown, cannot aid appellant to escape the rule that the omission of any element named in the claim avoids infringement, or overcome the effect of the specific limitations expressed therein. Where the invention asserted resides in such details as are mentioned in the claims, nothing is an equivalent *for the purpose of such claims* which omits them. The substitution of "*angle iron*" for the "*bar iron*," or "*round iron*" for the "*bar iron*" might be treated as an equivalent, and changes might be made in other details which would not avoid the patent, but nothing which omits what is represented *to constitute the invention*, and so *specified in the claims*, is an equivalent.

Petitioner's Comments on Bowyer Patent.

Petitioner has argued that the Bowyer patent is to be discarded because it relates to a "*painter's*" platform, and assumes that the Henderson relates solely to platforms used by masons. The Henderson patent has no restriction as to

the use to which the platform is put, nor has Bowyer. They each have platform hoists designed to be used in pairs and capable of being used to support a platform of any desired width or length. Neither claim of the Bowyer patent, or of the Henderson, is concerned with the use to which a platform is put.

When platform hoists which support and raise the staging on the outside of buildings first came into use, they were oftener used for painting than for other purposes, and therefore commonly spoken of as painter's platforms. The service they perform is identical, whether used by painters or masons. If Henderson had been the first to use them for the service of masons, instead of painters, this would not have been invention, but there is no pretense he originated this. The Murray and other prior hoists had long been used for masons' platforms, where they operated exactly as if a painter rather than a mason was to work on them. If the Henderson patent were valid, it would be equally infringed by similarly constructed hoists, whether used for a painter's stage, or any other, and the same applies to anticipation. See *Planing-Machine Company v. Keith*, 101 U. S., 479, 490, 491.

Petitioner also argues that the Bowyer has the plank held in place by an arm W, which passes over the plank cross the upper surface, and prevents it from being lifted from the spurs on the upper edge of the timber support; that this imparts "*rigidity*" and excludes the Bowyer from consideration. This is sufficiently answered by a glance at the Bowyer patent, which plainly shows (Figs. 1 and 3, and less plainly in Fig. 2) that the guide bar W is *supported in the frame considerably above the plank E*. It is near enough to help prevent the plank from being accidentally detached when the platform is tilted, but does not prevent a rocking movement or ready attachment and removal. It imparts all the advantage now asserted for Henderson. Neither the

spurs or guide bar would prevent the rocking motion, while they would contribute to "*security*" by lessening the liability of the plank slipping out and precipitating the platform to the ground below. They would not interfere with the rocking motion as much as the vertical rods of the Whitney and Little Wonder machines, projecting through the slots in the planks, and plaintiff has throughout asserted, and still is asserting, a charge of infringement against such construction. When the Whitney claims were rejected on the Bowyer and other prior patents, they were amended to differentiate from Bowyer, by laying stress on having the bearings of the hoist mounted in the upright arms of the bent U-bar (thus dispensing with the attached bracket used by Bowyer to carry these bearings), and stress was laid upon this in the argument, but it was not suggested that the presence or absence of the Bowyer means for preventing the slipping of the plank was material or novel. If the Henderson claims were valid no one could use the Henderson frame supplemented by the spurs and guide bar to prevent the planks from slipping out, and escape the charge of infringement. Plaintiff and defendants necessarily use some means of preventing the put-log from slipping out, and no prudent person would risk such a platform at a considerable height with the cross timbers resting on a perfectly smooth rod, with nothing to prevent their slipping out when the cross timbers were tilted in raising the platform, as they had to be with the Henderson.

Other Prior Patents.

The Sladek patent of July 19, 1898 (C. B. Rec. 337), and the Harpin (p. 359) illustrate other platform hoists, in which the cross-timber rests upon the bottom of the frame, and the platform is raised and lowered by winding the cable on the drum mounted in the frame, substantially as in the Hender-

son. They were cited against Henderson, and his specification and claims distinguished from them by the fact that their frames are not formed of a single metal bar bent into U-shape at the bottom, but have the bottom support *attached* to the side frames by connections involving a loss of economy in construction. The arguments urged this difference as expressed in the claims, just as the Bowyer had been avoided by the fact that the drum was carried on a bracket attached to the upright arms, instead of having its bearings in those arms. Each of these distinctions relied upon to escape the Bowyer and these other prior patents, exclude the Whitney as plainly as they do the prior patents from which they were discriminating the Henderson improvement.

Petitioner has argued that the Sladek patent has side bars resting in stirrups secured to, or made integral with, the hoist frames, and that the frame is a rigid structure. A glance at the patent shows that the frame is no more rigid than that of the Henderson patent, and that it would be no disadvantage if it were; nor has the rigidity of the *frame* any bearing upon the issue here. The frame differs from the Henderson in having the bottom formed by a cross-bar attached to it, instead of formed in a continuous bent U. In this respect it resembles the Whitney rather than the Henderson. The side bars referred to do not interfere in the slightest degree with the rocking movement of the timbers relative to the frame. They do not, in fact, come in contact with these timbers, but serve as a guard at the edges of the platform to prevent objects slipping off. They are laid in stirrups at the sides, which, irrespective of whether the stirrups are attached to the frame or cast integral with it, have no tendency to prevent the rocking movement referred to.

The timbers are shown as A, while these guard rails are on the outside of the frame. If such a guard were added to the Henderson platform, it would merely serve as an ad-

ditional safeguard, but the use of it would not affect at all the question of infringement of that patent.

If all that petitioner means is that the words "loose jointed" or "hinged connection" are not used in these prior patents, the same is true of the Henderson. It was equally an incident of these prior patents, and was not novel with the earliest of them.

Petitioner speaks of the timbers in the Harpin as clamped by "jaw 24." A glance at the Harpin (C. B. Rec., p. 258) will show that what is termed "jaw 24" is in no sense a clamp. It is simply a plain support for the under side of the cross-timber (see Fig. 3, where the timber is marked 1). In order to conveniently attach these jaws to the frame, they are formed in an L shape, the rivet or bolt passing through the frame into the upper arm of the L, holding them in fixed position substantially as the cross-bar at the bottom of each of the Whitney hoists is attached, except that, unlike the earlier hoists referred to, they only extend part way across, far enough to afford adequate support to the timber. They are not clamps. When used as shown in that figure and in Fig. 1, the timber is as free to rock relative to the frame as in the Henderson. There is a provision for preventing excessive rocking, and in this respect the Harpin is distinguished from the Bowyer and the Sladek. It was only possible to obtain the Harpin patent by limiting it to minor modifications made upon the prior patents. As illustrating how common these hoists were, see Crandall patent of August 22, 1905 (C. B. Rec., p. 380); Clark patent of May 7, 1901 (p. 343); Foster patent of June 21, 1904 (p. 351).

Both Whitney Hoists Essentially Novel and Exclusive of Henderson.

The Whitney patents under which the "Whitney" and the "Little Wonder" hoists are made (the first corresponding with Whitney patent No. 998,720, C. B. Rec., p. 397, and the second with the Whitney patent No. 1,114,832, p. 401) represent inventions strictly original with Whitney, and of great importance. They are not improvements upon Henderson, but proceed upon a principle which excludes the Henderson and introduces a different mode of operation; which makes possible some of the advantages which, in the first opinion of the Court of Appeals of the Eighth Circuit were erroneously credited to Henderson, but are impossible with the Henderson construction; and which introduces far more important advantages than the Henderson plan of construction excluded.

The invention of the first Whitney patent eliminated winding up the cable as the platform moved upwards, and enabled the hoist to creep up a cable of any length without increasing its load by taking up the cable below. The second Whitney patent improves the creeping mechanism of the former Whitney, excludes all winding mechanism, all taking up of cable, and all the gear rotating drum mechanism. It greatly reduces the space occupied by the hoist in either direction, enables it to be set close to the wall, whether edgewise or parallel, and in either position occupy but a small part of the space required by hoists operating on the Henderson plan. The hoist travels up a straight cable of any desired length, and does not have to be reset at short intervals, because it passes the cable through it instead of winding it up. It cannot be taken in at the upper stories (the supposed advantage which was originally relied upon to sustain the patent); nor is there any occasion to take it in, since it can travel down the cable without the inconvenience incident to the drum construction.

It dispenses with all outstanding gear and with the occasion

for the broad frame required where the load is to be wound up as in the Murray, Henderson and other windlass hoists, enabling the entire raising operation to be performed on a straight strand of cable, thus so reducing the width of the frame, and so reducing the space occupied by the frame, that it does not materially obstruct access to the wall in whichever position placed. Being operated by a lever, instead of, as in the Henderson, the Murray and other prior devices, by a crank-arm rotating crosswise of the frame, opposite hoists can be operated together. The operator would occupy the same position in working the hoist of this Little Wonder machine when set flatwise to the wall as he would in working the prior Murray hoist with its frame set edgewise to the wall, and a position at right angles to that he would occupy in operating the Henderson or the Murray when set with the frame parallel to the wall. The construction and function of the hoist is the same whether used in one position or the other, and the relative position is merely a matter of mechanical intelligence in the use of the hoisting device with such timbers as are at hand. The degree of "security" obtained depends on the efficiency of the clutch mechanism and the *positiveness* with which the cross timbers are attached to the frames—omission of positive attachments would be fatal to security.

The frame of the "Little Wonder" machine is composed of two straight vertical rods, spaced and held in alignment by "transverse and removable cross plates," through which these vertical rods pass and to which they are attached by nuts. These cross plates have perforations in their center through which the wire cable passes, and by which that cable is held and guided in alignment with the automatic clutches whatever the position of the hoisting frame may be. This enables the automatic clutch mechanism to climb up a straight cable maintained parallel with the face of the clutches, irrespective of whether the hoist is in vertical or inclined posi-

tion. These detachable cross plates are elements in constituting a guiding and supporting frame for the clutches and cable by which the hoist is enabled to crawl up or down the straight cable, and all winding or unwinding is eliminated. This construction and mode of operation is described in the second Whitney patent, and supplements the clutch mechanism in dispensing with all winding and unwinding of the cable. This excludes the "continuous U-frame" of the Henderson patent, and the "hoist drum rotatably supported by the side members of such bar," and makes possible the operation essentially novel with Whitney and excluded by the plan on which the Henderson is built. The original Whitney has a similar operation.

Petitioner urges that the Henderson patent was cited in the files of the first Whitney patent. It was the *latest of nine patents* cited in those files as illustrating the prior art (C. B. Rec., p. 227). It was not cited to meet any claim covering what plaintiff now asserts to be the Henderson invention, for there was no such claim submitted. It was not cited at all against the second Whitney patent. If any inference arises from the citation in the files of the first, it is that everything common to Whitney and Henderson was shown in eight patents earlier than the Henderson.

Petitioner has alleged that the substitution of the "Little Wonder" for the original hoist was an admission that the Whitney was an infringement. The substitution was made in 1913, the application for the second Whitney patent having been filed in that year. The reason for the substitution or rather the incorporation of the improvements of the second patent (for the second is an improvement upon the first), was that the inventor naturally preferred to make the machine in its improved form. Nobody had at that time suggested the theory on which infringement is now charged, and it would be quite impossible for petitioner to indicate what change upon the first to the second form was dictated by a purpose

to escape infringement of the Henderson patent, or represented an effort to escape infringement.

Henderson Specifically Anticipated Under Petitioner's Present Interpretation.

The Murray patent No. 854,959, of May 28, 1907, before referred to (C. B. Rec., p. 387, L. B. Rec., p. 114), which is not to be confounded with another Murray patent of different date, shows in the first figure a longitudinal view of the scaffold with the hoisting device in place, and in the second figure a cross-section of the same platform; Defendant's Exhibits 13 and 14 (C. B. Rec., p. 236) show a perspective and end view, as this was built and used by plaintiff both before and since Henderson claims to have conceived of any invention in this art. It has the "loose joint" formed exactly as petitioner claims to be an embodiment of the Henderson invention. This is the construction of Murray used under plaintiff's authority in building the walls of the Blackstone Hotel in Chicago in the winter and spring of 1908-09, and which Henderson went to examine after he had been requested to get up a hoist which would serve the same purpose as the Murray, and would not have to pay the heavy tribute which was being exacted by the owners of the Murray patent, who were refusing to sell their hoists outright (C. B. Rec., dep. Henderson, p. 125, A. 1 to 46; dep. LaBelle, p. 165, A. 1 to 133; dep. Henderson, p. 175, A. 1 to 11; Henderson's sketch, p. 242).

This Henderson sketch on page 242, which shows nothing about the relative placement of the hoist, or about the "loose joint," was handed to the solicitors, as showing his supposed invention. They evidently consulted the Murray patent to see what it covered and wherein the Henderson sketch could be distinguished from it, but did not have their attention called to the structural differences between the frame used in

the commercial structure of Murray and that illustrated in the Murray patent. The Murray patent, while showing exactly the same relative position of the hoists and platform, showed the "put-log" (which extended in the same direction in Fig. 1 of the Henderson patent) attached to the bottom of the frame by bolts (one bolt extending through the bottom of each hoist frame), having quite as much pivotal or rocking movement as in the present Murray construction, but the Murray patent claimed no novelty in the means of attaching the put-log to the frame, and its claim was limited to providing a plurality of outriggers vertically, one over the other, and the means of hanging the hoist on the lower outrigger when the cable was being connected to an outrigger higher up. The purpose was, when dealing with tall buildings, to hang the hoist on a lower outrigger, which would be reached by the cable of a length that could be conveniently wound up on the drum, and to hook the hoist on to the lower outrigger by means independent of the cable when unwinding the cable sufficiently to attach it to the next higher outrigger. This was needed where using a hoist of the type of either the Murray or the Henderson (or any hoist which was raised by attaching the lower end of the cable to a drum and winding it up on the drum), since it was impractical to carry on the drum sufficient cable to reach the top of high buildings, without making the drum so large and the load carried by it so heavy as to be inconvenient. It is one of the merits of the Whitney invention that it dispenses with such winding up, and enables the hoist to travel up the cable to any desired height without adding to its load. The Murray patent concedes the hoist and the means of supporting the platform upon it to have been old at that time. It could not do otherwise in view of the Bowyer *et al.*, May 1, 1888; Sladek of July 19, 1898; Harpin of June 28, 1904, and Crandall of August 22, 1905.

This Murray construction which Henderson had seen before

conceiving his supposed invention is identical with what petitioner now asserts embodies the invention covered by the two claims in suit, and must therefore invalidate these claims. This is also the identical construction shown in plaintiff's catalogue put out in August, 1912, as representing the Murray hoist alleged to have been on the market at that time for five years, and to have gone into use to the extent of 8,000 machines, and to have been used on many of the principal buildings of the country, including the Blackstone and La Salle Hotels in Chicago (Exhibit C, C. B. case, included also in the L. B. Rec., pp. 182 *et seq.*, see especially pp. 4, 5, 10, 11, 13, 15 and 25 of catalogue following p. 182, C. B. Rec.).

Its use on both these hotels prior to Henderson's conception of any invention in this line, and that it had been seen by Henderson before he attempted to provide a substitute which could escape the Murray patent, was conclusively shown by un rebutted evidence in the Chain Belt case, confirmed by plaintiff's publications, and by the testimony that Davidson, Pitou and Cavanagh gave in the Liebel-Binney case. It was within the power of plaintiff to absolutely rebut this testimony if it had not known it to be true, and the District Court offered it an opportunity to do so after the trial if it desired to (C. B. Rec., p. 182), though it related to the hoists made and used by plaintiff directly inconsistent with plaintiff's contentions, concerning the significance of which plaintiff already had notice by the cross-examinations in the Liebel-Binney case. It plainly was a fact plaintiff was seeking to suppress. It knew that it could not be rebutted. When asked if the Murray device was giving satisfaction, Davidson testified (L. B. Rec., p. 52):

"We think we have been giving pretty good satisfaction ever since we started. We have revolutionized the business."

The Court of Appeals in the Chain Belt case found as a

matter of fact that this use prior to Henderson's conception had been established. It said (C. B. Rec., p. 267):

"The evidence fairly established that in 1908, prior to Henderson's invention date, appellee, who owned the Murray and other patents for scaffolds, and had built up a large business in the supplying of scaffolds for the erection of high buildings, had furnished for the erection of the Blackstone Hotel at Chicago, scaffolds in which there was the U-shaped bar frame similar to that of Henderson, but with putlogs composed of two angle irons bolted together, the U frame extending down between them, and the connecting bolts resting on the top of the under web of the U, the floor boards of the scaffold being, as in Henderson, laid parallel to the building. This employment of the U bar did not change the position of Murray's machines, which, as shown in his patent drawings, was at right angles to the building."

Petitioner is thus confronted with the unanimous holding of the Court of the Seventh Circuit, that the definition of the Henderson invention to which it has now resorted, renders it invalid because of precise anticipation by plaintiff, whose machines were marked under the Murray patent, not under the Henderson. The Court of the Third Circuit has unanimously held the patent invalid, and the Court of Appeals of the Eighth Circuit has unanimously held that the patent could not be sustained as covering what petitioner now asserts to be the Henderson invention.

Petitioner in its brief for the Courts of Appeals of the Third Circuit and Seventh Circuit, referred to the Murray hoist as "junk," and applied the same term to the Cavanagh. The records show without conflict that both the Murray and the Cavanagh continued to be manufactured and marketed by plaintiff, or those acting under its license and authority, down to the present, while nothing that corresponds to the Henderson in any respect that it differs from prior hoists has been manufactured since plaintiff acquired title to the Henderson patent on May 12, 1911, buying out Henderson to get out of the way a competitor who was selling hoists outright, instead

of renting them at an exorbitant price, as plaintiff did (see dep. Henderson, C. B. Rec., p. 133, A. 57 to 76). "Junk" is the term that Davidson had applied to the Henderson hoist, while extolling the greater merits of the Murray.

Under cross-examination, he admitted that the Murray was known as the "*Gold Medal Scaffold*," because it was awarded a gold medal in 1910 on account of the record it had made in saving human life (C. B. Rec., p. 98, A. 12 to 27). He had already testified under cross-examination in the Liebel-Binney case that the New York Scaffolding Company was manufacturing this Murray type in May, 1908, and had been ever since (L. B. Rec., p. 50), but had evidently been cautioned to forget this before the testimony was taken in the Chain Belt case. Plaintiff there took the precaution (admonished by the cross-examination in the Liebel-Binney trial) not to put upon the stand witnesses who had been connected with its manufacture during the years immediately preceding the application for the Henderson patent.

Petitioner has to meet this dilemma; if, as it asserts, the loose joint between the timber and the hoist is necessary to success, the phenomenal success which its catalogue attributes to the Murray for the five years preceding August, 1912, necessarily means that it had the loose joint (and no construction of the Murray without a loose joint has ever been exhibited, while the Murray patent plainly shows a construction that would result in a loose joint); if plaintiff were using the Murray without the loose joint down to the time it bought the Henderson patent on May 12, 1911, the more than eight thousand hoists it had put into use, making such a phenomenal success as to secure the gold medal on their record, must have been "junk." The loose joint had been shown in all the patents prior to Murray, and it is inconceivable that, if there were any advantage in the loose joint, plaintiff would have put the Murray out for years so snugly bolted as to prevent the desired play. The evidence is overwhelming to the effect

that it had all the play prior to the Henderson that it has had since. If it employed rigidity at any time, it was as a departure from the prior art, and on the theory that rigidity was desirable. The obvious fact is that any tilt of the platform is undesirable, and that the present Murray construction allows rather less than was provided in patents prior to Murray. Plaintiff has no patent on a rocking connection between timber and hoist, and could not have obtained one.

If plaintiff, in its manufacture, put the rivet in tight, it did so, not because its mechanics were so stupid as not to know the relative advantage of putting them in tight or loose, or of using rivets or bolts, but because it favored the argument to the trade that "safety" was secured by riveting them snugly instead of bolting loosely or leaving them unfastened. The *security* so much advertised was obtained by *excluding* laying the cross timbers loosely on the bottom of the hoist, as had been done before and is assumed to have been done by Henderson. This looseness involved immense peril when such hoists are used on high buildings and overcrowded sidewalks, and to avoid it was from the outset, and is still, plaintiff's purpose in so attaching the put-logs that the cross timbers cannot be put on as contemplated by Henderson. Certainly his patent never suggested such an attachment as that which plaintiff now employs.

No Conflict of Decisions Concerning "Little Wonder."

These cases are brought here on the ground of conflict between the circuits. That conflict relates only to a question whether the Third Circuit was right in holding the patent invalid and not infringed by the Whitney hoist, or the court of the Seventh Circuit in the relief it gave in respect to the first Whitney hoist. There is no conflict between either of the circuits concerning the fact that the "Little Wonder" does not infringe the patents in suit; or the fact that the first

Whitney machine does not infringe unless placed edgewise to the wall; or the fact that the patent cannot be supported if confined to just what the claims, read in connection with the files, indicate was the invention they were designed to assert, if the effect be given to the limitations relied upon to differentiate from the prior art. The primary question is whether the Third Circuit was right in holding the patent invalid and not infringed by either Whitney construction in any position, or the Seventh Circuit right in granting the relief it did in respect to the first Whitney machine when used edgewise. There has been entire unanimity in refusing to sustain the patent as covering the "loose joint" between the timber and frame. The patent so interpreted is precisely anticipated according to the unanimous opinion of the Court of Appeals of the Seventh Circuit. Henderson has no claims covering such a joint, and never intimated that it was original with him. It was the common incident of the prior hoists, wherever the timbers were laid on the bottom of the frame of a pair of hoists, and was used in the commercial Murray machines which Henderson saw before undertaking to design any hoists. It served no novel purpose, and was recognized as old by the earliest patents in evidence. It was an obvious mechanical expedient, destitute of invention. There would have been less looseness of joint or rocking motion of the timbers relative to the frame in the Whitney hoists as used in practice with the side bars of the frame entering the slots in the timber, than in the Murray made exactly as shown in the Murray patent.

There was no proof that either the Liebel-Binney Company or the Chain Belt Company ever so attached the cross logs to the frame as to permit rocking motion, or ever saw them so attached. The frames are hung on cables. Any tilting movement required is afforded by the cables, even if there is a rigid attachment between the frame and the timbers. It has been urged on behalf of plaintiff that tilting of the frame

would cause the cables on the drum to cross each other and this would be objectionable. If so, this marks another distinction between the Henderson and the Whitney, in both forms in which the Whitney has been made, since the cable is not in either form of the Whitney, accumulated on a drum and no such crossing can ever occur. No rigidity of joint and no looseness of joint can, in the Henderson, prevent the suspended frame from being tipped out of the vertical whenever the tilt of the platform is sufficient.

Whitney's Relation to the Liebel-Binney and Chain Belt Cases.

Petitioner is in error in stating that Whitney has made no answer in the Liebel-Binney case. He appeared there, not for the purpose of litigating the issues between him and plaintiff, which were already the subject of a decree in the Eighth Circuit, where the identical machines used by the Liebel-Binney Company were being accounted for, but for the purpose of seeking relief against the injury to him caused by the malicious prosecution of his vendees, and to aid and protect these vendees against the attack made on them. The answer of these vendees was the only answer needed, so far as the issues under that bill were concerned. There can be no reopening in another district of the issues already adjudicated or in process of adjudication in the Eighth Circuit.

Whitney, however, in his petition prayed that he might

"be made party defendant herein, and that the answer of defendant now on file be treated as and for the answer of petitioner, and that the petitioner may be permitted to defend this cause as a party defendant" (L. B. Rec., p. 73).

The court, pursuant to this petition, ordered that he be "*made party defendant herein as prayed for in his petition for intervention*" (L. B. Rec., p. 80).

This made the answer on file his answer to the bill against

the Liebel-Binney Company, which was all that could be necessary in any aspect.

In the Chain Belt case he appeared for a similar purpose, the Chain Belt Company having merely been employed by him to manufacture the hoists, and having had nothing to do with setting them up, and, so far as appears, no knowledge of how they were set up. They were the same hoists for which he was under an order to account in the Eighth Circuit, and there could be no further relief against him because of them; nor could the Chain Belt Company be held as infringers for making the machines if the invention resided solely in the manner of connecting them with the timbers or placing them relative to the building, since it does not appear that they had any part in or knowledge of how they were to be used. The hoists themselves did not differ from the prior hoists in any respect that is material to the question of infringement on either of the theories upon which plaintiff has attempted to assert it. Hence making them did not constitute them contributory infringers.

Whitney did in that case join in the answer of the Chain Belt Company, but this could only be for the purpose of meeting the issues asserted against that company, not for the purpose of relitigating the questions determined, or under process of determination, in the prior suit against him in the Eighth Circuit. Plainly, when plaintiff elected to sue Whitney in the Eighth Circuit and had carried this case to a decree there and was still prosecuting an account against him there, that case concluded it against seeking relief against him in another court for the same cause of action, but did not preclude him from assisting his employes or vendees in resisting the attacks made upon them, or in any way affect his relation to the original suit; nor could any further injunction or account be obtained against him there in respect to the same infringement which was the subject of adjudication in the former suit.

Law of Infringement.

In *McCarthy v. Lehigh Valley R. R. Co.*, 160 U. S., 110, the Supreme Court had directly before it the question whether it could read into the claims a mode of combining the elements there described, which would have given patentability, but which was not specified in the claim. The case for plaintiff was there much stronger and more plausible than here. There was evidence to show distinct advantage in using the combination of elements recited in the claims in the relation described in the specification, but not mentioned in the claim. There the patentee had not, as here, illustrated the elements as used with and *without* the qualification which it was proposed to read into it, but only as used with it. The bolster mentioned in the claim was shown and described as resting upon the springs in the side trusses, and there was evidence to show that this gave to the combination a distinct advantage which the defendant had appropriated. The Supreme Court, refusing to read in this mode of supporting the bolster as an element of the claim, said (p. 116):

“There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are so described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim and avoid a defense of anticipation, we should never know where to stop. If, for example, a prior device were produced exhibiting the combination of these claims *plus* the springs, the patentee might insist upon reading some other element into the claims, such for instance as

the side frames and all the other operative portions of the mechanism constituting the car truck, to prove that the prior device was not an anticipation. It might also require us to read into the fourth claim the flanges and pillars described in the third. This doctrine is too obviously untenable to require argument."

The court also held that formal limitations introduced to distinguish from prior devices were binding, irrespective of whether they expressed invention, and that changes from the construction and arrangement shown in prior devices within the skill and judgment of ordinary mechanics did not impart patentability, though conceded to be useful (pp. 118-119).

In *Keystone Bridge Co. v. Phœnix Iron Co.*, 95 U. S., 274, the patents in suit related to iron truss bridges. In their claims for a combination of elements they defined one of the elements as "wide, thin eye-bars, of wrought iron." The court held that they were not at liberty to disregard this limitation on the contention that the real invention resided in other parts of the combination and that cylindrical bars would serve the same purpose and be equivalents in the combination. It said (p. 276):

"Words cannot show more plainly that the claim of the inventor does not extend to any other eye-bars or chords than such as are made wide and thin, and applied on edge. As those constructed by the defendant are cylindrical in form, only flattened at the eye for insertion between the ribs or projections of the posts, it is plain that no infringement of this claim of the patent has been committed."

It applied the same rule to the second patent. It could have been argued with much more reason there that the defendant's bar was an "*equivalent*" of that described in the patent than it can be argued here that the defendant's construction is an equivalent of that defined in the claims in suit. The language of the court applies with cumulative force here. It added (p. 278):

"When a claim is so explicit, the courts cannot alter or

enlarge it. If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. They cannot expect the courts to wade through the history of the art, and spell out what they might have claimed, but have not claimed. . . . As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public."

In *White v. Dunbar*, 119 U. S., 47, the original patent and the reissue were for a process of preserving shrimps and preventing their discoloration. One element of this process named in the original patent was "placing the textile fabric between the can and its contents." The patentee had reissued this patent to substitute for the term "textile fabric" the term "enveloping material for the shrimps, which is not itself capable of discoloring the shrimps." This only included equivalent elements of the same character as that for which it was substituted, and was intended to make the invention claimed commensurate with that described in the specification by not limiting it to the exact terms of the original claim, the contention being that any material placed between the can and its contents that would not discolor the shrimps was at this stage of the process the equivalent of the textile fabric. The Supreme Court held that such amendment rendered the reissue invalid and dismissed the bill, saying (p. 51):

"Some persons seem to suppose that a claim in a patent is like a nose of wax, which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making

the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further. See *Keystone Bridge Co. v. Phœnix Iron Co.*, 95 U. S., 274, 278; *James v. Campbell*, 104 U. S., 356, 370."

See, in this connection, *R. R. Co. v. Mellon*, 104 U. S., 112; *Railway Sup. Co. v. Elyria Iron Wks.*, 244 U. S., 285; *Grinnell W. Ma. Co. v. Johnson Co.*, 247 U. S., 426.

The doctrine of *Fay v. Cordesman*, 109 U. S., 408; *Mahn v. Harwood*, 112 U. S., 354, 359; *Shepard v. Carrigan*, 116 U. S., 593, 597-8; *Corbin Cabinet Co. v. Eagle Lock Co.*, 150 U. S., 38-40; *Hubbell v. U. S.*, 179 U. S., 77; *Comp. Scale Co. v. Automatic Scale Co.*, 204 U. S., 609 and many other cases holding that limitations in the claims used to define the invention, or to distinguish from devices in the prior art to which attention has been directed, must be given their full effect as limitations upon the patent, irrespective of whether they were essential or non-essential to the invention exhibited, would be altogether nullified by petitioner's contention here, which none of the cases cited by petitioner support. In most of the above cases it would have been much more plausible than here to argue that the article without such limitation was the equivalent of the one with it. Nothing is an equivalent which does not embody the *departure from the prior art defined by the claim*.

The Several Decisions.

Eighth Circuit.

In the Eighth Circuit, as in the Third, the district judge before whom the case was tried in open court held the patent invalid and so restricted that it would not be infringed. Upon appeal in the Eighth Circuit one circuit judge agreed

with the court below; the other circuit judge and district judge sitting in the Court of Appeals held there was no patentable invention in substituting a continuous open U frame passing under the timber and carrying the bearings of the windlass in its upright arms for the "*built-up frame*" of prior hoists (the only pretense of invention for which the claims were allowed), but, instead of finding the patent invalid for that reason, accredited Henderson with having secured some advantage by setting the frame broadside of the wall instead of edgewise, read this feature into the claims in lieu of what was expressed in them, and held them valid as covering the Whitney hoist *when thus placed*, but only when thus placed (224 Fed., 452-463). An application was made to this court for a writ of certiorari, but, the decree being merely interlocutory, and there being then no conflict between different circuits, the writ was denied apparently without consideration of the case on its merits.

The majority opinion of the Court of Appeals of the Eighth Circuit, though by a judge of recognized ability, seems to have proceeded upon assertions made in the argument for plaintiff, rather than upon careful examination of the patent and files and definite knowledge concerning what plaintiff and defendant, respectively, had done. It states many propositions of law about which there is no dispute, and cites numerous authorities to support them, but, in order to bring this case within those propositions of law and decisions, it assumes premises excluded by the proofs there, and more plainly by those in the present cases. Its recital of what Henderson sought to accomplish was not taken from the patent, which plainly states that the invention "*relates to a new form of hoist*," and the object of the invention to be "*to construct such a hoisting mechanism in such a manner that it results in a maximum degree of security and a minimum cost of production*." This was further summed up at the end by describing the invention as consisting in using

the single bar of metal bent so as to pass around the supporting means and carry the bearings for the windlass, dispensing with "auxiliary means of attachment."

The advantages stated to be secured by the invention were that—

"the construction is made very simple, and the machines can be cheaply made on account of the small number of parts, and further on account of the single bar constituting the framework of the machine serving also as the bearings and bearing supports for the hoisting mechanism."

This was followed by claims *exactly limited to this construction*, obtained only after arguments in which it had been emphasized and insisted upon as the distinction between the Henderson construction and the prior art.

The court then lays stress on the advantage of having the "floor pieces" *"detachable without removing rivets or fastenings of cross-pieces to the frame, or of the floor pieces to the cross-pieces, to the end that the combination could be easily and quickly knocked down, removed and set up again in another place."* If this were a correct description of any invention asserted in the claims, it would seem obvious that to make such a construction so that it could be conveniently put together and knocked down, by merely omitting ordinary fastenings, or even by using common means of attachment, was not invention. Some of the prior hoists had this capacity, and any claim for it must have been refused. It should be enough here that Henderson did not originate this, and that Whitney has not in this respect departed from the prior art, but *rivets a separate cross-piece to the bottom of the frame and then so attaches the timber to the frame that it cannot be as quickly knocked down or taken apart as the devices upon which the patent had been rejected, and from which the language of the claims differentiated the asserted invention*; while the support of the floor on the bottom of the

frame was shown in prior patents and used in prior platform hoists.

That what the court dignifies by the name of "*principle*" is not present in the Henderson construction (where there would be more obstruction with the hoist set "broadside to the wall" than with it set edgewise); that dispensing with fastenings between the timber and the frame would be so perilous that fastenings were always used; and that the advantages which the court attributes to taking in the platform at the top are excluded by both Whitney hoists, and that this feature is not the subject of either claim, but practically disclaimed, has already been shown. This so-called "*principle*" falls fairly within the denunciation of the Supreme Court in *Duer v. Corbin Lock Co.*, 149 U. S., 216, where the argument was earnestly pressed that the patent involved a radically new idea, solved a new problem and constituted a material advance in the art. The Supreme Court held that this solving of a new problem was only the exercise of ordinary mechanical intelligence and not patentable, saying (p. 223):

"His 'radically new idea of making the mortise as deep as the width of the projecting selvedge and of cutting out the selvedge at its ends,' as claimed by his counsel was such as would have occurred at once to an ordinary intelligent mechanic who had the previous devices before him. To speak of these trifling variations as involving months of labor, thought and experiment, is a misuse of words."

This case is distinguished from *Duer v. Corbin Lock Co.* by the fact that in that case there was proof that the invention claimed had been extensively adopted and had real utility, while here there was no evidence of the imagined invention having superseded the devices of the prior art, but, on the contrary, it has been discarded and is not used by the plaintiff, or shown to have been used by defendants. There is no such element as placing the frame "broadside to the wall of the building" mentioned in either claim,

and the specification excludes any distinction of this kind, representing that in either position it equally embodies the invention, the terms of the claims emphasized by the file-wrapper limiting the invention to what this opinion treats as *not patentable*.

The opinion proceeds to indicate that the patentee devised the use of a drum carried in the frame of a hoisting device with the cable depending from the overhanging portions of an outrigger or some point of attachment above; whereas the prior art here in evidence, as well as the specification and claims of the patent, show that he devised nothing of the kind, but copied from prior platform hoists. See:

Railroad Sup. Co. v. Elyria I. & S. Co., 244 U. S., 285.

Grinnell Washing Ma. Co. v. Johnson, 247 U. S., 426.

The court said:

“If there was no improvement in the combinations of Henderson, if the combination of Murray, or of any other patentee, was in effect the same as and equally useful with Henderson’s why did not the defendant claim and use it?”

The answer might well be, *first*, that the defendant did not use the Murray for the same reason that he did not use the Henderson, that is, because he had a better structure than either, and one that was more original than either; *second*, that the defendant did not “*claim*” the Murray construction because he knew it to be old; *third*, that he having abstained from using what Henderson *claimed*, these questions are irrelevant. If such an argument as this afforded a reason for holding a patent valid and infringed, it would have compelled the reversal of most decisions of the Supreme Court in which a patent has been found invalid for want of invention, or not infringed.

The opinion says that the frame of the hoisting device was “*preferably*” formed by bending a piece of iron bar into the form of the letter U, the lower end of which passed around

and supported one end of a cross-piece without being fastened there. It hardly seems possible that the court could have used this expression if it had looked at the files, the prior art, or the language of the claims, as defining the invention, rather than to plaintiff's argument, for they show conclusively that *each claim* in suit is specifically limited to and founded upon *just the features* which the court speaks of as "preferable." In the specification, the word *preferable* is used *not with reference to the forming of the frame by making it out of one piece and bending it into the U-shape*, supporting both the hoisting mechanism and the timber *directly by this single "member" without intervening attachments* (which is insisted upon as the essence of the invention) but is used only with reference to whether "*bar iron*" or *angle iron*, or some other form of iron, shall be used for bending into this shape. There is nowhere an intimation that any construction that does not have the frame formed of one continuous piece bent in the way described would be within the claims, and the claims themselves are conclusive to the effect that they rest on this distinction. If the word *preferable* had been used as applying to what is described as *constituting* the invention, it would have been controlled by the language of the claims. Where a specification describes both a preferable and a less desirable manner of making a device, *claims limited in terms to what is described as the preferable method* must control, especially so where it is shown that the claims which were not so limited were stricken out upon reference, and only claims limited to the preferred form insisted upon and allowed, and this on arguments which based the assertion of the invention on what distinguished the preferred form from other forms. Here the fact that a preference is suggested as to the *material* used, but not as to the *form of the frame* (in which the invention consists), adds to the significance of the limitations to this form. It does not nullify those limitations. Some of

the claims originally submitted were not in terms limited to the continuous frame in U-form, but those claims were all stricken out on rejection, and those that referred to this were still more specifically limited to this form, the economy and security referred to in the patent being attributed to the use of the single bar to form the frame, not to placing the frame "broadside to the wall."

In assuming great utility for this construction the court overlooked the fact that *positive fastening* and impossibility of being accidentally dislodged are essential for security in such platforms; that the advance in the art about which it was talking was not by dispensing with, but adhering to, such fastenings, and that, in practice, these hoists and cross-timbers are not taken apart until the hoists, including the cross-timbers, are drawn into the building or lowered to the ground, where, as in the prior Murray, they can be unfastened for the purpose of shipment. Every one of the old devices was equally capable of being thus taken apart—most of them more so.

The court says that the amendments introduced "did not change the meaning or effect of the original claims." They were introduced after rejection to *emphasize* distinctions upon which the argument for their allowance was based, and it was defendant's argument concerning the advantage of making the frame in the continuous bent single bar of metal that induced the allowance. What was the purpose of their introduction under these circumstances if they *meant nothing*, and how can the public be informed of what it is asked to abstain from using by the claims, either taken by themselves or read in connection with the arguments by which they were procured, if the terms of the claims are to be treated as of no consequence and the invention may afterwards be asserted to consist in something neither described nor claimed, as may then suit the purposes of the owner of the patent?

The court, speaking of the claims finally allowed, says, referring to the Examiner:

"He held that they were patentable because they disclosed Henderson's New Method of Combining Hoisting Devices and the frames therefor broadsides to the wall with the cross pieces and floor pieces of the scaffold so that the hoisting units should not obstruct the platform of the scaffold, and the cross pieces should be supported on the rod which connected the lower ends of the vertical sides of the frames."

As there is not a suggestion in specification, in claim, in the statement of the Examiner, or in the argument by which the Examiner was coaxed into allowing the claims, that supports or is consistent with this statement, it would seem that it must have been taken from the brief of the appellant. Placing the frames broadside to the wall is not mentioned in specification, claim or argument, as any part of the invention, and the specification is explicit to the effect that the invention is equally present whether placed edgewise or broadside to the wall. There is not a word said about obstructing the platform by placing it in one position rather than the other, and the fact is—as shown by the practice of plaintiff—that with the windlass hoist the edgewise position causes least obstruction. The claims and argument all emphasize the fact that the object was to *dispense with* "the rod which connected the lower ends of the vertical sides," thus *reducing the number of parts and avoiding attachments*. While the prior art showed that the support of the timbers on rods connecting the lower ends of the vertical sides was not new, it was one of the things that the claims were drawn to *discriminate against*. The "principle" which the court alleges induced the Examiner's action was plainly not discovered by either the Examiner or the patentee, or in any wise involved in the invention asserted and for which the claims were allowed. The reference made by the court to the argument by which the claims were procured omits the essence of that argument.

The decisions there cited to the effect that each inventor "is entitled to his own combination as long as it differs from those of his competitors and does not include theirs" and to the effect that "a combination" of old elements may be patentable if they produce a novel and useful result or an old result any more conveniently or facily, have no bearing upon such a case as this, because they necessarily relate to the *combination of elements claimed in the patent*, and to a combination of elements that *represents something more than the use of ordinary mechanical skill and judgment*. Every decision of the Supreme Court holding a patent invalid for want of invention, or limited to what it claims, would be overruled if such an interpretation of these decisions as this opinion puts upon them should prevail.

When the court says that the combinations of Henderson's first and third claims were new, it ignores the fact that each of these claims would read literally on the prior Murray patent and some of the other prior hoisting devices, *if not limited by the language which distinguishes them from the present defendant's construction*. Its theory that making the platform so that it can be more readily knocked down, simply by omitting fastening devices which secure the parts together, would be patentable, if accepted (and its acceptance involves rejecting the decisions of the Supreme Court on this subject), would still not help plaintiff, because defendant's device has no advantage over the prior art in this respect. The finding of infringement is also based on the placement of the frames parallel to the wall, notwithstanding the absence of the features to which the claims are expressly limited, and in which the specification represents the invention to consist.

Every claim that could possibly cover a construction in which the frame which supported the windlass did not extend "*continuously*" under the timber, but was connected at the bottom in some other way, was struck out after rejection

on prior devices that showed every feature claimed except this continuous U-bend of the *single-piece* frame, which was described in the patent as securing economy and safety and made essential to the invention asserted. The second claim was further amended to insert limitations to this feature, and the third claim was drawn to exactly describe them in terms that were equally applicable to either figure of the patent.

None of the decisions cited by the court justify such a revolution in the interpretation of patents, in the doctrine of patentability, and in the scope of injunctions, as this decision would inaugurate.

The later opinion of this court, after its attention had been directed to parts of the record which it apparently overlooked, is the more significant because the author of the first decision clearly recognized in the second what must have led to an affirmance of the decree dismissing the bill if duly considered at the former hearing. The reasons given for holding the "Little Wonder" not an infringement apply with equal force to the first Whitney, which the court had not correctly understood. (See opinion, 243 Fed., 180.)

Third Circuit.

The decree entered by the trial court dismissing the bill for want of equity, pursuant to its opinion that if the claims could be sustained the Whitney hoist would not infringe, and the unanimous affirmance of this decree by the Court of Appeals, were strictly in accordance with the facts, and with the law on this subject as administered by this court (see opinions L. B. Rec., p. 80, and p. 115).

Seventh Circuit.

The District Judge in the Chain Belt case evidently thought he was following the Court of Appeals of the Eighth Circuit, but the subsequent decision of that court (243 Fed., 180) rejected his interpretation of its former decision.

The Seventh Circuit Court of Appeals, overruling so much of his decision as included the "Little Wonder," strangely disregarded the facts that the reasons for excluding the "Little Wonder" in the second opinion of the Court of Appeals of the Eighth Circuit, applied aptly to the former Whitney hoist, when read in connection with the evidence, to which its attention had been directed; that the advantages assumed to support the claims were purely fictitious; that the one upon which alone it relied (saving of space) was not obtained by the Henderson, but on the contrary, by reason of the gear drive and the fact that, if its frame be set parallel to the wall, it must be so far from it that the crank can be turned freely without knocking the knuckles or the gear against the wall, there would be a distinct *loss of space* when so set; and that the specification, claims and files excluded injecting this feature into the claims and disregarding the limitations by which allowance was secured. If such saving of space had been obtained by the Henderson construction the court could not, with due respect for the repeated decisions of this court, discard the limitations by which the claims had been secured, for the purpose of finding infringement, and predicate its finding of validity and infringement upon placing an old hoist in one of two alternative positions merely to save room, when, as it states in its opinion:

"Neither in the specifications nor the claims is mention made of the position of the drums with reference to the building wall." (C. B. Rec., p. 267.)

The decisions of this court touching the subject of patentability are unanimous in holding that this was not patentable invention. Whether the hoist was set in one position or another, made no difference in any of the offices performed by the Henderson hoist, and was nowhere claimed as his invention. It was equally within each of the claims whether set in one position or the other, and there was absolutely no "saving of room," or advantage in obtaining ac-

cess to the wall by setting it parallel instead of edgewise. It could not be set "flat against the wall," because of the space occupied by the gear, and turning of the drum crank, and the space needed for the support of the timbers. It was by a radical change in principle, original with Whitney, that his hoist was adapted to be set close to the wall in either position, and which introduced the advantage, impossible with the Henderson, of enabling one operator to simultaneously actuate the levers of the two oppositely placed hoists, thereby raising these two hoists together.

The court treated the "*presumptive validity of the grant*" as outweighing the evident lack of invention, quite disregarding the fact that such presumption could only attach to the invention as *defined by the claims and asserted in the Patent Office*, which limited it to features the Whitney machine excluded, and which distinguished the Henderson from the prior hoists only by structural features, in which the Whitney corresponds to the prior hoists and not to the Henderson. Any presumption of validity due to the grant cannot extend beyond what it is plain the Patent Office treated as the improvement upon which the claims were based and the allowance obtained. The absence of such "improvement" from the defendant's, and its adherence to the prior art in respect to the subject-matter of the claims, is palpable. This court, while professing respect for the authority of the grant, rejects that authority both for the purpose of finding infringement and for the purpose of finding validity.

It had also found the evidence before it established that, prior to the Henderson invention, the plaintiff, the owner of the Murray patent, had built up a "large business in supplying scaffolds for the erection of high buildings," and had furnished, for the erection of the Blackstone Hotel, the Murray hoists and scaffolds corresponding exactly to that petitioner now asserts to be the Henderson invention. It recognized that this practice had been and was being pursued by

the owner of the Henderson patent, without using this "saving of room."

It states that Henderson having the ends of the put-logs laid directly in the U-frames "necessitates the frames being parallel or broadside with the building." This again is a palpable error. The so-called put-logs can rest in the frames in precisely the same manner when they are set edgewise to the wall, the only difference being that the put-logs would then extend parallel with the wall, and the timbers resting on them would be laid crosswise of the put-logs in either case. The effect of what is asserted as Henderson's invention would be exactly the same in either case, and each of the claims equally cover the construction of the hoist. The position in which they were used might be determined largely by the relative length and breadth desired, or by the timbers at hand when constructing the platform.

When considering the imaginary advantages of the Henderson, the court apparently was looking at the exhibit of the Whitney hoist before it, and not at the Henderson. It overlooked the fact that with the original Whitney, as well as with the "Little Wonder," it would have been impracticable to disassemble the platform and take it in at the top of the building; that it did not carry the cable up with it, and that its connection with the depending cable, as well as with the timbers, was such as to preclude what the Court of Appeals of the Eighth Circuit had regarded as the distinguishing invention of Henderson; that the fact that it could be placed close to the wall was due to what distinguished it from Henderson. It correctly found that the "Little Wonder" did not infringe in any position it was placed, and should have found the same with reference to the Whitney. It should also have found, as did the court of the Third Circuit, that the claims in suit were invalid.

Furthermore, as it held the original Whitney did not infringe except when placed flatwise, there was nothing to

support its finding the Chain Belt Company a contributory infringer to such use of it. That company, as the court concedes, only made the metal hoists for Whitney, employed by him for that purpose, and had nothing to do with marketing them or setting them up. There was nothing in their construction that adapted them to be set in one position rather than another, any more than the Bowyer *et al.*, and other prior platform hoists. It would be just as reasonable to hold them contributory infringers if they had made the old Bowyer construction, or any of the hoists of the prior art, since they are all capable of being set in either position, quite as much so as Henderson. The Whitney is adapted to be used in every position, as these old hoists are. The court admits that the Chain Belt Company had ceased making the original Whitney scaffold hoist,

“for a period of nearly two years next before the filing of the bill.” (P. 269.)

This was long before the first decision of the Court of Appeals of the Eighth Circuit, and before there had ever been a suggestion that the patent covered the setting of hoists flatwise to the wall, and while according to plaintiff's contention and this court's finding, the plaintiff had substantial control of this market, and was putting out its hoists set edgewise rather than parallel to the wall. Certainly the Chain Belt Company could not be held as an infringer merely because of the work which it then did for Whitney in manufacturing hoists having exactly the same capacity to be set edgewise to the wall as all prior hoists, unless it was definitely proved it had some part in, or at least knowledge of, the placement of such hoists parallel to the wall. The burden was upon plaintiff to clearly prove this. (See second decision of Court of Appeals of the Eighth Circuit, 243 Fed., 180). There was no such proof against the Chain Belt Co. There was therefore upon the court's finding no justification for a decree against the Chain Belt Company; nor was

there any equitable consideration that would justify such a decree, where plaintiff had already a decree against Whitney, who had employed the Chain Belt Company to make these hoists for him, and where that company was shown to have discontinued their manufacture long before the suit was brought, and before there was any suggestion of the plaintiff's patent being interpreted as covering these hoists placed flatwise instead of endwise. It had ceased to make them when the only decision under the patent was that of the trial court in the Eighth Circuit, holding the patent invalid and not infringed by the Whitney hoist, however placed.

Nor was there any justification for the decree against Whitney. Such cause of action as plaintiff had against him by reason of the manufacture of the Whitney hoist was entirely controlled by the suit then pending against him in the Eighth Circuit, under which an accounting was then proceeding. No further relief was obtainable against him based on these Whitney hoists, which he had discontinued before that judgment, and for which he was then accounting. His helping to defend the Chain Belt Company against the attack made upon it did not entitle plaintiff to the same relief against him in another court, which it had already obtained in the Eighth Circuit. The pleadings in the Chain Belt case showed all the facts necessary to exclude such a decree against Whitney. If the opinion of the court of the Seventh Circuit contemplates a decree against him, it would for that reason be without justification.

In every respect in which its judgment differs from that of the Court of Appeals of the Third Circuit, it is plainly erroneous. It should have found that the claims were neither valid nor infringed.

No Patentable Invention.

In a very large proportion of cases before the Supreme Court in the last thirty or forty years, patents have been held invalid for want of invention notwithstanding both plaintiff and defendant were using the device, notwithstanding its utility was thus conceded and recognized, and notwithstanding it could be differentiated by the terms of the claims from anything in the prior art. In all those cases the Patent Office had found the subject of the claims patentable and the court was overruling it. In the present case, the Patent Office did not find to be patentable, or allow claims for, anything that the majority opinion in the Eighth Circuit assumes to constitute the invention; but, on the contrary, *only allowed claims for what each court holds does not constitute patentable invention.*

Whatever weight in this case is to be given to the opinion of the Examiner is adverse to plaintiff, for it expressly confines the invention to what defendants have not used.

In *Richards v. Chase Elevator Co.*, 158 U. S., 299; 159 U. S., 477, there was certainly much more to be said in favor of patentability than in the present case. The association of elements was new. It conduced largely to economy and convenience and had been adopted. But the Supreme Court, in holding that it did not involve invention, said (158 U. S., 302):

“So long as each element performs some old and well-known function, the result is not a patentable combination, but an aggregation of elements. Indeed, the multiplicity of elements may go on indefinitely without creating a patentable combination, unless by their collocation a new result be produced.”

See, to the same effect, *Hailes v. Van Wormer*, 20 Wall., 353; *Heald v. Rice*, 104 U. S., 737; *Hall v. Macneale*, 107 U. S., 90; *Atlantic Wks. v. Brady*, 107 U. S., 192; *Slawson v. Grand St. Rd. Co.*, 107 U. S., 649; *Penn. Ry. Co. v. Locomotive*

Truck Co., 110 U. S., 490; *Morris v. McMillan*, 112 U. S., 244; *Thompson v. Boisselier*, 114 U. S., 1 (11); *Crescent Brewing Co. v. Gottfried*, 128 U. S., 158; *Aron v. Manhattan Ry. Co.*, 132 U. S., 88; *Consolidated Roller Mill Co. v. Walker*, 138 U. S., 124; *Pope Mfg. Co. v. Gormully Mfg. Co.*, 144 U. S., 254 (259-260); *Duer v. Corbin Lock Co.*, 149 U. S., 216 (222-4); *Knapp v. Morss*, 150 U. S., 221; *Cimiotti Unhairing Co. v. Am. Fur Ref. Co.*, 198 U. S., 399, 416; *Computing Scale Co. v. Automatic Scale Co.*, 204 U. S., 609; *N. Y. Belting & Packing Co. v. Sierer*, 158 Fed., 819; *Brill v. Washington Ry. & El. Co.*, 215 U. S., 527; *Ry. Sup. Co. v. Elyria I. & S. Co.*, 244 U. S., 285; *Grinnell W. Ma. Co. v. Johnson Co.*, 247 U. S., 426.

Nor is it invention to combine old devices in a new article without producing a distinctly different result by reason of their co-operation. The mere association in one article of manufacture, or one machine, of features selected from different prior devices, which only contribute their several advantages in the one article, unaffected in their operation by the presence of others, does not constitute a new result within this requirement.

Thatcher Heating Co. v. Burtis, 121 U. S., 286; *Burt v. Ivory*, 133 U. S., 349 (359); *Florsheim v. Schilling*, 137 U. S., 64; *Busell Trimming Co. v. Stevens*, 137 U. S., 423 (435); *Belding Mfg. Co. v. Corn Planter Co.*, 152 U. S., 100; *Wright v. Yuengling*, 155 U. S., 47 (53-4).

New applications of expedients familiar to artisans where they serve only their customary purpose in a new association do not constitute invention. *Ryan v. Hard*, 145 U. S., 241; *Grant v. Walter*, 148 U. S., 547; *Market St. Ry. Co. v. Rowley*, 155 U. S., 621; *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S., 485.

In most of the cases before cited in which the association of elements was found to be lacking in patentability there was co-operation in the elements and no dispute over the advantage of having them united in one article, or about that

article being the better for their presence. If the fact that the article was a better article than those which omitted one or more of the components were sufficient to make it a patentable combination, or if that were such new result as is necessary to support a patent for a combination, every patent that has been held invalid as not for a patentable invention, must have been held valid. In most of those adjudged invalid there were very distinctive advantages obtained by the association of elements, requiring some mechanical skill and contrivance; and in many of them it was argued quite persuasively that a distinctly new and valuable result was obtained.

In *Atlantic Works v. Brady*, 107 U. S., 192, the familiar language of the Supreme Court, holding that it was not the object of the law to "grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture," was used in holding invalid a patent which exhibited incomparably more novelty, ingenuity and advance in the art than the patent here under consideration, and all the condemnation of such patents contained in the context (see, especially, p. 200) applies with cumulative force here. The combination recited in the claims there in suit was not exhibited in the prior art, it had a different mode of operation, and possessed great advantages over the nearest approaches. The dredging boat so created by a combination of elements not before associated could be sunk on an even keel to the level desired for attacking the sand bank and then forced forward by its stern propeller on the level so obtained while its "mud fan," constructed with special reference to this work, was attacking and dissipating the sand bank in front. The Supreme Court held that this was not patentable, since there were instances in the prior art where steamboats had been turned with their stern toward the sand bank and backed into it, using their propeller to dissipate the bank. They had not been sunk on an even keel for

this purpose, they had been obliged to depend upon the propeller (which, being reversed, was causing the boat to move backward), as the agent with which to attack the sand bar, with only that end of the boat sunk sufficiently, instead of having a mud fan specially constructed for the purpose on the bow of the boat driven against the bank by the propeller at the stern, each capable of being operated at different speeds and adapted to its special work. It was impossible to attack the bank without turning the boat around and reversing the motion of the propeller. A court that so strongly denounced ascribing invention to what that patentee had done, and laid such stress upon that patent as illustrating those who—

“watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts.”

cannot consistently tolerate such arguments as those by which it is here sought to ascribe patentable invention to Henderson.

In *Bussey v. Excelsior Mfg. Co.*, 110 U. S., 131, the elements had been brought into a new association, with conceded advantages, but this was held not to constitute patentable invention.

In *Thatcher Heating Co. v. Burtis*, 121 U. S., 286, dealing with a case in which more could be said in behalf of the patent than could be said here, admitting that the patentee had brought together elements not before combined in one stove, thus improving the stove, it was held there was no invention.

In *Florsheim v. Schilling*, 137 U. S., 64, the court found some of the features of the patent in one prior device and some in another, saying (p. 77):

“The different arrangement of these groupings as they appear in the patent sued upon is not an invention, but is a mere matter of mechanical judgment ‘the natural outgrowth of the development of mechanical skill as distinguished from invention.’ *Burt v. Evory*, 133 U. S., 349, 358, and authorities there cited.”

Referring to the argument that the combination of the prior inventions secured and put into use by the prior patents, making it a superior and cheaper article, constituted invention, the court said, "We are unable to agree with appellant's counsel on this point," citing *Pickering v. McCullough*, 104 U. S., 310, and adding:

"the combination of old devices into a new article without producing any new mode of operation, is not invention."

In *Aron v. Manhattan Ry. Co.*, 132 U. S., 84, the patentee had been the first to make the recited combination of mechanism serving a new purpose. It had gone into immediate and extensive use and its utility was indisputable. In holding that there was no patentable invention the Supreme Court said (p. 90):

"It rarely happens that old instrumentalities are so perfectly adapted for a use for which they were not originally intended as not to require any alteration or modification. If these changes involve only the exercise of ordinary mechanical skill, they do not sanction the patent; and in most of the adjudged cases where it has been held that the application of old devices to a new use was not patentable, there were changes of form, proportion or organization of this character which were necessary to accommodate them to the new occasion."

In *Busell Trimmer Co. v. Stevens*, 137 U. S., 423, the argument that, because the patentee had, by combining in one device elements not so employed before, produced a superior article, he was entitled to a patent for such new combination, was rejected by the court, which, in holding that there was no patentable invention, said (p. 435):

"The most that can be said of it is that it shows on the part of Orcutt great industry in acquiring a thorough knowledge of what others had done in the attempt to trim shoe soles in a rapid and improved mode, by the various devices perfected by patents for that purpose, good judgment in selecting and combining the best of them, with no little mechanical skill in their application;

but it presents no discoverable trace of the exercise of original thought."

Then, after referring to certain changes which, though recognized as improvements, were held not to be patentable, it said (p. 435):

"It may be admitted that Orcutt's later patent performed the work it was designed to accomplish in a better and more workmanlike manner than any of the preceding cutters patented; because, as already stated, there were constant improvements in the art to which it related. So far as this record shows, it was the last of a series of patents designed to accomplish the same object. As such it necessarily retained all the beneficial features of those earlier patents, and, to a certain extent, improved upon them. Such improvement, however, was an improvement in degree only, and was, therefore, not patentable. *Burt v. Ivory*, 133 U. S., 349, and cases there cited."

In *Olin v. Timken*, 155 U. S., 141, the question of patentability was more favorable to plaintiff than it would be here if the claims in suit had expressed what the Court of Appeals of the Eighth Circuit have treated as embraced in them. It required considerable mechanical change from either of the prior devices to obtain just what was asserted as the invention of Timken, but the court considered those changes as requiring mechanical skill and judgment rather than invention. It said (p. 154):

"Appellee's argument seems to be that the Timken patent should be so constructed as to cover a double-sweep sectional spring, having the attaching ends connected to the bottom of the buggy or cross-sills at any point between the side and the centre, crossing the centre, bending downwardly for a distance and then upwardly to be attached to the side bar; having a thick end for attachment to the buggy bottom and a thin end for attachment to the side bar shackle, the curve being such as to allow the body to move up and down without expanding the side bar; but we do not understand this description to be within the terms of the patent, according to which the Timken invention consisted in the use of sec-

tional springs arranged in pairs side by side and crossing each other to couple the body to the gear. Now that sectional springs can be used for coupling the body to the gear of the vehicle; that rigidity of spring can be obtained by making the connections rigid; that the body could be hung either high or low by the proper sweep of the spring; that the form and sweep of the springs and various methods of using them as couplings between the gear and body, were well known, the patents, exhibits, and proofs make exceedingly clear; and we should say that nothing but mechanical skill was required to so adapt these well-known springs as to attain the desired objects expressed in complainants' patent. And while the patented article may have been popular and met with large sales, this fact is not important when the alleged invention is without patentable novelty. *Duer v. Lock Company*, 149 U. S., 216."

Neither utility nor extensive use nor general adoption can impart patentability to such use of ordinary mechanical expedients in new connections as fall fairly within the province of the artisan. See *McClain v. Ortmyer*, 141 U. S., 419, 429; *Duer v. Corbin Cabinet Lock Co.*, 149 U. S., 216, 223, 224; *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S., 485, 493.

Summary.

It is only by treating the Henderson patent as a chameleon, whose character changes according to plaintiff's exigencies in each case, that plaintiff has been able thus far to obstruct Whitney in the introduction of his patented hoist, which represents the most distinctive invention in this art made for many years; which has borrowed nothing from Henderson, and rejected everything upon which his claims and assertion of invention were based.

Petitioner has now brought this case into this court on the plea of conflict between the decisions of the Courts of Appeal, and then, abandoning (as the proofs compelled it to) every interpretation of the claims by which any court has been induced to sustain them, has sought to again revise

them to cover what neither of the judges of the three circuits has found to be either claimed or original with Henderson, or patentable, and what the Court of Appeals of the Seventh Circuit unanimously found was not novel. There is no pretext in the patent, or in the art, or under the decisions of this court, for holding a "loose joint" is the subject of either claim, or that it originated with Henderson, or was patentable invention; or for reading it into the claims of the Henderson patent. It is plainly shown not to be novel, and the plaintiff has been shown, without contradiction, to have employed it in its own Murray hoist long before Henderson. After seeing these hoists, Henderson secured his patent on the supposed peculiarities of his hoist frame, which neither defendant has used.

Whitney has avoided everything upon which the Henderson claims rested, and has created a distinctly new and valuable hoist, operating upon a principle that essentially distinguishes it from the Henderson and all prior structures, while the Henderson patent was suppressed by plaintiff, who bought it for the purpose of excluding Henderson and his associates from disturbing its commercial monopoly by subjecting them to the doctrine of estoppel, and then consigned it to the scrapheap.

The courts of the Third Circuit correctly applied the law administered by this court in holding the patent invalid. They could not have sustained it without holding that it was not infringed by the Whitney hoist. None of the decisions cited by petitioner justify finding the patent either valid or infringed. Those heretofore cited in behalf of respondents are conclusive to the effect that the patent is neither.

Respectfully submitted,

ROBERT H. PARKINSON,
WALLACE R. LANE,
Counsel for Respondent.

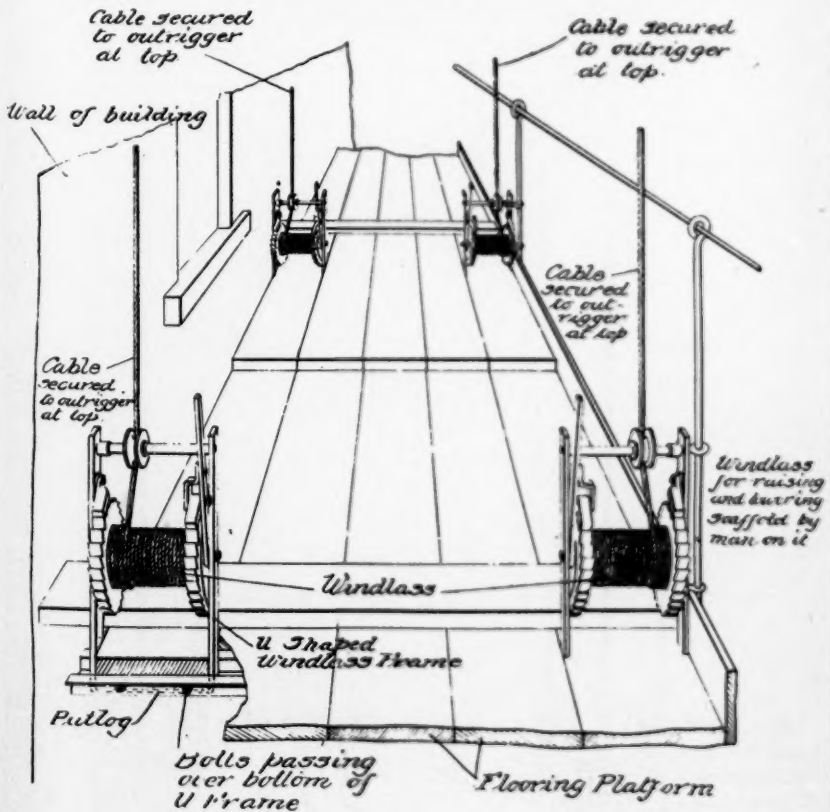
Pages 2 to 6, inclusive, show cuts and catalog pages (illustrative and descriptive) of scaffolding and scaffolding devices sold, rented and used by plaintiff and its licensee companies continuously since 1907.

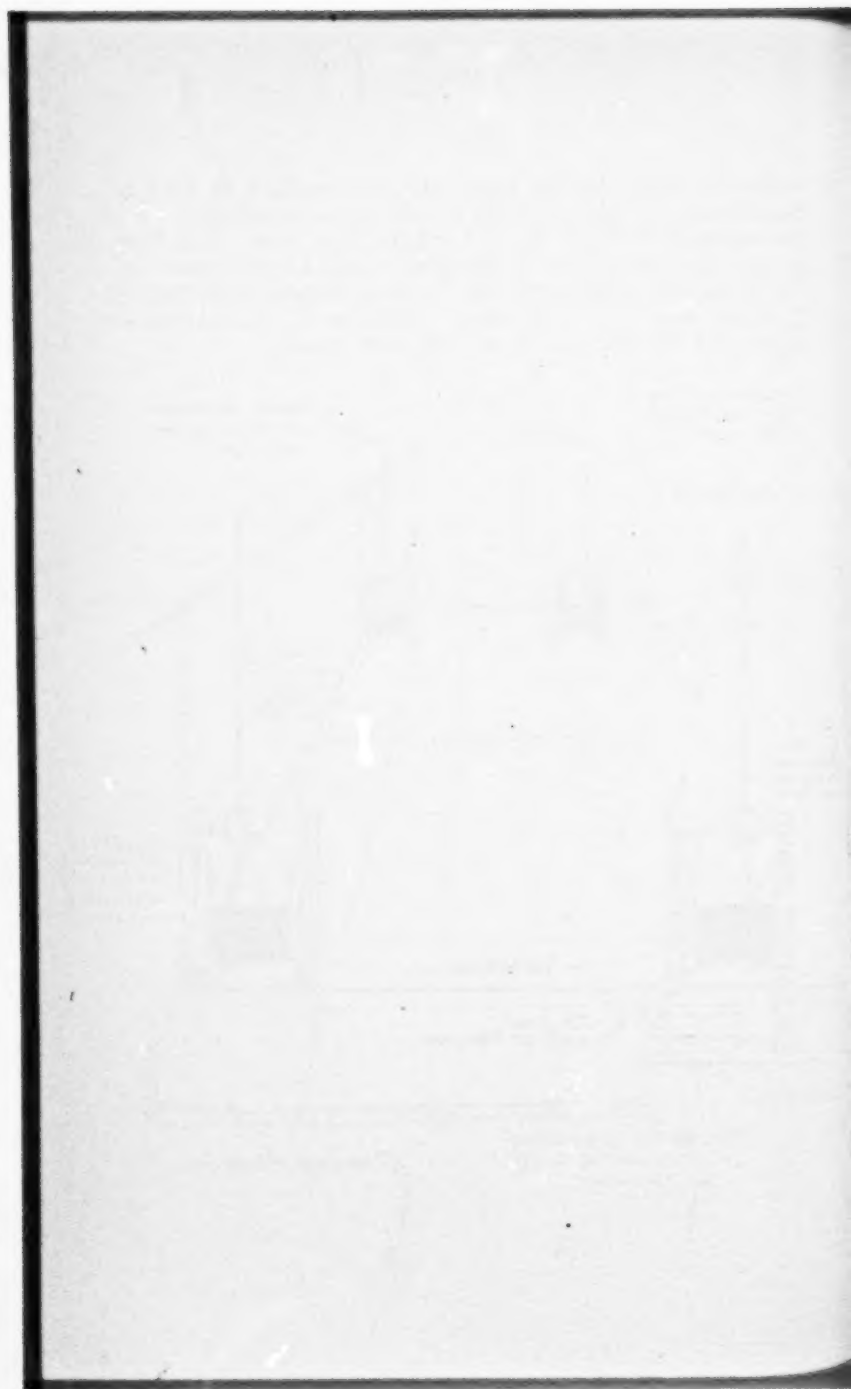
The testimony of LaBelle in the Chain Belt case shows them used on LaSalle Hotel, Chicago, Ill., in 1907; the testimony of Henderson and LaBelle in the same case shows them used on the Blackstone Hotel, Chicago, Ill., in 1908 and 1909; the testimony in the Liebel-Binney record shows seventy per cent. of all scaffolds sold, rented or used in this country (from prior to 1910 to the time of trial) were identical with those shown on the following five pages; the remainder of the overhead type shown on other pages herein.

Plaintiff and its licensee companies marked all these devices shown on the following seven pages under the Murray patent of May 28, 1907, No. 854,959. None were made or marked under Henderson patent in suit, nor were structures made under that patent used to any extent commercially.

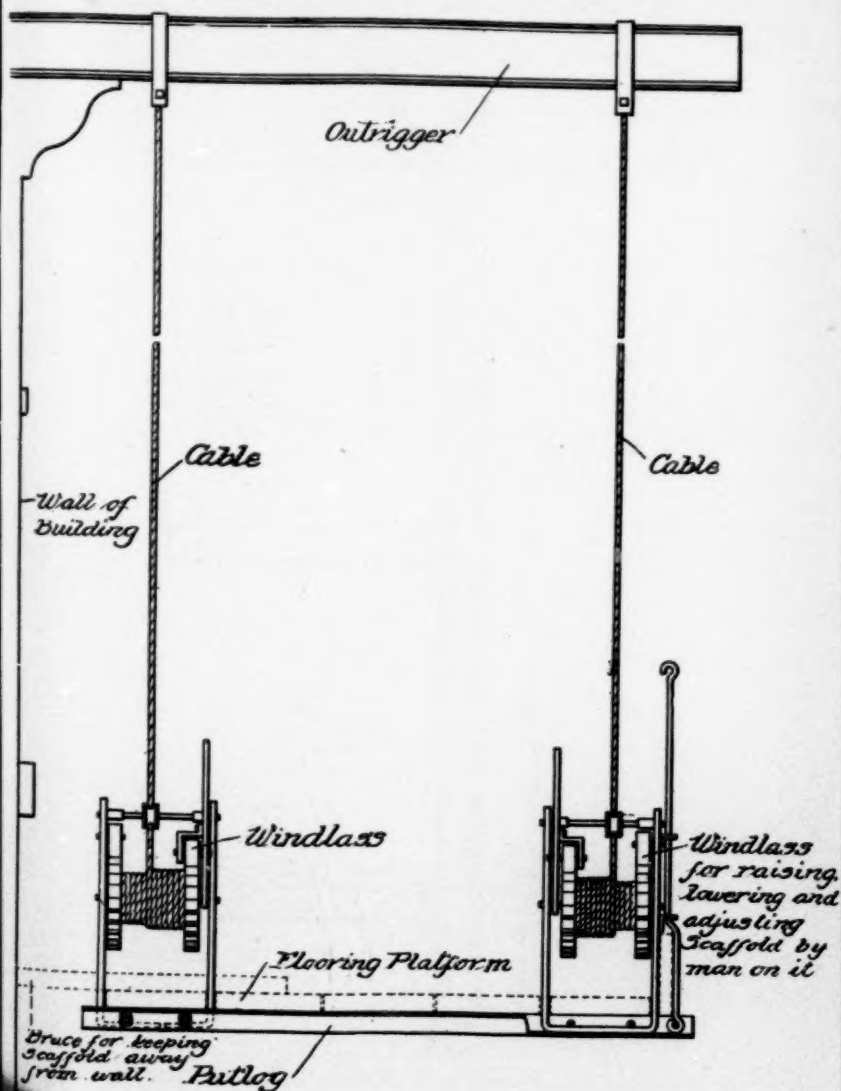


Perspective view Murray type swinging scaffold as used by Scaffolding Co. and plaintiff in 1908 and subsequently. See Defendant's Exhibit No. 13, Chain Belt case (No. 713), p. 236; also testimony of Henderson and LaBelle; also pp. 10, 11 and 13, Scaffolding Co. Catalog, Defendant's Exhibit 2, same case, and Defendant's Exhibit C, Liebel-Binney case; also Murray patent of 1907, both cases.



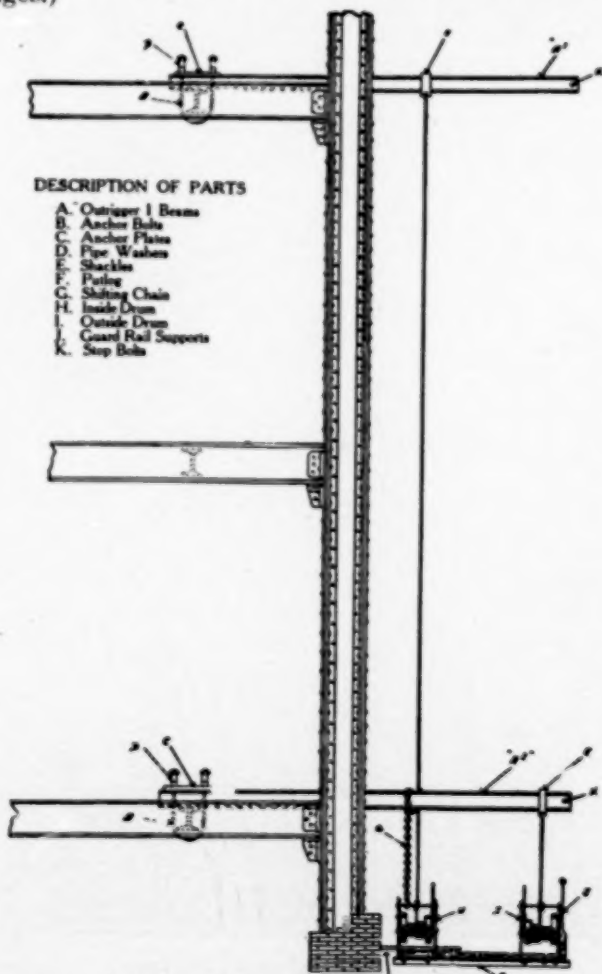


End view Murray type swinging scaffold as used by Patent Scaffolding Co. and plaintiff in 1908. See Defendant's Exhibit No. 14, Chain Belt Case (No. 713), opposite p. 236, and testimony of Henderson and LaBelle. Same structure as on preceding page.





Page 10, Patent Scaffolding Co. catalog (following p. 98, Liebel-Binney Record [No. 712]). Plaintiffs and associates sold 70 per cent. this kind; marked all under Murray patent of May 28, 1907, No. 854,959, continuously from 1908 to time of trial (see Record, pp. 27, 28, 29, 61, 63, and 181 of exhibits). (Same catalog in Chain Belt case as Defendant's Exhibit No. 2.) See pages 5 and 6 hereof for other pages from same catalog. (Same structure as on two preceding pages.)



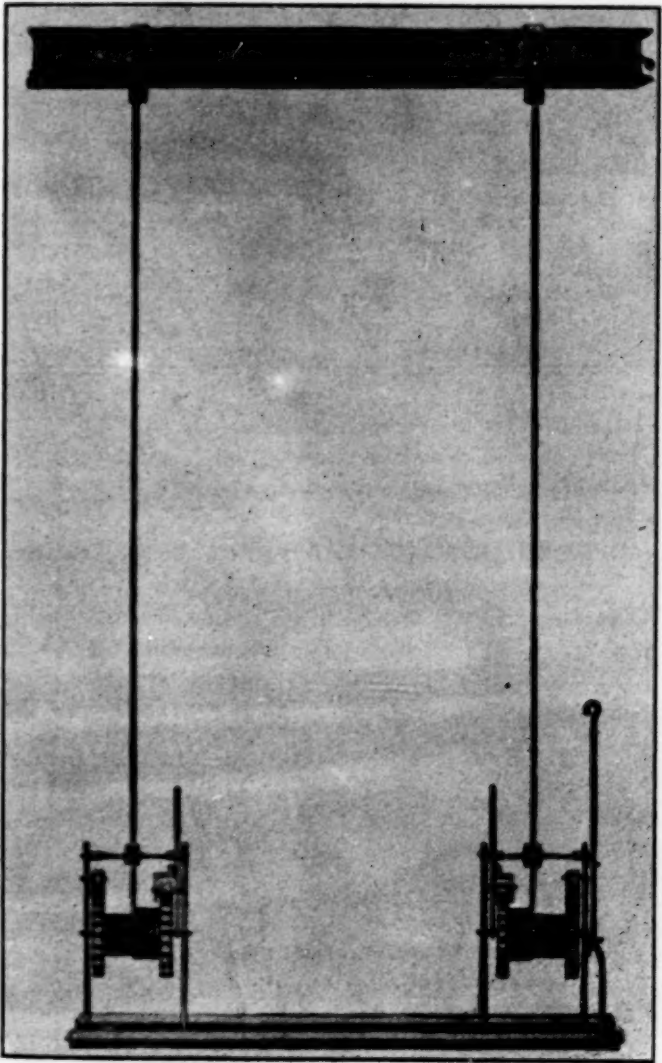
DESCRIPTION OF PARTS

- A. Outrigger 1 Beams
- B. Anchor Bolts
- C. Anchor Plates
- D. Pipe Washers
- E. Shackles
- F. Pulley
- G. Shifting Chain
- H. Inside Drum
- I. Outside Drum
- J. Guard Rail Supports
- K. Stop Bolts

How scaffolding can be shifted to higher levels without dismantling the platform or delaying the work



Page 11, Patent Scaffolding Co. catalog.
(Showing same device as on three preceding pages.)

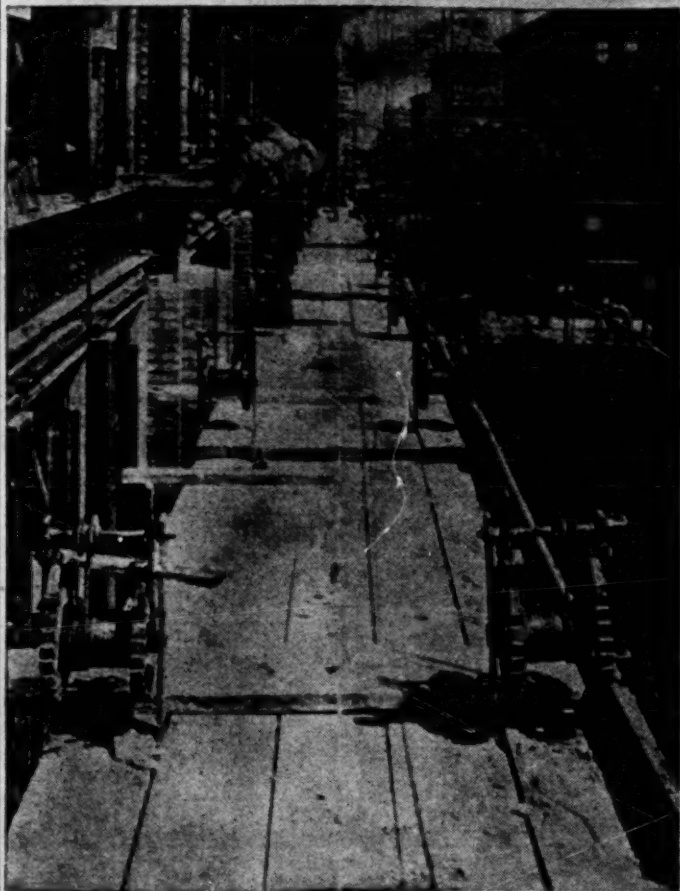


SAFETY SCAFFOLDING MACHINE.



Page 13, Patent Scaffolding Co. catalog.
(Showing same device as on four pages just preceding.)

Views of Safety Scaffolding Machine



Showing the bricklayers working on an easy platform due to the fact that the platform may be raised to a convenient height

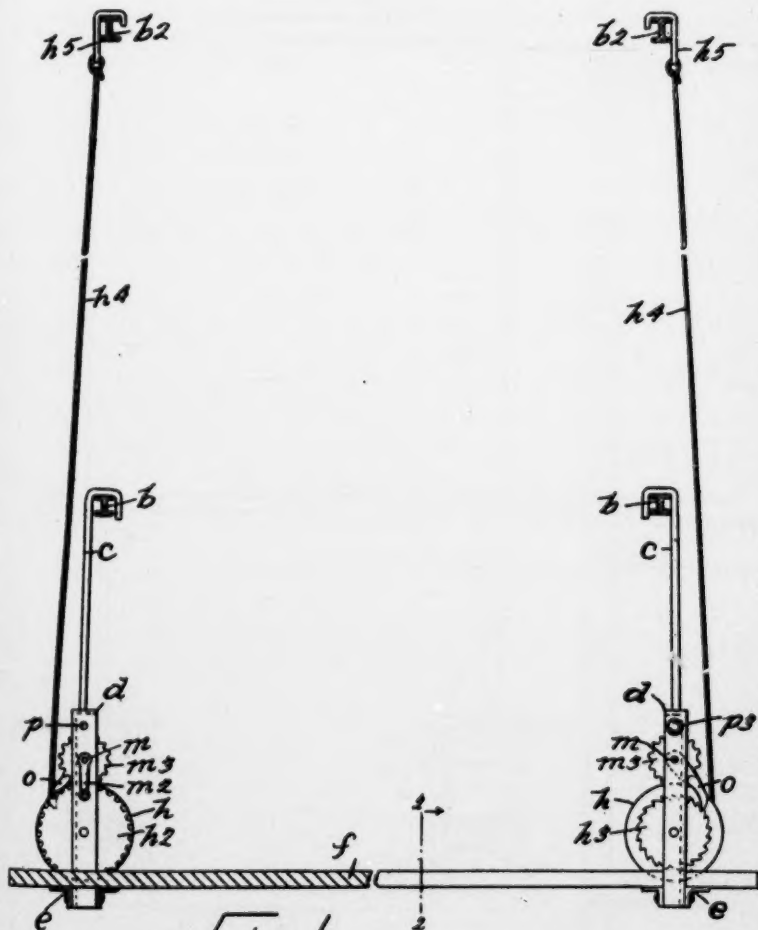
Drawings of Murray patent of May 28, 1907, No. 854,959, sheets 1 and 2. This is the patent under which the plaintiff and its licensees marked and licensed their scaffolding and scaffolding devices. See record Liebel-Binney case, pages 27-29, and page 181 of exhibits in that case. Seventy per cent. of all scaffolding devices licensed and used in the United States at the time of and prior to this suit were thus marked and used.

No. 854,959.

PATENTED MAY 28, 1907

W. J. MURRAY.
ADJUSTABLE SCAFFOLD.
APPLICATION FILED NOV. 12, 1906.

2 SHEETS—SHEET 1



WITNESSES

W. J. Murray
Adam Bee

Fig. 1.

BY

INVENTOR

William J. Murray
J. Chris Lassen

ATTORNEY



W. J. MURRAY.
ADJUSTABLE SCAFFOLD.
APPLICATION FILED NOV. 12, 1906.

2 SHEETS—SHEET 2.

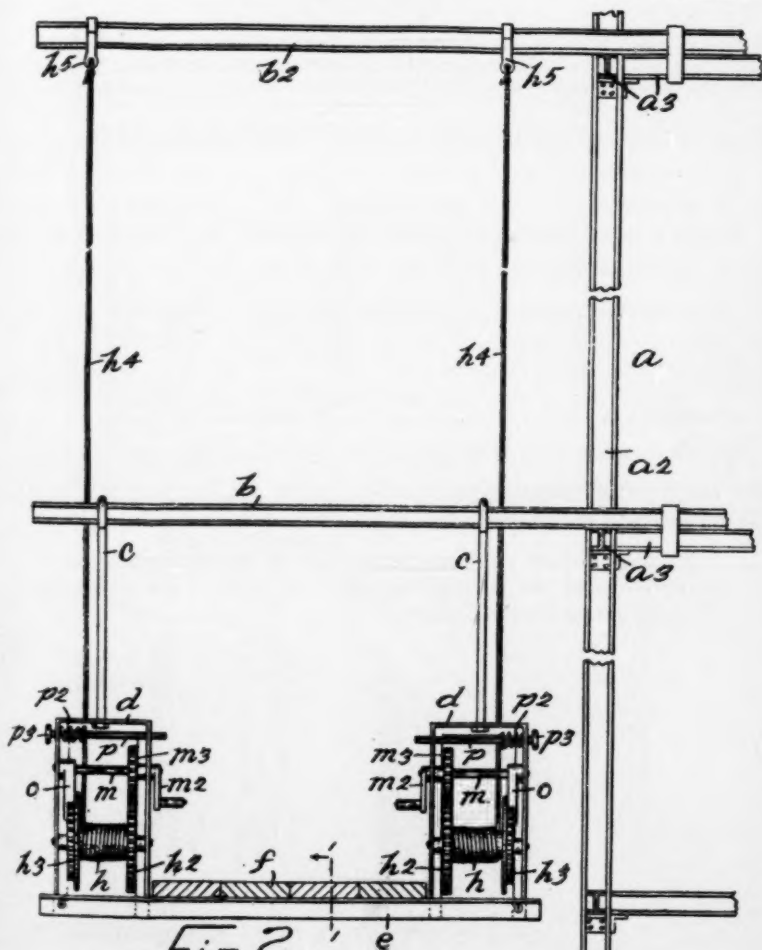


Fig. 2

WITNESSES
Murray

INVENTOR
William J. Murray

J. Chris Lavelle
ATTORNEY

Adam Bee

Pages 9 to 17, inclusive hereof show views (illustrative and from patent drawings) from the following prior art patents:

Bowyer & Casperson.....	382,252	May 1, 1888
Sladek.....	607,805	July 19, 1898
Clark.....	673,384	May 7, 1901
Foster.....	763,274	June 21, 1904
Cavanagh.....	796,807	Aug. 8, 1905

These patents, the Murray patent and the other art before the court were considered by the Court of Appeals of the Third Circuit when it said:

“finding no new problem presented or solved and no real improvement, we cannot conceive patentable invention in Henderson’s formal changes from the prior art.”

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J. SLADEK.
SCAFFOLD.

Application filed Sept. 20, 1897.

(No Model.)

FIG. 1.

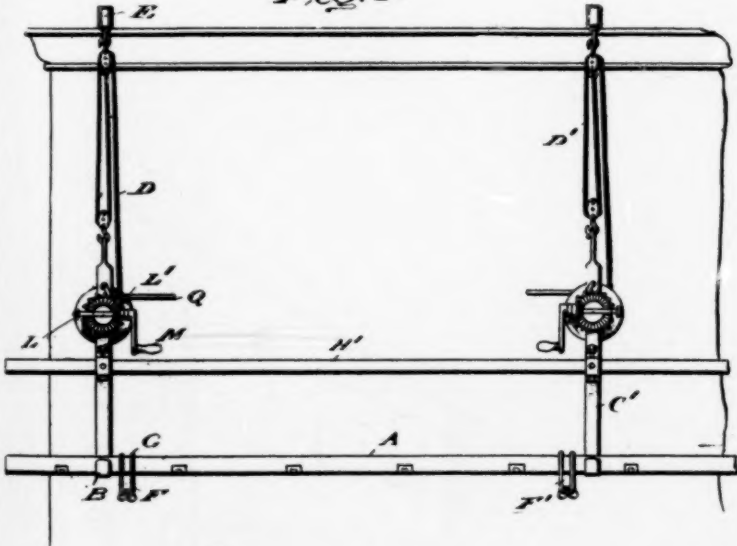


FIG. 2.

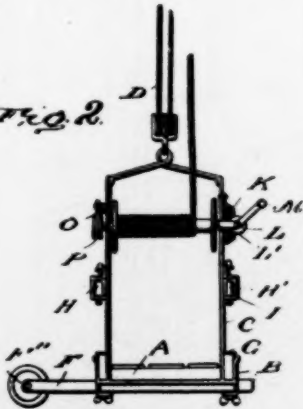
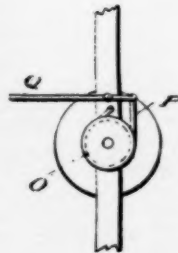


FIG. 3.



Inventor

Johann Sladek,

 Attorney.

Witnesses

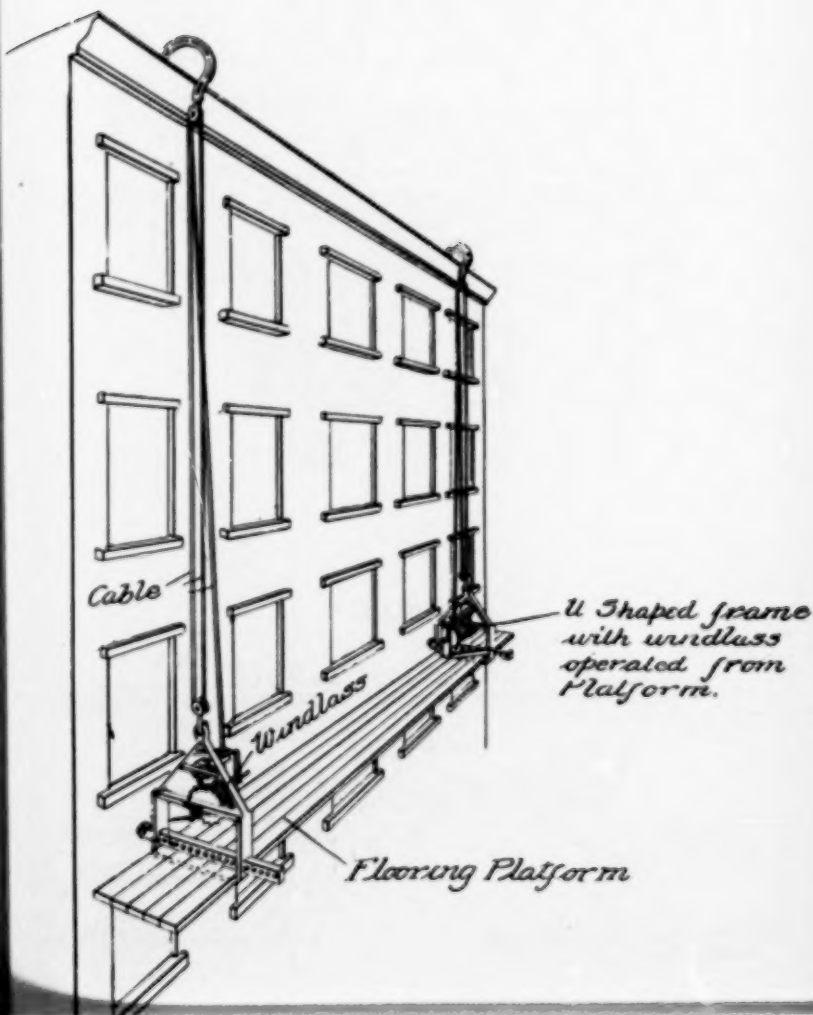
 J. S. Sladger



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Handwritten text, possibly a signature or a note, located at the bottom right of the page.

Common Form Scaffolding
 Used for more than twenty-five years
 Perspective view of Bowyer and Casperson
 Patent No. 382,252. May 1, 1888.





No. 673,384.

Patented May 7, 1901.

C. J. CLARK.

MASON'S PLATFORM FOR BUILDINGS

(Application filed Nov. 18, 1900.)

(No Model.)

2 Sheets—Sheet 1.

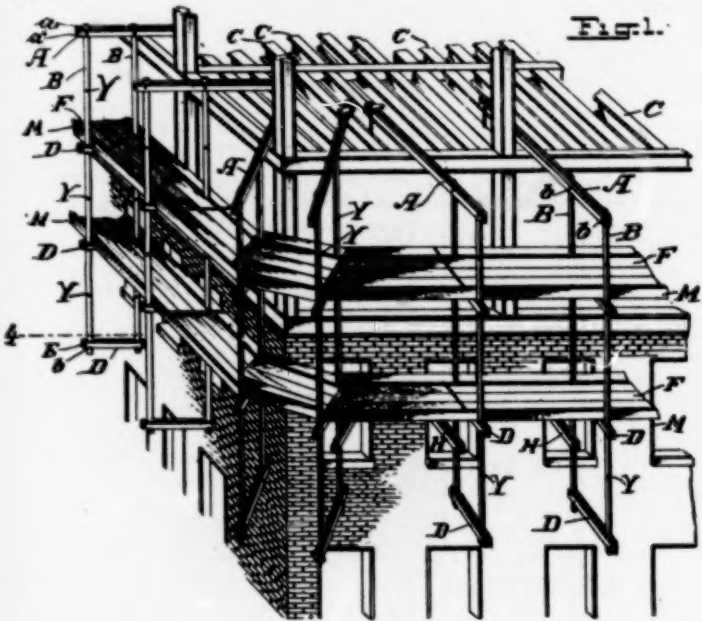


Fig. 3

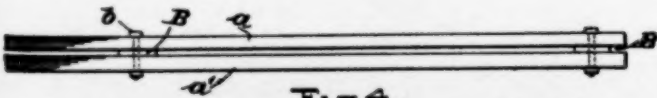
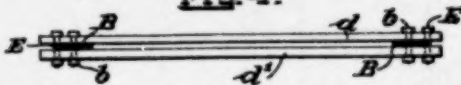


Fig. 4.



WITNESSES:

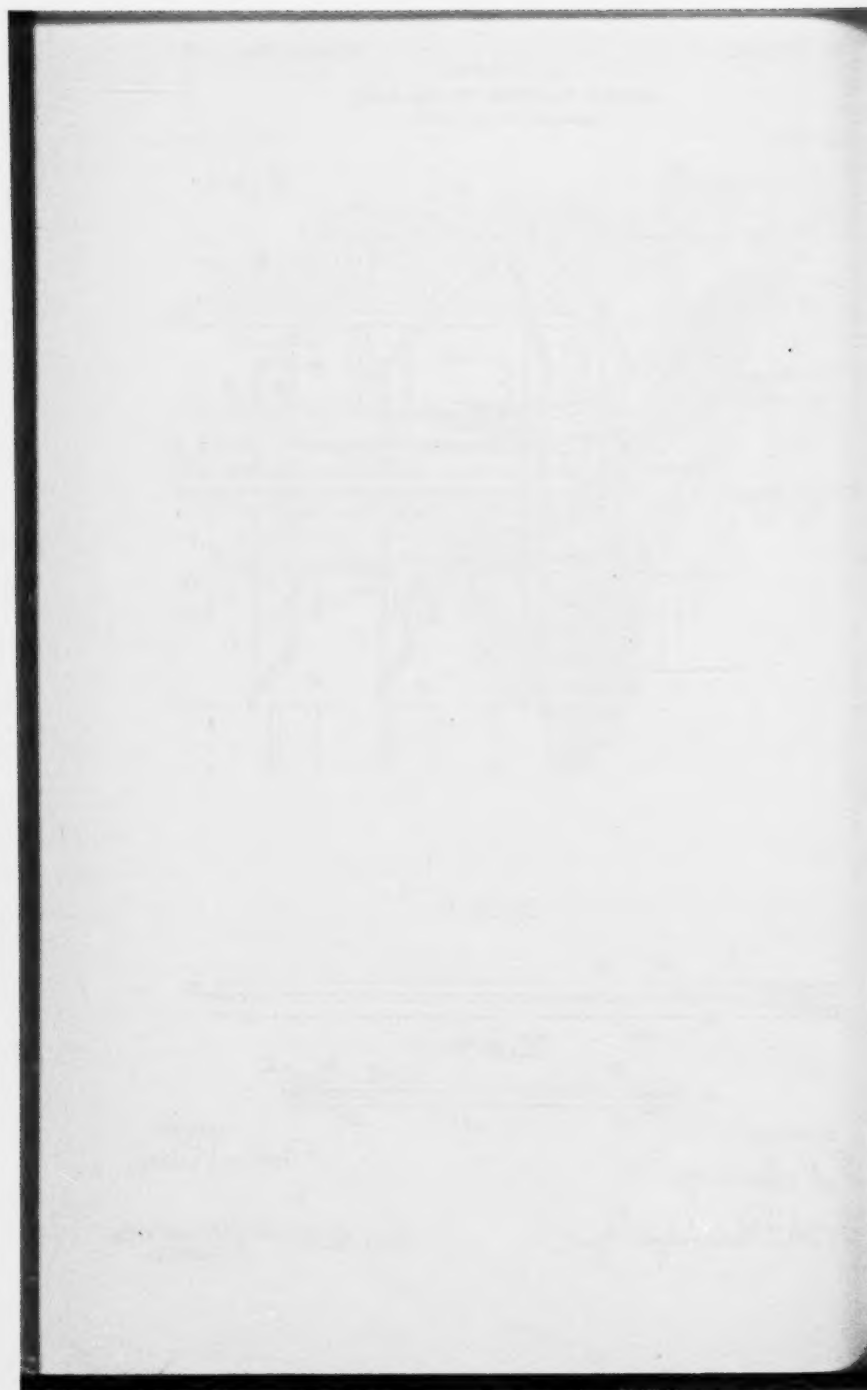
F. N. Roehrich
W. H. Berrigan Jr.

INVENTOR,

Charles J. Clark,

BY

Butt, Butt, Shiffert & Co.
 ATTORNEYS.



No. 673,384,

Patented May 7, 1901.

C. J. CLARK.

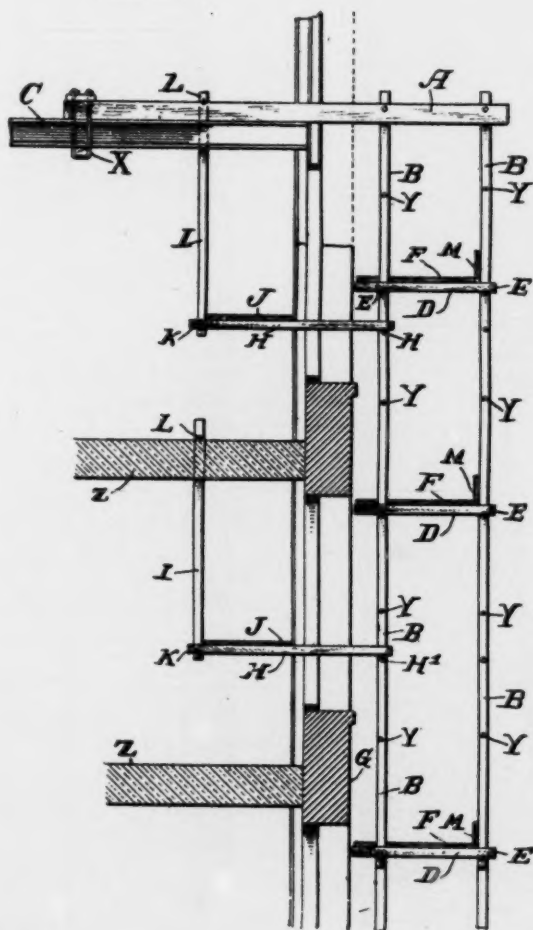
MASON'S PLATFORM FOR BUILDINGS.

(Application filed Nov. 15, 1900.)

(No Model.)

2 Sheets—Sheet 2.

Fig. 2.



WITNESSES:

C. N. Roehrich

A. H. Bennigand Jr.

INVENTOR

Charles J. Clark,

BY

Bett, Bett, Shiffner & Bett
ATTORNEYS

1890-1891

1890-1891

1890-1891

1890-1891

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1890-1891

No. 763,274.

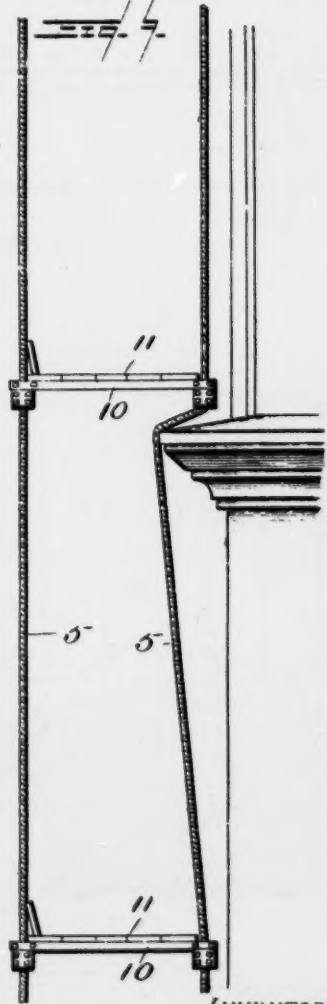
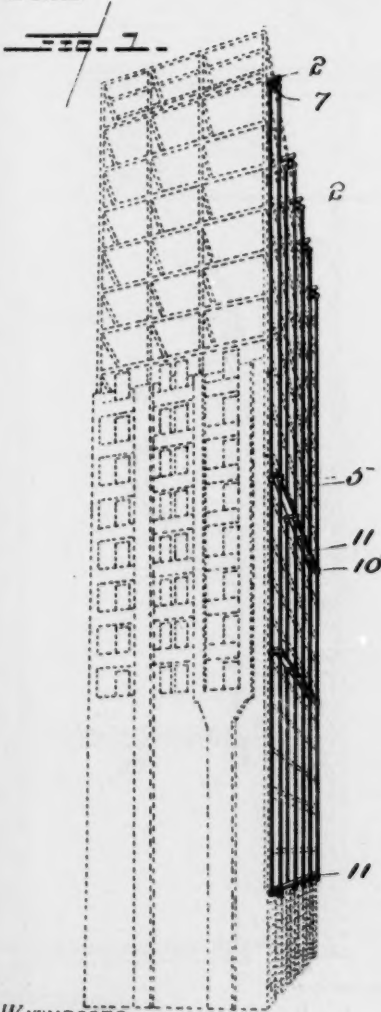
PATENTED JUNE 21, 1904.

C. FOSTER.
SCAFFOLD.

APPLICATION FILED MAR. 18, 1903.

NO MODEL.

3 SHEETS—SHEET 1.



WITNESSES

H. F. Doyle.
Geo. B. Pitts.

INVENTOR

Clair Foster

BY

J. S. Barker
Attorney



No. 763,274.

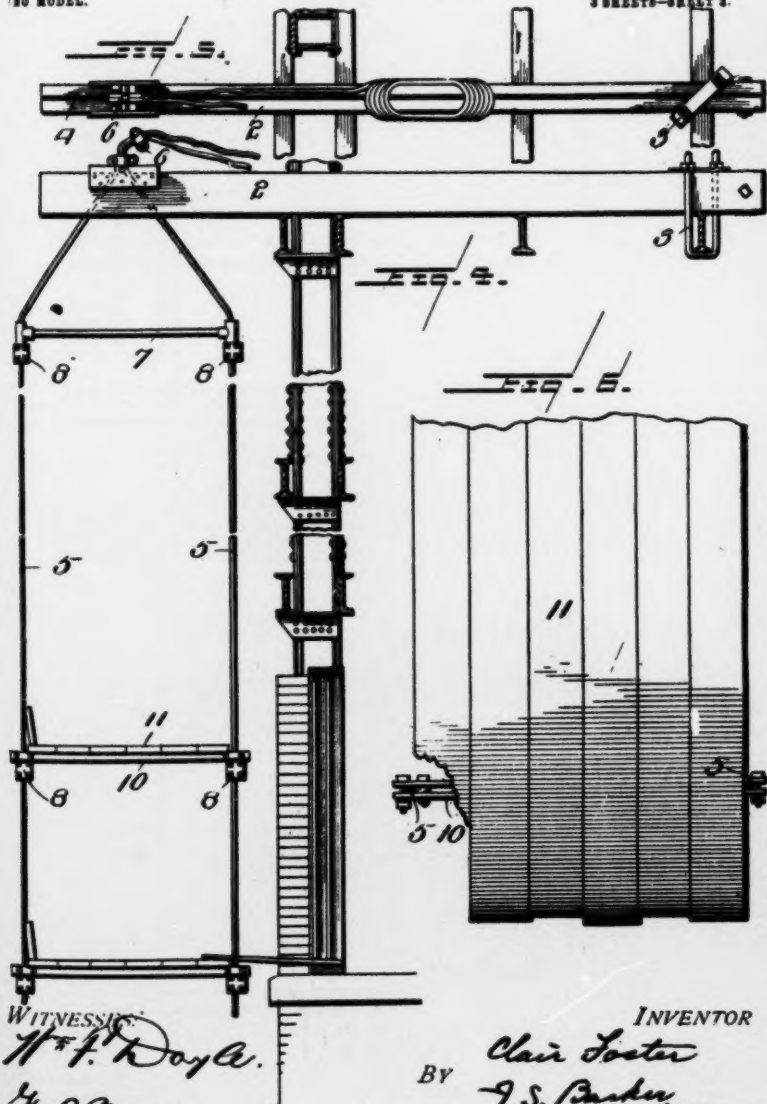
PATENTED JUNE 21, 1904.

C. FOSTER.
SCAFFOLD.

APPLICATION FILED MAR. 19, 1903.

NO MODEL.

3 SHEETS—SHEET 3.



WITNESSES

W. F. Doyle.

Geo. B. Pitts.

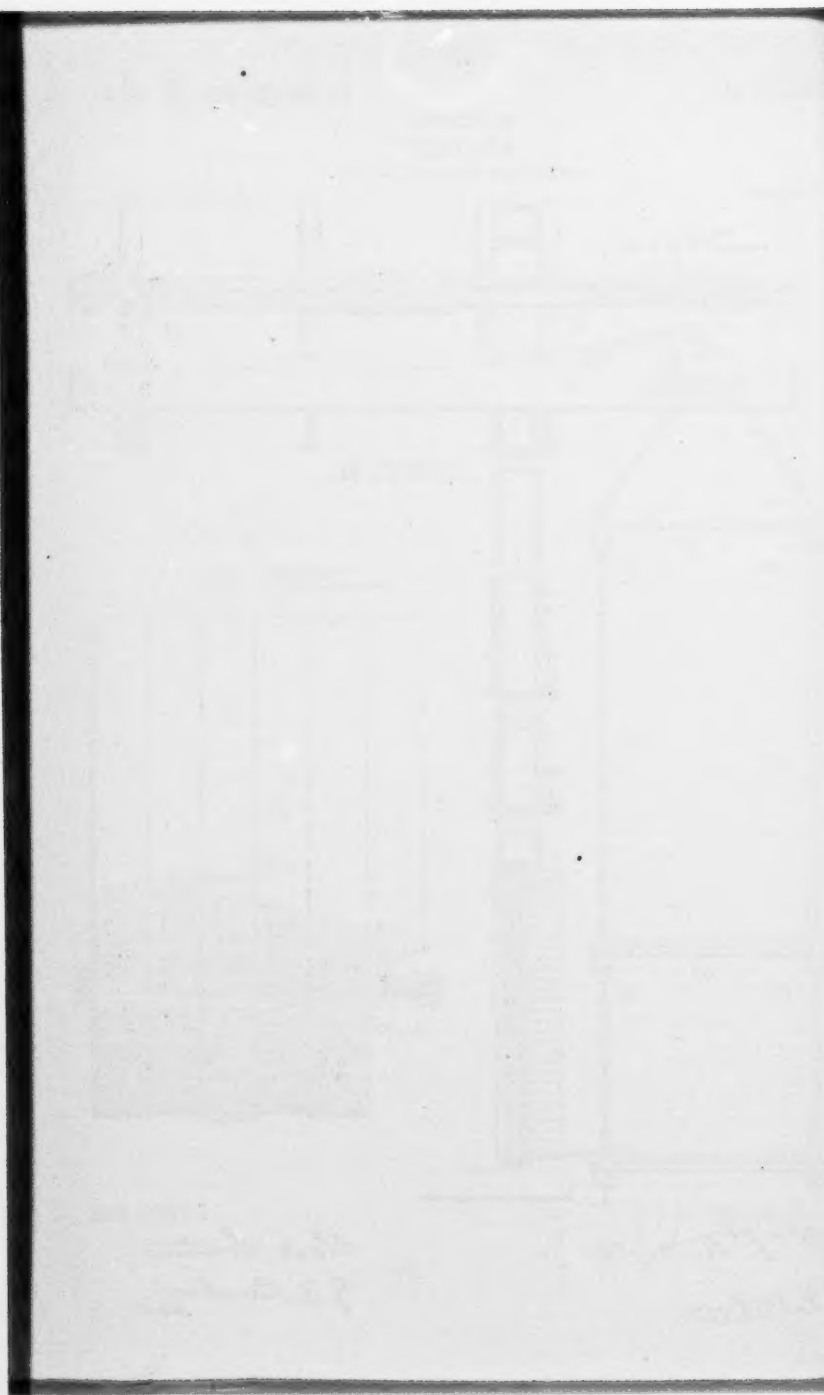
INVENTOR

Clair Foster

BY

J. S. Parker

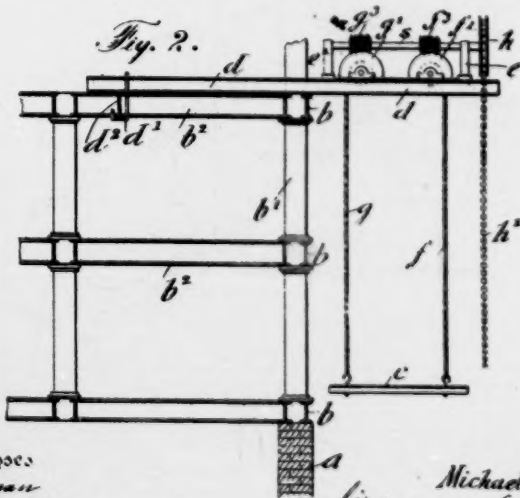
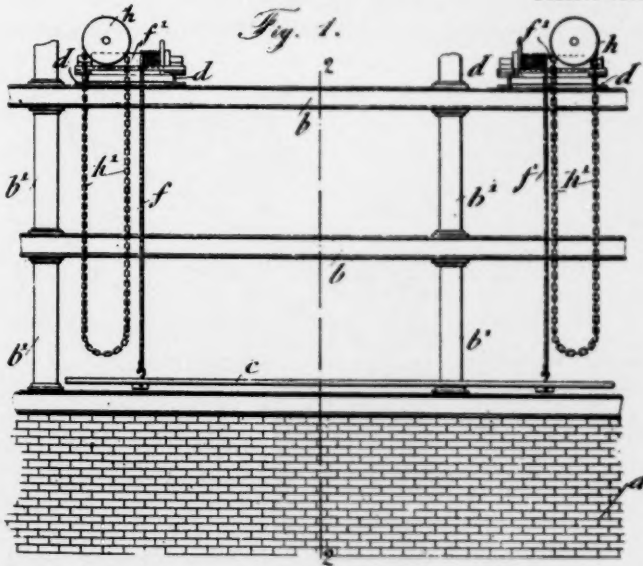
his Attorney.



M. CAVANAGH.
SCAFFOLD SUPPORT.

APPLICATION FILED NOV. 22, 1904.

2 SHEETS—SHEET 1

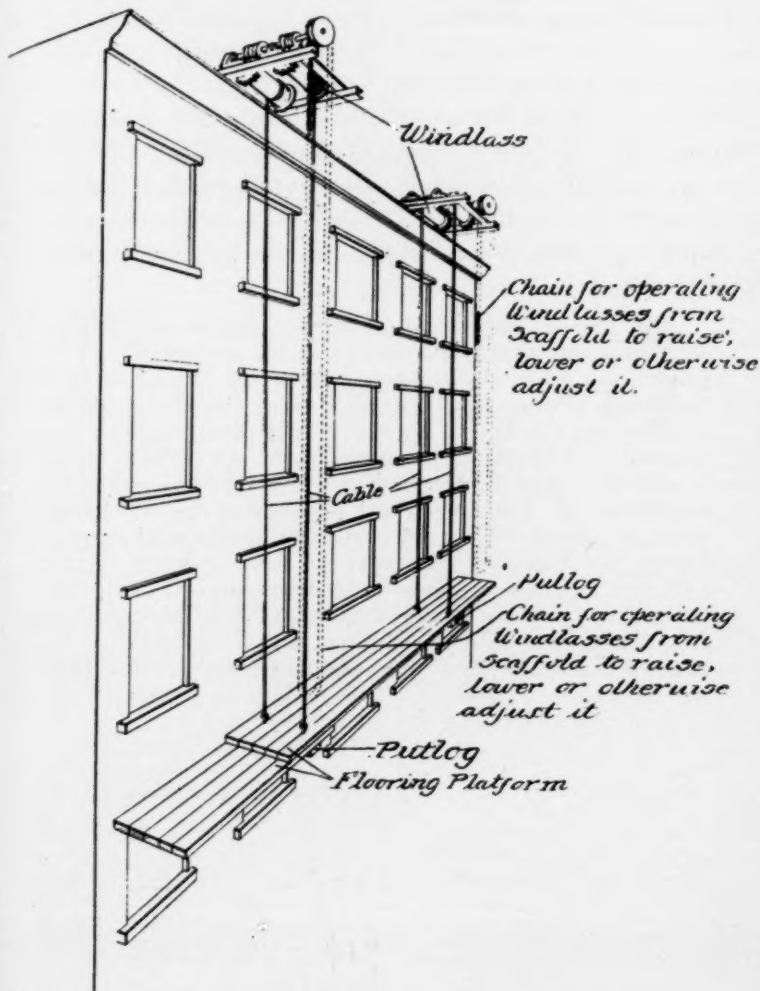


Witnesses
W. D. B. B. B.
H. B. B. B.

Inventor
Michael Cavanagh
By his Attorneys
James Niles



Perspective View Cavanagh Swinging Scaffold 1905
 Used for more than ten years.
 Overhead Windlass with endless chain
 for elevating scaffold by workman on it.
 Cavanagh Patent 796,807. August 8, 1905.



Pages 18, 19 and 20 hereof are views (illustrative and from the patent) of the Henderson scaffold, never used by plaintiff or its licensees, as shown by the record.

The reason why it was never used is illustrated on page 20. The danger in the use of such a device is apparent from the view on page 20, and was fully appreciated by the Court of Appeals for the Third Circuit, when it says in discussing the so-called improvement claimed to have been made by Henderson over Murray:

“We are not satisfied that by this difference Henderson made any improvement, patentable or otherwise. He provided a loose and unfastened put-log in place of the fixed and fastened put-log of Murray and lessened the fixidity and rigidity of the whole platform, thereby correspondingly lessening the security of the workmen, which is just the opposite of what was pressed throughout the argument as the important consideration to induce masons to work with heavy materials upon swinging platforms, but however that may be, the evidence is that although Henderson followed Murray and claims to have improved upon his device the Patent Scaffolding Company advertises only the Murray device and seventy per cent. of the scaffolds it puts out and rents are the Murray device.”

E. H. HENDERSON.
 SCAFFOLD SUPPORTING MEANS.
 APPLICATION FILED JUNE 19, 1909.

Patented May 24, 1910.

59,008.

SHEETS—SHEET 1.

Fig. 1

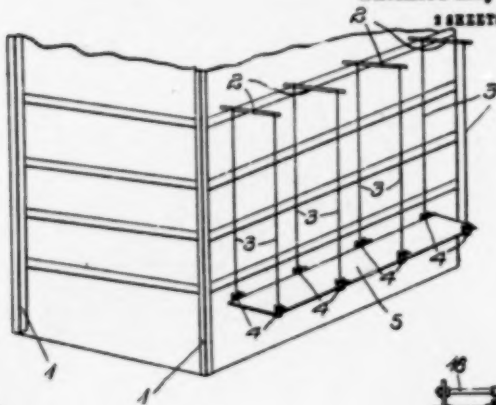


Fig. 2

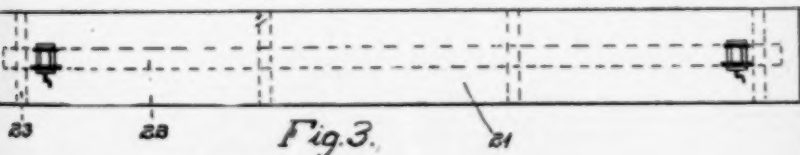


Fig. 3.

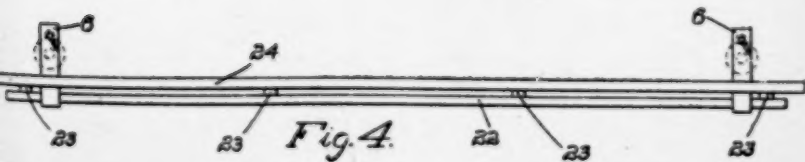


Fig. 4.

Witnesses

George C. Higham.
 Robert S. McCall

By

Inventor
 Elias H. Henderson
 Edward Williams
 ATTORNEYS



E. H. HENDERSON.
SCAFFOLD SUPPORTING MEANS.
APPLICATION FILED JUNE 10, 1909.

959,008.

Patented May 24, 1910.

SHEETS-SHEET 2.

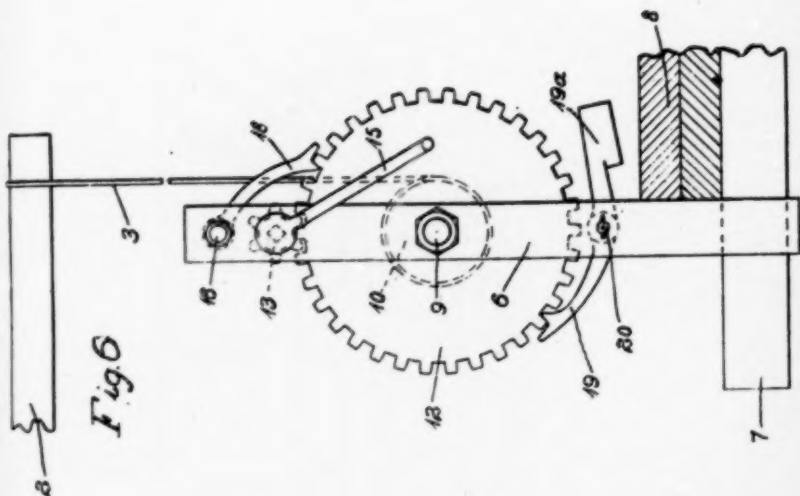


Fig. 6

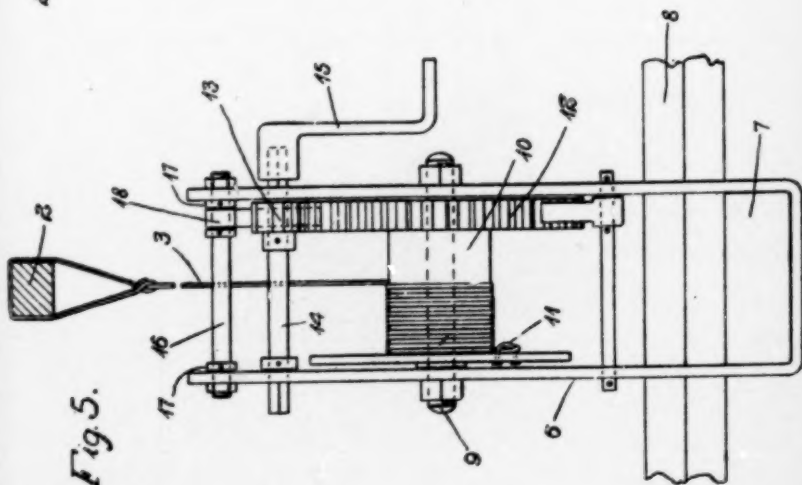


Fig. 5.

Witnesses

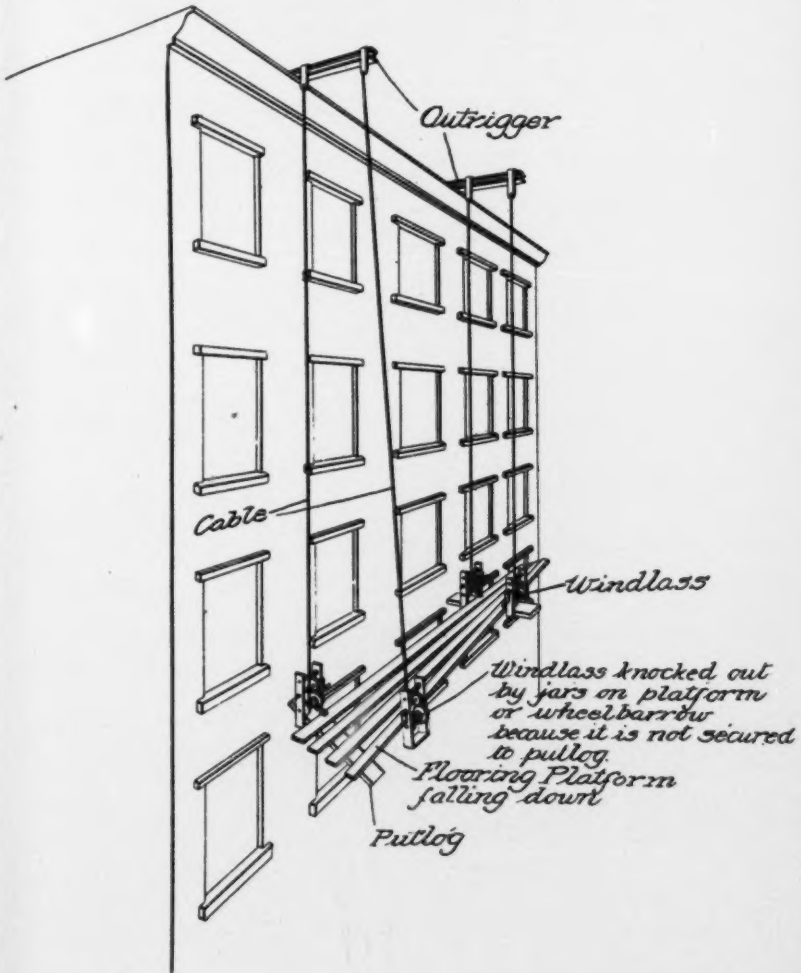
George C. Higham.
Robert H. McCaleb

Inventor
E. H. Henderson
By Brown & Williams
Attorneys



Henderson Patent Device (In Suit)

Showing what would happen if wheelbarrow or jars on platform caused one of the windlasses to be forced off end of pullog to which it is not secured in anyway



INDEX.

Statement	1
I. Petitioner's thirty-three indictments.....	2
II. Concerning respondent's Appendix.....	9
III. Concerning Whitney's relation to defense of Lie- bel-Binney and Chain Belt cases.....	18
IV. Concerning file-wrapper and contents.....	24



SUPREME COURT OF THE UNITED STATES

NEW YORK SCAFFOLDING COMPANY,	}	NO. 712.
Petitioner,		
VS.		
LIEBEL-BINNEY CONSTRUCTION COM- PANY,		
Respondent.		

NEW YORK SCAFFOLDING COMPANY,	}	NO. 713.
Petitioner,		
VS.		
CHAIN BELT COMPANY et al.,		
Respondents.		

(Nos. 47 and 48 of October Term, 1919.)

REPLY TO PETITIONER'S REPLY BRIEF.

Statement.

Petitioner has filed a brief in which, under the title "Misstatements and Perversions of Fact in Respondents' Brief," it makes an attack upon that brief in terms and substance quite appropriate to this title and out of place in this court. We submit that there is no justification for the attack so made; that each of the statements of respondents' brief there assailed is true and pertinent; that this will be evident from reading respondents' former brief in connection with the rec-

ord; and that the passages criticised, either by themselves or read in connection with the context, precisely express the facts to which they relate.

I.

Petitioner's Thirty-three Indictments.

Disregarding the intemperate, and, as we think, inexcusable terms of many of these indictments, we refer to them successively as numbered by petitioner, and join issue with each.

1. The effect of the decision of the judges of the Circuit Courts of Appeal who have passed upon the Henderson patent here in suit is as stated on pages 1 and 2 of respondents' brief. All the judges of each Court of Appeals refused to sustain the patent as covering what petitioner in its briefs has constantly asserted to be the invention covered by the claims in suit, as very definitely explained on page 2 of respondents' brief. All of them held that it could not be sustained as covering the first Whitney hoist, or the platform supported by such hoist, except when these hoists were set *parallel* instead of edgewise to the wall, and all were dealing with a case where they were used in groups of four. The Court of Appeals of the Eighth Circuit and that of the Seventh Circuit (the only two courts which had the Little Wonder machine before them) held unanimously that the patent could not be sustained as covering this Little Wonder machine whether set edgewise to the wall or flatwise to the wall, or with the timbers connected thereto in either of the ways in which it had been used or was charged to have been used. The Court of Appeals of the Third Circuit, affirming the trial court, held unanimously that the claims could not be sustained at all.

This is all shown beyond room for controversy by

the records and opinions in the several cases. Petitioner, both in the brief seeking the writ and in its original brief filed herein (see, for instance, Brief for Petitioner, pp. 16, 23 and 51), has, with constant reiteration, asserted that the invention by which the Henderson patent was to be distinguished from the prior Murray patent (which, like the Henderson, employed four platform hoists, raised and lowered by crank-driven drums mounted therein, supported the cross-timbers or put-logs on the bottom of the same frames that carried the drums and had the longitudinal timbers laid in like manner on such put-logs, and which plaintiff has manufactured and put into use continuously since long prior to the alleged Henderson invention, and which it still manufactures and uses to the exclusion of the Henderson) consisted in inserting the "loose jointed connection between the put log and the supporting frames." It is upon this assertion that it founded its argument that it is entitled to relief here.

The Court of Appeals of the Seventh Circuit found unanimously that, prior to the Henderson alleged invention, plaintiff was using the Murray platform hoist in precisely the way that petitioner insists would satisfy the invention covered by the Henderson patent—that is, with the cross-timbers or put-logs supported upon the bottom of the hoist frames by bolts passing through the put-log and resting on the bottom of each frame, respectively (Opinion, C. B. Rec., pp. 266-271). In restricting the relief given against the first Whitney machine to those which were placed parallel to the wall (conceding that this was the only departure from the prior art by which the patent could be sustained, and that the advantage of this, except in respect to the "saving of space," was dubious, referring to the "saving of space" which it erroneously assumed to be the effect of the parallel

placement, but which was not obtained in the Henderson machine as shown in the patent, but due to a departure which respondents' machine had made from the patent), it held that the Little Wonder did not infringe, however the cross-logs and platform were placed or attached. In so holding it unmistakably rejected petitioner's contention that the introduction of a "loose jointed connection between the put log and the supporting frames," even in the exact combination, was the invention, or any part of the invention, introduced by Henderson or covered by the Henderson patent. None of these judges found this loose-jointed connection (in this combination or any other) to be original with Henderson, or to involve patentable invention over the prior art.

The Murray patent as issued, as well as petitioner's commercial operations under it, since long before the alleged Henderson invention, employed the so-called "loose jointed connection between the put log and the supporting frames" in a platform of the same character and operated in the same way. This is sufficiently referred to in the evidence cited in respondents' former brief.

Petitioner's contention here for relief in each of the three cases rests upon its argument that this loose-jointed connection between the hoist frames and the cross-timbers of the prior Murray patent is the invention secured by the Henderson patent, relied upon to distinguish it from the prior art, and the presence of which is the trespass complained of. This contention of petitioner cannot be disguised or evaded by the use of the term *combination*, since it cannot be denied the entire combination was in other respects old in the Murray patent; and petitioner's argument is that it was the modification of this old combination in *respect*

to this one feature that constituted the Henderson invention.

The facts are that the Murray patent and the Murray machine exhibited the entire combination, *including this feature*; that the Henderson patent makes no claim to the invention of this loose connection, and its claims, if valid, would be equally infringed whether it be present or absent; that the action of the Patent Office in allowing the patent was placed explicitly upon the presence of another feature which neither the first Whitney nor the Little Wonder machines contains, and which the courts have agreed in holding would not constitute invention; that in the use of the platform hoists of all the prior patents there was the same looseness of connection, contributing the same freedom of play; that it was a common incident of all constructions of this character; that the construction exhibited in the Murray patent would have afforded ample looseness of play; that the planking, when laid on as is customary in these platforms, would practically, in plaintiff's past and present practice, exclude the looseness of play which petitioner's fancy has invoked as so important, and the same would be true of the platform shown in the Henderson patent; that it is desirable, rather than objectionable, to maintain the platform as nearly level as possible when raising or lowering, and especially to prevent any such tipping as the looseness of play would afford, especially to prevent any danger of the put-logs slipping out and precipitating the platform, the operators on the platform, and all it carries, to the sidewalk below; that the Henderson construction, if assumed to be used without some positive attachment, would be too dangerous for use; and that the presence of some form of attachment is necessarily implied, and the character of that attachment left to the discretion of the user.

2. This is sufficiently answered by what has been said above.

3. The facts here are precisely as stated in respondents' brief. The opinion of the Court of Appeals of the Eighth Circuit was confined as there stated. It did not "restrain any combination of four or more whether used edgewise or broadwise." It could not, in view of the indisputable prior art then before the court. The subsequent opinion of the same court, in the same case, delivered by the same judge, expressly held that plaintiff was not entitled to any relief against the second Whitney machine (the only one there under consideration) irrespective of whether placed edgewise or parallel to the wall, whether used in groups of four or more, or less, and irrespective of this loose connection. Platforms of any width or length can be made by placing the pairs of hoists edgewise to the wall, supporting the cross-planks on the lower bars of each pair, and laying the platform on these cross-timbers, as well as by placing the hoists edgewise to the wall and the cross-timbers at right angles to the wall. It is only a question of the relative length of the timbers to be used lengthwise and crosswise of the platform. The placement authorized by the first opinion of the Court of Appeals of the Eighth Circuit would involve the very "looseness of connection" which petitioner seeks to appropriate. The prior Murray patent, No. 854,959, with its "combination of four or more" hoists carrying the cross-logs and platform thereon in the same relative position as now used by plaintiff, was before that court when delivering that opinion, and it is hardly conceivable that it was enjoining the defendant from using the "combination of four or more hoists" in the platform there shown. Its later opinion entirely excludes any such interpretation of its former one as petitioner contends for.

4-32. The statements on page 3 of respondents' brief, denounced by petitioner, are true and amply supported by evidence later cited in respondents' brief. The same applies to all that is challenged under the remaining articles of this indictment.

In 19 petitioner refers to only part of the evidence cited by respondents.

In 21 petitioner attempts to treat the expression "*rigidly bolted*" as equivalent to so bolted as to allow no rocking motion, when the testimony shows that the bolting there referred to was that still used by petitioner, and to which it elsewhere refers as affording the loose connection. Witnesses plainly so described that construction, as shown by evidence cited in respondents' brief, and the Court of Appeals in the Chain Belt case unanimously found plaintiff's use of the Murray machine prior to the alleged Henderson invention, to which petitioner here refers, to have been that which petitioner relies upon as affording the "loose connection." (See respondents' brief, pp. 63-68, opinion C. C. A., 7th Cir., top of p. 267, C. B. Rec.)

In 24 "*irremovably riveted together*," as used by the witness, refers to the fact that the hoist and put-log were so connected that they could not *come apart accidentally*, and would have to be purposely taken apart, either by removing the nut on the bolt or by removing the head of the rivet, thus avoiding danger of their accidentally separating when in use. "*Rigidly bolted*" refers to the snugness with which the nut was attached to the bolt, so as to prevent any accidental separation. In either case, the rivet or bolt was so supported on the bottom of the frame as to allow quite as much rocking motion as is present in the platform hoists now, or at any time, made by plaintiff or its licensees, the principal check upon the extent of this rocking being the plat-

form timbers. In this sense defendants' hoist frames and timbers are "*irremovably attached*"; nor can they be taken apart without removing the fastenings which secure them to the hoist frames. This it would be impracticable to do when these hoists are at any elevation, as more fully explained in respondents' brief.

In 29 respondents' counsel are assailed for stating the facts exactly as shown by unrebutted evidence and found in the unanimous opinion of the Court of Appeals in the Chain Belt case already cited. The same is true of 30.

In 31 respondents' counsel are arraigned for stating that "junk" (the term petitioner's witness Davidson applies to the Murray hoist which it extensively introduced and advertised as a great success before Henderson's alleged invention) is the term the same witness applied to the Henderson hoist. It charges not only that this is "absolutely false," but that respondents cited no evidence to support their statement. Henderson (p. 133, C. B. Rec., A. 57), referring to plaintiff's attempt to persuade him to discontinue the Henderson and go into association with them in building the Murray, testified that Davidson (plaintiff's official representative) then told him they had used a device similar to the Henderson but discontinued it because finding it impracticable, urged him to discontinue the Henderson and (A. 61) requested that he store or "*junk*" the Henderson. This evidence was cited in respondents' brief (top of p. 67) in connection with the reference to this use of the term "junk" by Davidson.

The subject of petitioner's second 31 (the number being repeated) and 32 has already been referred to. Not only does the Murray patent exhibit a construction which would have all the play that has ever since been employed in the Murray machine, but the latest form of

the Murray machine which plaintiff is shown to have used is conclusively proved to have been in regular commercial operation, including its "loose jointed connection," before the earliest date alleged for Henderson's conception, and is so explicitly found by the Court of Appeals of the Seventh Circuit, C. B. Rec., p. 267. It is also shown and represented by plaintiff's advertising literature to have been in use extensively on many of the great buildings of this country long before Henderson's conception, and to have been extraordinarily successful. Respondents' brief cited evidence to this effect.

II.

Concerning Respondents' Appendix.

The Appendix, so vigorously criticised by Petitioner's Reply to Respondents' Brief and Appendix, starting at p. 21, consists almost wholly of reproductions of patent exhibits and drawings before the courts and is fully substantiated by the testimony.

The scaffolding shown on p. 11 of the Appendix is simply a perspective view of the structure of the Bowyer & Casperson patent No. 382,252 of May 1, 1888, reproductions of the drawings of which are shown on page 9 (the date of this patent is incorrectly stated in petitioner's brief, p. 21, as 1883). This patent issued more than twenty-five years prior to the time of trial of these cases, and corresponds very closely to the common form of scaffolding used for many years. The patent is, of course, evidence of its being known to the public for that length of time, and Mr. Davidson, president of the Patent Scaffolding Company and one of petitioner's principal witnesses, when shown the Bowyer & Casperson patent, admitted that it showed the general plan of painters' scaffolds to which he had referred in his

testimony (L. B. Rec., p. 44, first two questions under cross-examination).

Mr. Davidson, in connection with his description of this painters' scaffold, drew a sketch which he admitted to have been in use twelve or fifteen years, and which has substantially the same U-shaped frame as the Bowyer & Casperson patent. This is shown by "Defendants' Exhibit F," L. B. Rec., following p. 98 original p. 188.

Whether a single plank or a series of planks is used on this U-shaped frame is immaterial.

The illustration of this scaffold, p. 11 of the Appendix shows plainly the U-shaped frames with planks between them. If the frame is narrow, but one plank would be used; if the U-shaped frame was wider, more planks would obviously be used; and if the user of the U-shaped frames had two narrow planks, instead of a single wide one, those would be used because most available.

In this structure, as in the Henderson and Murray devices, the platform is raised and lowered, through the operation of the windless near the scaffold, by a person standing upon the platform. The view on p. 11 is a fair perspective of the structure on p. 9, which latter is an exact reproduction of the Bowyer & Casperson patent of May 1, 1888 (L. B. Rec., following p. 98, original p. 184; C. B. Rec., following p. 258, original p. 332).

Pages 2 and 3 of the Appendix are exact reproductions of Defendants' Exhibits 14 and 15 in the Chain Belt case (C. B. Rec., following p. 236, original 293, 295). They were testified to by both LaBelle and Henderson, as correctly showing the devices used by plaintiff itself in 1908 at the Blackstone Hotel and subsequently elsewhere. Not only do the pictures appearing on pages 2 and 3 accurately show what the plaintiff was doing long prior to the

Henderson invention, but this is testified to by both LaBelle and Henderson.

The Court of Appeals of the Seventh Circuit says (C. B. Rec., p. 267):

"The evidence fairly establishes that in 1908, prior to Henderson's invention date, appellee, who owned the Murray and other patents for scaffolds, and had built up a large business in the supplying of scaffolds for the erection of high buildings, had furnished for the erection of the Blackstone Hotel at Chicago, scaffolds in which there was the U-shaped bar frame similar to that of Henderson, but with put-logs composed of two angle irons bolted together, the U-frame extending down between them, and the connecting bolts resting on the top of the under web of the U, the floor boards of the scaffold being, as in Henderson, laid parallel to the building."

This statement describes the device shown on pages 2 and 3, as did, also, the testimony of LaBelle and Henderson. Not only this, but Mr. LaBelle fully explained this device as used by him at the Blackstone Hotel in 1908 prior to seeing these drawings (C. B. Rec., p. 166), and then identified this device as being the same as the one then in the court room introduced in evidence by plaintiff as "Plaintiff's Exhibit No. 15," which, when mounted as used by plaintiff since 1908, is also correctly shown in the cuts appearing on pages 2 and 3.

These cuts are, also, faithful reproductions of the structures shown on pages 10, 11 and 13 of the catalog of plaintiff's licensee, the Patent Scaffolding Company, of which Mr. Davidson is president (L. B. Rec., p. 50).

In this connection, it should be noted that on p. 25 of this Patent Scaffolding Co. catalog (L. B. Rec., following p. 98, original p. 182), reference is made to the fact that 106 and 110 of these machines, respectively, were used at the Blackstone and LaSalle hotels; and further, that the catalog—which was issued in August, 1912--contains

as true, statements made by petitioners' licensee, when it was not under the pressure of litigation (p. 9), as follows:

"We have no statistics to show the number of lives which the ever-increasing use of our scaffolding has saved, *during the period of more than five years since its introduction.*"

"*More than five years since its introduction*" of the device shown in this catalog on pages 10, 11 and 13 is 1907, the very year when the Murray patent No. 954,959, of May 28, 1907, was issued (L. B. Rec., following p. 114). Incidentally, this is the identical patent under which petitioner and its licensees have marked all of the devices which it has used, including those which it has produced in court as representing its commercial practice. The manner of marking all of these devices is shown (L. B. Rec., following p. 98, original 181), referred to as "Defendants' Exhibit B," as follows:

"Property of The Patent Scaffolding Co. of Illinois,
Chicago, U. S. A.,

"Machines rented not sold.

"Patent No. 854,959—May 28, 1907.

"Machine No. 833."

This patent is plaintiff's Murray patent of May 28, 1907.

The same marking appeared on plaintiff's machines introduced in both cases.

In the Liebel-Binney case, there were no witnesses introduced by defendant, and plaintiff's witnesses positively testified that the structure shown on pages 10, 11 and 13 of the Patent Scaffolding Company catalog, "Defendant's Exhibit C," correctly represented the device on which the gold medal was awarded and that this award was made on November 21, 1910 (L. B. Rec., p. 34).

The catalog fully confirms Mr. LaBelle and Mr. Henderson to the effect that the devices shown on pages

10, 11 and 13 of the catalog were the regular commercial product of petitioner's company since prior to 1908.

Mr. Cavanagh, plaintiff's witness, also testifies that these were the commercial product of the New York Scaffolding Company. He produced three of these exhibits from which the Murray patent marking was taken, as "Plaintiff's Exhibits 11, 12 and 13 (L. B. Rec., p. 61), testifying that seventy per cent. of the trade were using them at that time.

Mr. Davidson testified in the Liebel-Binney case—although he attempted to vary this in the Chain Belt case—that the Murray type which they had been manufacturing since 1908 is correctly shown on pages 10, 11 and 13 of "Defendants' Exhibit C," which is the Patent Scaffolding Company catalog referred to, and the cuts from which are reproduced on pages 4, 5 and 6 of the Appendix to respondents' brief. Mr. Davidson said, when these three pages were called to his attention (L. B. Rec., p. 48):

"Yes, I would think it looks like the Murray type. I think it is."

He then went on to explain that page 13 of the catalog shows the one they were putting out under the Murray patent; that he knows this Murray type, with the wire hung from the out-riggers and having hoisting devices on the platform by which the platforms were raised and lowered, was on the market in 1908 (p. 49), saying—

"Well, I know they were on the market in 1908, because then I came in and helped to form a company."

"Q. When did you become interested in the New York Scaffolding Company?" (L. B. Rec., p. 50).

"A. In May, 1908.

"Q. And you started at that time putting out this Murray type of device, with the U-shaped frame, with put-logs, and at the lower end a hoisting device

by which the device was lowered and raised, did you?

"A. At that time it was the Murray device that we first started to handle.

"Q. And you have been putting that out ever since?

"A. Except that we have improved our service and machine."

He also says (L. B. Rec., p. 51) that these devices were being leased in 1908 prior to the time they had any negotiations with Henderson. He further says that they started as early as 1908 and continued right on leasing machines, and were doing so at that time.

He was asked (L. B. Rec., p. 52):

"Q. The Murray device is giving satisfaction under your lease, isn't it?"

and answered—

"A. We think we have been getting pretty good satisfaction ever since we have started. *We have revolutionized the business.*"

Again—

"Q. What did you mean when you answered the last question and said that the Murray type was giving satisfaction?

"A. I think my mind ran into more than just the type. With all these scaffolds it is organization and service and improved methods.

"Q. Well, do you mean by the Murray type a structure like that shown in the Murray patent 854,959, or do you mean a structure like that shown on page 11 of the booklet, Defendant's Exhibit 'C'?

"A. Well, now, I mean this scaffold, this machine. This is what we are doing. (Witness indicates page 11 of Defendant's Exhibit 'C.')

"Q. And that is what you meant in that last answer, was it?

"A. Yes, sir."

The testimony out of the mouths of plaintiff's witnesses, as well as the testimony of LaBelle and Hender-

son, shows plainly that plaintiff was leasing the devices correctly illustrated on pages 2, 3, 4, 5 and 6 of the Appendix, and substantially illustrated in the Murray patent, shown on pages 7 and 8 of the Appendix, continuously certainly since as early as 1908; that they have been marking all of these devices under the Murray patent of 1907; that they did not purchase the Henderson patent until May 12, 1911, about four years after the Murray patent had been taken out, and approximately three years after the plaintiff company was organized and commenced doing its business on this Murray patented device, according to the testimony of Davidson.

The trial court in the Liebel-Binney case, through Judge Orr, who heard only plaintiff's testimony, for there was none offered by defendant, very properly in view of this evidence, finds in its opinion that—

“In the neighborhood of 70 per cent. of the scaffolding devices put out by the Patent Scaffolding Company are used and are intended to be used in accordance with the disclosure of the Murray patent No. 854,959.”

The Patent Scaffolding Company, in its catalog, illustrated the Murray arrangement and not the Henderson.

The court then points out (L. B. Rec., p. 84) that the plaintiff's use of its devices has been as shown in the Murray patent, instead of as shown in the Henderson patent, in other words, that the entire use of plaintiff's device has been with the hoisting frames at right angles to the wall of the building instead of broadside, as the Court of Appeals of the Eighth Circuit, in the first case, asserted was the invention of Henderson in order to distinguish it from Murray.

It is insisted that, in view of this testimony, the cuts shown on pages 2 to 8 of the Appendix, inclusive (all of which are simply reproductions of cuts which have been

before either two or more of the courts from which these records have come) as well as the statements made in connection therewith, are fully substantiated by the record, and are confirmed by the trial court and the Court of Appeals in the Third Circuit, as well as by the Court of Appeals of the Seventh Circuit.

The statement made opposite page 18 of the Appendix referred to on page 28 of Petitioner's Reply to Respondent's Brief and Appendix, is entirely consistent with the record. In the Liebel-Binney case, Mr. Pitou, who was connected with the New York Scaffolding Co., and one of plaintiff's witnesses, says (L. B. Rec., p. 38) that he *thinks* some of the devices were marked under the Henderson patent, and says (p. 39) that he will produce one to confirm his thought on that subject. He never produced any such structure, nor is there any testimony in the record to show that any of these devices which have been sold or leased by the plaintiff have ever been marked under any other than Murray patent No. 854,959, of May 28, 1907.

There is nothing in the record, or even in petitioner's reply, which questions the statement that these Murray devices, as shown by the physical exhibits of plaintiff's structure, as well as in the Patent Scaffolding Company catalog, Exhibit C in the Liebel-Binney case, pp. 10, 11 and 13, were put upon the market by petitioner during the year of 1910, which was months prior to its acquisition of the Henderson patent, as shown by the assignment to the plaintiff, dated May 12, 1911 (C. B. Rec., p. 184; L. B. Rec., p. 96). The testimony of plaintiff's own witnesses before they had changed their position, that the invention consisting in a flatwise placement of the hoisting structure, to the position that the invention consists in the tilting of the frames relative to the put-logs, is clearly to the effect that they were making and leasing

these devices, marked under the Murray patent, prior to their acquiring any interest in the Henderson patent, and there is other testimony, including that of defendants' witnesses LaBelle and Henderson, as well as that of plaintiff's witnesses Davidson and Cavanaugh in the Liebel-Binney case, that these devices were made and used under the Murray 1907 patent in the identical form which is shown both by physical exhibits and Defendant's Exhibit C in the Liebel-Binney case (Patent Scaffolding Company catalog) as early as 1908 and long prior to the alleged Henderson invention.

The opinions of Judge Orr, who heard the witnesses in the Liebel-Binney case, and the Court of Appeals of the Third and Seventh Circuits agree that it was the Murray device which has been used commercially instead of the Henderson, and that whatever success plaintiff has had has been due to the Murray rather than that of Henderson. The dangers incident to the use of the Henderson structure are shown in the illustrative picture on page 20 of the Appendix to Respondents' Brief, and are pointed out in the opinion of the Court of Appeals of the Third Circuit when it says of the Henderson construction (L. B. Rec., p. 118)—

“We are not satisfied that by this difference Henderson made any improvement, patentable or otherwise. He provided a loose and unfastened put-log in place of the fixed and fastened put-log of Murray, and lessened the fixity and rigidity of the whole platform, thereby correspondingly lessening the security of the workmen, which is just the opposite of what was pressed throughout the argument as the important consideration to induce masons to work with heavy materials upon swinging platforms. But however that may be, the evidence is that although Henderson followed Murray and claims to have improved upon his device, the Patent Scaffolding Company advertises only the Murray device, and seventy per cent. of the scaffolds it puts out and rents are the Murray device.

"We do not see what problem was presented to and solved by Henderson. He did what Murray had already done, but did it in a different way. Patentable invention does not reside in mere difference, either of construction or result. The difference in construction is small indeed, involving nothing more than mechanical skill. The difference in result is a small saving of space upon the platform. This saving does not appear to have been demanded before the patent or valued after it. Finding no new problem presented or solved, and no real improvement made, we cannot conceive patentable invention in Henderson's formal changes from the prior art. We are therefore of opinion that claims 1 and 3 of the patent are void for want of patentable invention."

III.

Concerning Whitney's Relation to Defense of Liebel-Binney and Chain Belt Cases.

What was said on pages 70-71 of Brief for Respondents should sufficiently dispose of this subject. Petitioner seems to entirely misapprehend the effect of what was there said and the status of the parties. It is petitioner, not respondents, that has insisted upon relitigating, in these two later cases, the issues between plaintiff and Whitney which had already, by plaintiff's action, been made the subject of the litigation in the Eighth Circuit, and which must be controlled by whatever *final decree* may be entered therein.

Neither the Liebel-Binney suit nor the Chain Belt suit could be maintained as suits *against Whitney* for any relief obtained or obtainable in the earlier suit against him in the Eighth Circuit. It was only upon the theory that plaintiff was entitled to some relief against the Chain Belt Company and against the Liebel-Binney Company, respectively, which was not obtainable in the suit against Whitney, that these later suits could proceed.

If they had been brought or prosecuted simply to obtain, in another district, an injunction and accounting against Whitney for his manufacture, use and sale of any of the machines involved in the Eighth Circuit suit, or to obtain any relief against him cognizable there, they would be only vexatious suits which must be dismissed as soon as such fact appeared. They were brought, or purported to be brought, for relief against the Liebel-Binney Company as a *user* of one or more of the original Whitney hoists which were the subject of the decree in the Eighth Circuit, and for which Whitney was then accounting; and against the Chain Belt Company because of its part in manufacturing the iron part of these hoists and of the Little Wonder hoists. When the Chain Belt suit was brought these "Little Wonder" hoists (the only hoists for which it had made any part or had anything to do with for over two years before this suit was brought) had not been passed upon by any court. They were afterwards included under the interlocutory decree in the Eighth Circuit by the district judge, but were subsequently held, in the same case, by the Court of Appeals of that circuit, to have been improperly so included and not to be an infringement. No final decree had, or has, been entered against Whitney in the Eighth Circuit.

Every Whitney hoist for which the Chain Belt Company furnished the iron work, and every hoist used by the Liebel-Binney Company, was treated by plaintiff and by the court as the subject of the accounting against Whitney in the Eighth Circuit case.

When, pending this accounting, before any final decree, long after Whitney had ceased to manufacture or sell the only machine that had been found to infringe (the first Whitney machine), plaintiff brought suit against ten different defendants in different parts of the country who were charged with having used hoists sold then by

Whitney, or, in the case of the Chain Belt Company, with having supplied Whitney with the iron work, and when these suits were accompanied by advertisements and notices representing the Little Wonder machine, which Whitney was then making, to be included in such decree (as it had not then been in any decree), Whitney applied for leave to intervene in the Chain Belt case, for the purpose of enjoining vexatious and malicious attacks upon his vendees and protecting them against liability in respect to the hoists for which he was already accounting, or in respect to any Little Wonder hoists, which had not then been included in the decree against him. His appearance was not for the purpose of relitigating any issue between him and plaintiff which was the subject of the Eighth Circuit suit, but for the purpose of securing relief against these vexatious attacks, as his petition amply shows.

His thus appearing did not prejudice either the Liebel-Binney Co. or the Chain Belt Co. in respect to any defenses that would have been open to them if they had themselves conducted their defenses instead of leaving to him the expense of doing so. It was creditable to him that he assumed this expense. If there had been a final decree against Whitney in the Eighth Circuit (as there was not) finding everything that was found in favor of plaintiff in the first opinion of the Court of Appeals of the Eighth Circuit, it did not follow that either of these defendants had committed any infringement or was in any respect liable to plaintiff, for these hoists were adapted to use, and largely used, in a manner which, under that opinion, would not be an infringement; and it did not appear, and has not appeared, that either of these defendants ever used, or in any way participated in the use of, these hoists in any such manner as was there held necessary to constitute infringement.

Certainly the right of these defendants, or Whitney personally, to contend that the Little Wonder machine was not an infringement had not then been concluded, for it had not then been adjudicated in that circuit, and when adjudicated there was adjudicated against plaintiff, as it afterwards was in the Seventh Circuit.

It was only for the purpose of seeking affirmative relief against vexatious suits and advertisements that Whitney had occasion to intervene. His right to defend his vendees against such attacks on any ground that was available to such vendees was not dependent upon obtaining leave to intervene. Neither of these defendants had been parties to, or taken any part in, the defense of the Eighth Circuit suit, and each of them was at liberty to contest the validity of the patent, as well as to deny that they had infringed thereon. Nothing in the Eighth Circuit suit could conclude them in respect thereto, or deprive them of any defense that was set up in their answers; Whitney's part in defending them did not entitle plaintiff to any relief against him personally in respect to the matters that were the subject of the Eighth Circuit suit against him. It was not determined in that suit that anything which either of these defendants had done would infringe plaintiff's patent, and, therefore, neither of these defendants could have been concluded thereby in respect to the question whether the patent can be sustained as covering what either of them was doing by anything decided there, if they had been parties to that suit.

Plaintiff was obliged to ask an interpretation of the patent that relieved it from the restrictions upon which it had been sustained in the Eighth Circuit, in order to charge the Liebel-Binney Co. or the Chain Belt Co. with infringement. If these defendants had been privy to the Eighth Circuit suit in any such sense as would con-

clude them thereby, there would have been no occasion to bring these suits based on the same hoists that were being accounted for there. These suits must rest upon the theory that the relief sought by reason of what these defendants had done is quite independent of any relief in respect to these same hoists obtainable against Whitney. The only devices that the Chain Belt Company was making for Whitney at the time suit was brought against it, or had made for years before, were the Little Wonder, which the court of the Eighth Circuit, in the suit against Whitney, held not to infringe the patent.

Petitioner's theory of estoppel is fatal to it so far as concerns the Little Wonder machines, and also so far as concerns its right to relief against the Liebel-Binney Co. Certainly a manufacturer who is under an interlocutory decree, which may at any time be changed or reversed before it becomes a finality, is not concluded against defending his vendees or his employes in any attack that the plaintiff may make upon them in seeking recovery or injunction against them, especially so when the right to such recovery is dependent upon a different state of facts than any supporting such interlocutory decree. Such users or employes against whom a judgment is sought are not deprived of any defense otherwise available to them by reason of the fact that the manufacturer assumes the conduct of the defense.

Suppose the defendants here had called upon Whitney, as the manufacturer, to defend these suits. His assuming that defense would not deprive the plaintiff of the benefit of any claim it might have against such defendants by reason of acts for which Whitney was in no wise responsible; nor would it entitle plaintiff to judgment against them if they had committed no act of trespass. Whatever defense was available to them

would not be prejudiced by reason of the expense of defending them being assumed by the manufacturer.

Plaintiff was not, in either of these suits, entitled to a decree "*in personam*" against Whitney in respect to relief obtained, or obtainable, in the prior suit against him then pending in the Eighth Circuit, and the Eighth Circuit has agreed with each of the other circuits in holding that plaintiff was not entitled to any relief in respect to the Little Wonder machine, or any relief in respect to the original Whitney machine except that heretofore specified.

Suppose Whitney had done nothing to defend either of these defendants, or any others against whom suits were brought based on their use of the Little Wonder, or on their use of the original Whitney in the manner that the court held would not constitute infringement, and that, as a consequence, plaintiff had obtained judgments against all his users in all parts of the country and against all who had made any part of the Little Wonder or the original Whitney, and it had afterwards been held in the suit against him—as it was held by the Court of Appeals of the Eighth Circuit—that the patent did not cover this Little Wonder machine, or any use of the former Whitney machine which had been made by either of such defendants, and meanwhile the decrees against them had become final, the term expired and Whitney been ruined by reimbursing for such judgments those to whom he had supplied these machines and by having all who would otherwise be disposed to deal with him under a permanent injunction. Suppose, further, that, after such judgments had been obtained and the term run on the final decrees, the controversy had been carried to this court and it had held the Henderson patent invalid, or so limited that it had never been infringed. Is there

any rule of law or equity that would place it in the power of plaintiff to bring about such a situation as this, by excluding the manufacturer from defending his vendees until the controversy had been settled by a final decree?

If there have been cases where courts, after granting an interlocutory decree against the manufacturer, have enjoined that manufacturer from defending his vendees, where the plaintiff has thereby been enabled to secure final decrees against such vendees, and where the *ultimate decision* of the suit against the manufacturer has been in his favor in respect to the issues raised by the suits which he was enjoined from defending, in which, by reason of such judgments against his vendees having become final, no relief was possible, such abuses should not receive the sanction of this court. The irreparable wrong to innocent defendants, and the unconscionable advantage to a plaintiff whose claims are without merit, which would follow if such a practice were upheld, is evident.

IV.

Concerning File-Wrapper and Contents.

Respondents have not invoked the file-wrapper and contents to contradict or change the limitations expressed in the specification and claims of the patent, but to show that the limitations so expressed were used as defining the only invention asserted by applicant or recognized by the Patent Office, and as differentiating it from what petitioner now seeks to include under the claims so obtained. This is clearly shown by respondents' brief, pp. 30-55.

The platform hoist having the drum mounted in its upright frame and the timbers resting upon the bottom

of the frame was shown to be old by patents cited; and it was also shown to be old to use the platform hoists in sets of four or more, as well as in sets of two, with two hoists supported from each outrigger, the cross-timbers supported upon each pair so hung, and the longitudinal timbers laid upon successive cross-timbers. It happened that in some of the prior patents cited in the files the cross-bar forming the bottom of the frame was attached to the uprights by bolts or screws, or other means, instead of being made of a *continuous bent bar*, and that in the case where it was shown to be made of a continuous bent bar the bearings of the drum were not set *directly* in the uprights of the frame, but were *attached thereto by a bracket* (substantially as in the first Whitney machine). It was nowhere pretended or suggested that there was any novelty in using the hoists in sets of four or more with the cross-timbers pivotally attached to the bottom of each pair and the platform resting on such cross-timbers. This was fully shown and described in the prior Murray patent cited in the files. It was not claimed there because not then novel. Henderson had seen this Murray, including its "loose jointed connection," before his alleged invention, and relied on certain peculiarities in mounting and operating the drum, never used in either of defendants' hoists; upon the fact that the frame was composed of a *single bent bar* instead of attached parts, and had the bearings of the hoist and drum set *directly in the uprights of this bar*, instead of on parts attached thereto, and the timbers resting upon *its* bottom; upon the *cheapness of construction secured by thus reducing the number of parts*, and the *exclusion of any attachment between the bearings of the drum and the support of the timber thus secured*, as constituting the invention to support the claims in suit. This is emphasized in speci-

fication, claims and repeated arguments, which show that these limitations were treated throughout as the *very essence of the invention* asserted; that, however trivial and lacking in originality or patentability they may be, they *define the entire invention for which the patent was allowed*.

We are not concerned with the question whether, if the patentee had been the first to make a platform hoist, and the specification and claims had represented this to be his contribution to the art, and there had been nothing in either specification, claims or proceedings before the Patent Office to show that these specified limitations were used to define the invention and differentiate it from the prior art, a hoist lacking them could be treated as an equivalent.

Respondents insist that limitations plainly used to define such an invention as this and distinguish it from the very close approaches in the prior art, and so emphasized by the patentee and recognized by the Office as representing the invention claimed, cannot be disregarded for the purpose of finding infringement; that nothing can be treated as an equivalent which would render ineffective the limitations so insisted upon and expressed in the specification and claims as allowed. This and the law pertinent thereto (especially the decisions of this court) have been more fully referred to in respondents' brief.

Furthermore, the entire combination now asserted by petitioner to constitute the Henderson invention has been shown without contradiction (except as the assertions of petitioner's briefs, unsupported by evidence, may be considered as contradiction) to have been in general public use by plaintiff prior to the alleged Henderson invention, always used under assertion of right under the Murray patent, the only patent under which plaintiff

either made, marked or advertised its machine, though it has no claim covering anything pertinent to this controversy. The Court of Appeals of the Seventh Circuit unanimously found that such prior use was established, and for that, among other reasons, refused petitioner the main relief it was seeking. In every aspect, petitioner's contentions are without merit and inconsistent with its own conduct.

Respectfully submitted,

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